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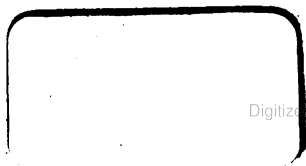
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Suggestions as to Methods of Shortening the Time Required to Finally Adjudicate Applications for Patents.

A paper read January 28, 1915, before the Examining
Corps of the United States Patent Office

BY

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Some Suggestions as to Methods of Shortening the Time Required to Finally Adjudicate Applications for Patents

By

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The subject of patent law has been described as covering a very limited portion of the field of general law. While not extensive, it is, gentlemen, as deep as a well.

It is believed to be generally recognized that there is no other branch of the law that requires a greater mentality, a wider knowledge, or greater skill and training.

The Examiner, who with the all too little time for each case, is able to apply this law with reasonable accuracy, to the multitude of different inventions, embraced in applications possessing a multitude of different imperfections and insufficiencies, and adjudicate the enormous number of claims required to mark the limits of the rights involved, must indeed possess a degree of skill, judgment and learning that is, to say the least, unusual. He must be at once judge, jury and counsel. He must determine the law, weigh the evidence, and combat and expose the fallacies in the arguments presented by the too zealous applicant. All this he must do with a maximum of speed, if the work before him is not to hopelessly accumulate.

It is the purpose of this paper to make some suggestions looking to the shortening of the time required to finally adjudicate the application. That every effort to this end is necessary is abundantly evidenced by the fact that steadily the number of applications filed each year has increased, and as steadily the time required to adjudicate each case has also increased; until now, the corps staggers under a load it is well nigh impossible to carry.

It is of little utility, perhaps, to discuss the reasons for this increase. It will be sufficient to merely note, in passing, that they are found in the fact that we are the most inventive people in the world; that our industrial and commercial supremacy is in a considerable measure due to this fact, and the steady increase in our population brings with it the natural increase in the number of applications filed each year. In 1840, there were 765 applications filed; in 1860, over 7,000; in 1880, 23,000; in 1900, 41,000; in 1913, 70,000. The examiners will, in the near future, be facing the stupendous task of examining a hundred thousand new cases a year.

Experience has shown that there is no such thing as an exhausted art.

Even where there are lulls in the advance of some of the arts, these are more than offset by the sudden activity in others, brought about by the invention of some radically new thing.

The invention of the wireless telegraph; of the successful flying machine; of the automobile, have resulted in a flood of applications for inventions in the nature of improvements and refinements, all having their bearing upon the creation of the eventually practical, commercial form of apparatus.

These pioneer inventions also bring about an increased activity in a large number of related arts.

A wireless telegraph station must have its source of high frequency current, its structural towers of great height, its special conductors of high insulation. In fact, these new conditions have brought about an increased activity in almost every branch of the electrical art.

A flying machine and an automobile must each have a gas engine, with its electric igniting means, its gas mixing apparatus, and its multitude of related devices pertaining to many mechanical and metallurgy arts. All these take on special designs and refinements incident to their new use, and bring their multitude of applications to the various divisions of the office having in charge the cases relating to these various arts.

The art that must be searched is increasing by leaps and bounds, and reclassification, imperative as it is,

and helpful as it is, can not solve this part of the problem, and is only a partial, though welcome, aid.

The complexity of the subject-matter of the applications is ever increasing. The fact that more and more of the complicated manual operations and processes are being accomplished by machinery, and that existing machinery is being more and more refined, made automatic, and made to do things requiring almost a human intelligence, with a minimum of supervision, brings about this result.

There has also grown up a class of people who are desirous of a patent of some sort, of any sort, who keep an application which is fairly anticipated before the Examiner as long as possible, hoping by some argument or shift, or amendment, to find some slight point on which to hang an allowable claim or to weary or argue the Examiner into allowing some sort of a claim, so that counsel may obtain his fee, or satisfy an uninformed client or a client who is indifferent to the validity of his patent but wishes to mark his device patented merely for the intimidating effect upon would-be rivals.

It is plain enough, therefore, that in the near future, the work of the examining corps will not grow less. The situation, as we are all aware, has resulted in the cases awaiting action reaching the somewhat startling number of over 25,000

There are several very cogent reasons why applications should be speedily brought to a final adjudication.

Applications long pending are a source of scandal and abuse. Often they do not embody the inventions in commercial form, they are kept pending in the office while others, ignorant of them, and therefore obtaining no aid from them, invent and produce successful devices, create a commercial value and status at great expense and risk, only to find that the owner of the long pending application has placed therein a claim dominating all that the later inventors have done, has issued the patent and by legal process lays tribute upon the labors and the rewards of the later innocent inventors. Such a proceeding is so repugnant to justice and equity that this office is warranted in doing all it can to prevent such applications from being kept pending during long periods.

Further, by removing the cause, legislation honestly intended to reach this class of cases, but also doing great harm to inventors whose applications are necessarily delayed in the office, will be rendered needless.

The long pendency of a large number of applications before the office, by consuming its time in reconsidering them over and over, renders the period before a new application is reached for the first examination so long that the inventor frequently suffers great loss. The art may pass beyond his invention. He may lose his opportunity to sell. He dare not incur the expense incident to manufacture because of lack of protection. Having no indication of the attitude of the office his commercial interests, so far as that invention is concerned, are entirely halted.

The foregoing considerations are sufficient to show that the office has reached a condition that may be regarded as almost critical, and one that fully justifies it in adopting any means, not inconsistent with law and which will not injure the rights of inventors, that will enable the corps to reduce the number of times applications must be reconsidered, the period they may be kept pending, and the number awaiting action.

How is this to be done?

I shall not consider here possible future legislation, but will consider only what can be done with the means at hand.

The standard of work must be maintained. If the examination and adjudication of applications are to be worth while, are to possess any real value justifying the enormous cost involved, the work can not be slighted. Enough patents, more than enough, in spite of the best we can do, are declared invalid in whole or in part.

It is believed there is room for improvement in a conservation of energy.

I am reminded of a youth whom I knew in my younger days, who was wont to contest in foot races. When he was in full action, he had such a habit of waving his arms and moving his body up and down, that he had too little energy or time left for making progress forward. He always came in last. It has seemed possible the office sometimes progressed a little like this youth;

that it takes too many unnecessary actions, and the following suggestions are made, with a good deal of diffidence, in the hope that some economy of time and effort may be realized.

In the first examination of the application, if the action is to go to the merits, let it be a complete one.

In matters of form all objections should, so far as possible, be embodied in the first office letter, and be kept before the applicant in subsequent letters, if necessary, by simple reference to the first letter. This generally enables them to be all out of the way by the time the matters of merit are determined. I recall a letter received in a division in which I was an assistant many years ago, which read something like this: "The informalities and objections, which seem to increase in number with each reexamination of this case, have, we hope, all been cured."

Just a word here about formal objections. It is a well recognized fact that a great many are made that are subsequently waived. Bearing in mind the specification and drawing are addressed to those ordinarily skilled in the art, and they should be clear and understandable, yet as few formal objections should be made as is consistent with this ultimate end. Merely because the Examiner would state a matter differently, or could even state it better, were he writing the description, is no reason for requiring revision or change. If the matter is not incorrect, is not misleading, and the meaning of the inventor is plain, objection should, ordinarily, not be made. The Examiner should be sure his formal objections are really necessary. This saves time, argument and friction.

Before making a search for anticipatory art the application and the invention should be fully understood. It pays to take time to fully and completely comprehend the disclosure every time the case is acted upon. Then the first search should be as nearly complete as it is possible to make it. Not only the broadest and the narrowest claims should be held in mind in searching, but the invention, the thing itself, and its functions should be held in view. Where the invention is simple and fully comprehended a second search is rarely neces-

sary. In the more complex and extensive cases, however, second or even third searches are often necessary, it is true, but even here the gain of a complete search is proportionally great, and second searches will be proportionally fewer.

In regard to the search:

It is said all men are equal before the law. Some one has added, "this is true, however, only in theory." The same is true of claims.

A narrow claim limited to the precise embodiment of the invention disclosed is much less likely to be anticipated by anything found outside the class where the case belongs. A search on such a claim, therefore, should seldom be prosecuted beyond rather restricted limits.

Further, a narrow structural claim is seldom sued upon. An alleged infringer almost always adopts a modification and escapes the terms of such a claim. Also courts are very apt to sustain a specific claim where an infringer uses the very same thing on which it is based.

For these reasons, therefore, the narrow structural claim is not so important, is of less value and is much less frequently heard of after being once granted.

It is the broad claim, that is important. It is this claim that dominates an art, that spreads over the territory that others may seek to occupy. It is almost always this type of claim that is brought before a court, and by which the plaintiff seeks to restrain an alleged infringer who uses something different.

This type of claim is valuable, if it is good, and is harmful if it is invalid. The inventor should have it, if he is entitled to it, and it should be denied him if it is not rightly his. Such a claim should be more carefully weighed. The chance of anticipating such a claim outside the class where the case belongs is proportionally great. Before searching in any place, however, the Examiner should first weigh the question as to whether, if he found something there, it would be in an analogous art and would be a proper reference.

Where an incomplete search is made, the Examiner takes very nearly as much time to make it and fully as much to adjudicate the claims on the art he finds as if he made a complete search. The attorney, in response,

amends his case to define from the art found. The Examiner reviews the case, possibly months later and after he has forgotten both the case and how faithfully he searched it. He will usually research the ground previously covered as well as the additional ground he originally should have searched. Here is a great loss of time because he covers the same territory twice. The whole status of the case may now be changed. The first action taken in the case as well as the response of the attorney are rendered almost useless, possibly quite so. The application is now just where it should and would have been had a complete search been made at first. The practice of not making a full and complete search in the first instance has resulted in some attorneys making a practice of not attempting to really advance their cases until after the second or even third action by the Office. It is easy to see that time and energy are lost by such proceedings.

The temptation is great, where an Examiner is driven at top speed to get off his cases so as to make the necessary weekly gain, to make an incomplete search, hoping that when the case comes up again he will have more time. But he merely puts off the evil day, and in the end does more work and gives more time in reaching a final adjudication of a given case than he otherwise would. When this case is multiplied by a hundred or even a thousand, the Examiner is, like the youth in the foot race, wasting a great deal of energy and time. When the search has been made and the Examiner comes to apply his references and adjudicate the claims, some of them may be squarely met by some references. Little time need be wasted here. Some claims, however, may require a combination of references. Here it is almost always best to explain, in as few words as possible, just how the combination is made. Even where the invention is simple, this is often advisable. It puts the matter specifically and squarely before the applicant and he can and must either point out why the combination is not proper or amend the claims. Where a reference lacks an element recited in a claim or must be modified in any way, even if ever so slightly, it is well to make an explanation, in a few specific words,

just why the element of the claim which is not in the reference is regarded as insufficient, or just what the modification of the reference consists of. Where the subject-matter is more complicated, these explanations are correspondingly more advantageous. Where an attorney is known to be well skilled in the art, less explanation is necessary. Where an inventor is prosecuting his own case but exhibits sufficient knowledge of patent law to warrant the Examiner in the belief that suggestions will enable the inventor to conclude his case without the aid of an attorney, the explanations should be correspondingly extended and made as specific as possible.

This practice places before the inventor or his counsel all formal objections, the complete art, and the Examiner's interpretation of the relation of such art to the application. It is evident the termination of the prosecution of the case before the Examiner need not be greatly prolonged. In the reasonably simple cases, where the entire scope of the invention can be readily seen and comprehended, the third action by the Examiner with the same references before him should ordinarily be sufficient to conclude the case. There are some cases, where special reasons exist, in which further consideration will be necessary. The Examiner should exercise judgment in each case and not make any fixed rule. With the increase in the complexity and extent of the subject-matter of other cases, a reasonable increase in the number of actions is inevitable. Even in these cases, however, the early citation of the complete art, and the notation of all formal objections, will go far to reduce the number of reconsiderations and reexaminations, while in no manner preventing the applicant obtaining full protection for all he has invented.

Whenever final rejection is about to be taken, and whenever the condition of the case indicates such a course would be helpful, the Examiner should suggest in brief specific terms any amendment which he thinks would advance the case or render the claims allowable.

There is a class of applications that I can not approach without realizing I am standing on holy ground

These are the *old* pending cases. Some have been pending five, ten, fifteen, and even twenty-five and more years. I know of no one, or half a dozen, things that will bring about so great an improvement in the condition of work before this Office as the conclusion of the pendency of these cases. Over and over again have they been examined. Unusually they have been amended once a year, some are so old that they fall under the old law of requiring amendment only once every two years. For a variety of reasons, some good and some bad, these cases have been kept in the Office, growing older, their records larger and more cumbersome, and adding very greatly to the labors of the examining corps. The annual amendments made to them have not been calculated or intended to really advance them toward a conclusion. The Examiners, too, have in the past despaired of making much advancement, and their annual actions have sometimes been less complete than they might have been. Until a comparatively recent time the Examiners have felt helpless to solve this problem.

Section 4904, R. S., states:

“Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejections, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a reexamination of the case.”

Rule 68 is based on this statute and provides that an applicant “may amend as often as the Examiner presents new references or reasons for rejection.”

Section 4909, R. S., states:

“Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected . . . may appeal from the decision of the Primary Examiner.”

Rule 134, which is based on this statute, specifies:

“There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, . . . before the case can be appealed to the Examiners-in-Chief.”

These two sections of the statutes and these two rules have constituted the basis for a practice that existed from the adoption of the law, to almost the present time, and which was to the effect that an Examiner could never close the prosecution of a case before him so long as an applicant presented at each reconsideration at least one claim that was different in scope from any previously considered. When it is recalled that an application may have anywhere from half a dozen to several hundred claims, it is at once apparent any skilled attorney could, under such practice, keep an application pending so long as he desired.

This has been the cord that tied the hands of the Examiners and has rendered possible this great accumulation of old cases. By the decision in *Ex parte* Miller (139 O. G., 730), the cord was severed and the examining corps was relieved from this helpless condition which had become well-nigh intolerable. That decision is based upon the view, which is clear enough, that the statute does not contemplate nor require the repeated reconsideration of an application, dependent only upon the will of the applicant or the skill of his counsel in varying the language used to define the invention.

That decision held:

“Where the Examiner has held that certain claims are unpatentable and has fully advised the applicant of his reason for such holding and the latter, after reasonable prosecution of the case, has failed to so amend as to necessitate the citation of new references and has been unable by argument to convince the Examiner that he was in error, an issue is reached, and the Examiner is justified in refusing to accept further amendment and in finally rejecting the claims then of record in the case.”

This ruling, which has been subsequently fully upheld in *Ex parte* Perry (140 O. G., 1001), a second *Ex parte* Miller (150 O. G., 827), and *Ex parte* Lang (153 O. G., 1081), constituted a very marked departure from, the old practice, in that it transferred from the applicant to the Examiner, the power to bring the prosecution of an application before the Examiner to a close. This at once made it possible for the corps to put a check upon what was becoming, in some instances, a grave abuse of the latitude of the Office procedure.

In explaining this holding of *Ex parte* Miller, Perry, etc., Mr. Billings pointed out that while it was true Rule 68 provided that an applicant had a right to amend as often as the Examiner presented new references or reasons, this rule also made it incumbent upon the applicant in amending to "clearly point out all the novelty which he thinks the case presents in view of the art disclosed." It is a natural deduction that if an applicant really does this, when he amends, a condition will ordinarily be reached in one or two actions where the Examiner has no new references or reasons to present.

Still the Examiners are not out of the wilderness. These old cases are often complex and extensive in subject-matter. It is not difficult, and the more complicated they are the easier it is, in amending them, to drive the Examiners to "new references or new reasons." This precludes the application of the Miller doctrine, in such instances, and brings them under Rule 68, giving applicants the right to further amend and argue.

Many inventors and attorneys, since the real condition of the Office and the possibility of stringent legislation being enacted have been made known to them by the Commissioner, have recognized the necessity, in the interests of all, for prompt action looking to a bringing to a conclusion these old cases, and have presented carefully prepared amendments which have enabled the Office to considerably reduce the number of such cases. In passing it is worthy of remark that it is surprising and also gratifying to note the extent to which it is possible to advance one of these old cases,

by a carefully prepared amendment, without sacrificing any of the inventor's rights.

There are, however, quite a number of these old cases where financial and other reasons impel the applicant to seek a further delay. Sometimes large rival concerns have many applications pending relating to a general subject or art, and are involved in many interferences which delay their cases in the office. Their interests are financially very great. Millions have been and are being expended in the production and perfection of these inventions. The securing of patents which will protect the owners in the use of such inventions is vital. To take out some of their patents, while so much is being litigated, and while rival concerns still have pending cases relating to analogous subject-matter, would be productive of enormous loss. These considerations must be given due weight.

Some cases, in which a plea for further delay is made, it would appear that counsel merely hopes, by repeating and impressing his arguments in various forms, to finally win over the Examiner.

Whether rightly or not a good many attorneys do not wish to be denied the privilege of impressing their arguments on the Examiner over and over again. This should not be necessary. If the applicant and the Examiner fully understand the case and the art, there is no necessity for this repeated review.

Some few of these applicants whose cases have been long pending are undoubtedly actuated by motives similar to those which actuate the citizen who does not want to enlist. They hope that, by some hook or crook, to keep their cases going a year or two longer and by that time, they are trusting, the war may be over, and they will finally escape the firing line.

So grave has become this evil of long pending cases, so great is the inertia of this load, so clearly is a remedy necessary to the preservation of our patent system and the interests of inventors and the public alike, that the Commissioner has seriously set about the work of bringing these cases to a conclusion. Results are plainly apparent, but the end has not been reached. Eager to afford these tardy prosecutors an additional oppor-

tunity to protect their inventions as he is, yet he has firmly impressed upon these applicants that he will not permit any needless delay. To that end he has sought to limit amendments to those that will not longer delay the case. He has taken over the personal consideration of all amendments to applications pending five years or over.

“If an amendment is filed in such a case which puts it in condition for allowance or final rejection, it will be accepted, but if the amendment does neither of these two things, as, for example, when an applicant undertakes to put in new claims the amendment will be considered without being entered and the applicant notified by the Commissioner of the character of a supplemental amendment which will put the case in condition for allowance or final rejection. If the applicant fails to file such supplemental amendment, the amendment which has already been filed will be refused admission and the case when the year is up will be held abandoned.” (Commissioner’s address to the Patent Bar Association, Chicago, Ill., Nov. 19, 1914, *Sci. Am.* Dec. 12, 1914, p. 491.)

It will be readily apparent that this plan is going to bring the prosecution of this class of cases to a close, yet there is given each applicant, after all the opportunities he has already had, a still further opportunity to draw his claims to cover what he believes he has invented, and if he can not agree with the Examiner to obtain the judgment of the higher tribunals. Even where an applicant seeks to expand his case anew, at this late date, by claiming something he has not claimed before, thereby necessitating “new references or reasons of rejection” the office goes so far as to examine this new amendment and indicate to him what part, if any, is allowable, and gives him an opportunity to incorporate this part in his patent.

It would seem that this plan is as liberal as is possible, consistent with the end had in view, and that

no one can justly claim his rights have not been safeguarded.

Returning to the consideration of applications generally, there is thought to be some loss of time due to what may be called debatable rejections. There is no need to discuss here practices that are settled, grounds of rejection that are fixed, but there are several grounds of rejection that are very frequently used and possibly a little more uniformity throughout the corps would be an economy of time.

I have read office letters rejecting claims on the ground they recite aggregations, where the claims would seem to be for true combinations, which were merely old combinations. Perhaps the ultimate end, the amendment of the claim, is finally reached, but often such rejection precipitates argument and needless waste of time.

While the United States Supreme Court in the decisions of *Hailes vs. VanWormer* (20 Wall., 368) *Florsheim vs. Schelling* (53 O. G., 1737); *Adams vs. Bellaire Stamping Co.* (57 O. G., 1280); *Richards vs. Chase Elevator Co.* (71 O. G., 1456); *Reckendorfer vs. Faber* (92 U. S., 347), and the U. S. C. C. of Appeals, Seventh Circuit, in the case of *Deere and Co. vs. Rock Island Plow Co.* (82 O. G., 1561), discuss very fully this question of aggregation versus combination, the following from a decision of the Examiners-in-Chief, made in a recent case, is so pertinent that I take the liberty of quoting it.

"In the first place, it should be observed that the problem of whether a given claim sets out a patentable combination or an aggregation is not to be solved by the citation of references. A true combination of elements, working together under a cooperative law, and producing a given result, remains a true combination for all time, irrespective of the antiquity of its original creation, . . . the ground of rejection which is proper is not that the combination is illegitimate, but that it is old."

The question settles itself by determining whether the elements named in the claim *cooperate, work to-*

gether, though not necessarily simultaneously, but so that by virtue of what they *together* accomplish, a different result is secured from what would be secured if the elements were used separately. As was said by the Supreme Court in the *Reckendorfer vs. Faber* case, *supra*: "There must be a new result produced by their union; if it is not so it is only an aggregation of separate elements." This case was based on a lead pencil with a rubber eraser at one end. The court aptly pointed out that the rubber did not perform any function in connection with the writing. It remained inoperative, and could as well be absent. So in erasing the marks, the pencil remained inactive, did nothing, could as well be absent. These two things never worked together, and never accomplished any joint function or result.

A second ground of rejection that gives rise to much trouble and creates considerable argument and friction is applied to claims for alleged machine or apparatus methods or processes as distinguished from chemical and article methods.

It is not the purpose of this paper to discuss this class of claims from an academic view point or quote from the many learned expounders of this subject. Further, the matter has been ably treated in a previous paper presented to this body. It is desired here, however, to make, if possible, a few practical, rough suggestions which may be helpful in determining whether a claim is for a true method or for the function of the apparatus.

The authorities are pretty well settled that the old definition of the United States Supreme Court in *Cochrane vs. Deener* (11 O. G., 687), stands as about the most tangible and workable definition yet given. There must be present an act or a series of acts and they must be performed upon something to change it to a different state or thing. Remembering that only so-called machine processes are under consideration, and that the main difficulty is to distinguish them from the function of the machine or apparatus, it may be helpful to first note that the claim does not recite specific means or mechanism. If this specific mechanism is necessary to

support the alleged steps, it is probable these latter are inevitably the function of such mechanism. It is well to try to discover what the step is or what the series of steps are; to recognize them in the language used in the claim. Then the thing they are performed on should, if possible, be identified. This may be the electric current, as in the Telephone Cases (126 U. S., 1532), and *O'Reilly vs. Morse* (15 Howard, 62). If these can be identified it is generally easy enough to determine whether the steps are so tied to specific mechanism as to be but its function, or whether they can be performed, within the language or terms of the claim, by different mechanisms differently organized, or, if the nature of the steps permit, by hand. While no function can be carried out without some means to do it, yet the function must be distinct from the means, from its practical embodiment, and its immediate effect. There must be some other means, with some other embodiment, to which this function is common. Robinson on Patents cites the example of smoothing something, and explains how different things, like running water, a single knife, a sliding weight, a group of revolving knives, may perform this function. The machine step of smoothing, therefore, is performed by some means, but is not a function of any specific means, but is a function of several different mechanisms or means, and is a proper step of a method. Again, this author cites the function of exploding or igniting a substance, and notes this may be accomplished by different means, as a red hot iron, a flame, the electric spark, etc. The function is common to these different devices, and also these different devices can operate without producing the function of exploding or igniting a substance. These things have separate existence, the means is a permanent thing and the function is a transient, intangible thing.

If these principles concerning this class of claims can be had in mind considerable time can be saved, both in determining when a claim should be rejected and in making suggestions to an applicant who discloses but is not succeeding in properly claiming a method of this character.

There is another ground of rejection which is not

uniformly interpreted throughout the office. This is that the claim is functional in that it fails to recite the means for accomplishing the results specified. Sometimes the mere length of a functional statement, predicated upon a properly included means, is made the basis of rejection. Obviously this is in error.

The so-called "whereby" clauses, and those beginning with the word "adapted," are often found to be unsupported by the inclusion in the claim of the means for accomplishing these functions. In such cases, the means should be included. But the statement of means, mechanisms, or devices, accompanied by their functions, constitute the long accepted manner of drawing claims for mechanical inventions. If the elements are recited, the length of the functional clause is of no moment. If recited generically, the claim is merely broad and if otherwise patentable is allowable.

There is a class of claims wherein the entire invention is recited in the generic words "means," mechanism, or devices, accompanied by the functions of such means, or mechanism, without defining anywhere in the claim the structural nature of the means or mechanisms or devices. Of course these claims are as broadly drawn as possible, and in language, cover any and all means for accomplishing these functions, cover means substantially different.

There are at least two views held in this Office as to such claims. One is that they are too broad, are broader than the invention, and that they are therefore unpatentable. Beside several Commissioner's decisions there are decisions of the United States courts which look to the support of this view. (*Consolidated Electric Light Co. vs. McKeesport Electric Light Co.*, U. S. Supreme Court, 159 U. S., 465; *Madison vs. Campbell*, U. S. C. C., 78 Fed. Rep., 910; *Wilson Trolley Catcher Co. vs. Frank Ridlon Co.*, U. S. C. C. of Appeals, First Circuit, 159 O. G., 244; *Ex parte Denning*, 26 O. G., 1207; *Ex parte Knudson*, 72 O. G., 589; *Ex parte Pacholder*, 51 O. G., 295.)

The other view is that no matter what the breadth of terms used in the claim, an inventor is only entitled to what he has invented and produced, and substantially

its equivalents and, if the invention is of a pioneer character, the range of equivalents will be proportionally broadened when, on proofs, this is made to appear. These claims, if they can not be met by references, are, therefore, to be allowed.

The cases where courts have held such claims void on this ground alone, of being broader than the invention, are so few, and modern judges are so prone to construe claims to save a really meritorious invention that the question is one of no very great moment.

There is one other ground of rejection of which mention may be made. This is upon the so-called Hawley doctrine. This doctrine was first emphasized and made prominent in the decision of the Court of Appeals of the District of Columbia, *In re Hawley* (121 O. G., 691), although it is but a repetition of the substance of *Ex parte Griffith* (85 O. G., 936). This holding has been confirmed by the same court *In re McNeil* (20 Ct. App. D. C., 294), and *In re Ratican* (162 O. G., 540). Later the Circuit Court of Appeals, Third Circuit, held a claim void on this ground in the case of *Langan vs. Warren Axe and Tool Co.* (166 O. G., 986).

This doctrine is to the effect that where the combination recited in the claim is old and the distinction over the prior art resides in one element only of the combination and does not result in a modified or improved action of the other elements of the combination the claim is unpatentable and should be limited to the element *per se*.

The doctrine has been quite extensively applied by some Examiners and but little used by others. It is a proper ground of rejection when properly applied.

It is believed the vital determining factor is whether the element which has been improved constitutes a complete thing itself capable of separate and independent use, or one that has acquired a distinct status in the arts and trades. If neither of these conditions is present, it is doubtful if the doctrine applies.

In the Hawley case, the improvement was in a tape to be used in a recording mechanism. The latter was not modified in any way and was admittedly old. Obviously the tape fulfilled the conditions above noted.

No one would buy a new recorder every time he used up the tape, any more than one would buy a new typewriter machine every time he used up his supply of paper. The tape was clearly a separate subject of invention, a separate article of manufacture and sale and should not have been claimed in combination with the old recorder.

In the Ratican case, the invention resided in a nozzle for a street washing machine, otherwise old. It is plain enough the nozzle was a separate, complete unitary thing, did not in any manner change the operation of any part of the machine, was a separate subject of manufacture and sale. Obviously no one, wishing, a new nozzle, would purchase an entire new street washing machine.

The case of *Langan vs. Warren Axe and Tool Co.* is a very much more important one. The decision was rendered by the United States Circuit Court of Appeals, the patent was already granted and the claim was held invalid.

There exists some difference of opinion as to whether this ruling may be said to uphold the so-called Hawley doctrine. There was a very plain discrepancy between the statement of invention in the specification and the structure covered by the claim. The specification made it very clear that the patentee had invented a new kind of grab-hook, and merely described how such hooks were to be used, in pairs, with a draft device in skidding logs. The claim, however, was for the combination of a pair of hooks with the draft device. The novel details of the hook were, however, specified in the claim.

The court emphasized this lack of consistency between the statement of invention in the description, which was that applicant had merely improved the hook, and the statement of the claim, and in doing so said:

"There is no suggestion that any part of the patentee's invention resides in the combination of the grab-hooks and the draft appliance. The connection between the grab-hooks and the draft appliance by means of links or chains is mentioned, but such connection was as old

as grab-hooks themselves, and the patentee expressly states that his invention consists, not in any such combination, but in the particular and peculiar form of hook. . . . Not only is the claim for a combination foreign to what is set forth in the specification, but there is no new coaction or cooperation of the elements of the combination. The grab-hooks and the draft appliance of the patent, in combination, coact as grab-hooks and draft appliances have always done. The grab-hook of the patent, by reason of its peculiar construction and form, is very probably an improvement of no little utility. But the patentee can not, merely because of this fact, have a patent for a combination, which shall have, as one of its elements, a pair of such grab-hooks. He did not invent the combination. He invented, if he invented anything, an improved grab-hook."

On being urged by counsel to construe the claim as for the hook alone, the court said:

"Manifestly, we can not so construe it. The claim is for a combination of grab-hooks, of a peculiar form, and a draft device. We are not at liberty to distort its plain language."

Whatever may be the view as to the general effect of this decision, the fact is plain enough that this patentee lost his invention because he did not claim the hook alone, because he claimed it in the old combination which it did not affect in any new way.

It is hardly to be presumed the court would have found the claim valid if the patent itself had not contained the inconsistencies noted by the court, provided the proofs adduced at the trial had been such as to set forth this same state of facts.

This decision is sufficiently suggestive, that in plain cases, the doctrine should be applied.

In the usual house door-bell arrangement, in use all over this city, there is a push button switch, a bell, a battery, and the wire conductors. Each is a separate subject of

invention and has a distinct status in the art and trades. An inventor may improve the bell, the switch, the battery, or the wires. None of these improvements would affect the mode of operation of the other elements, and the claims should be confined to whichever element—the switch, the bell, the battery or the conductors—that is improved. A combination claim should not be allowed.

But if an invention is made in a part of the switch, or the bell, or the battery, which part has no general utility, no separate status, it is doubtful if the Office is warranted in objecting to a claim that includes the entire switch or the entire bell, or battery. These are unitary things, and to carry the Hawley doctrine to their details of structure constitutes a refinement of procedure that can only result in harmful confusion, friction and delay.

An adherence to this firmer ground in the application of this doctrine will in no way endanger the validity of any grant, but will save much time and needless argument.

In conclusion I leave with you, therefore, this suggestion:

If this great and ever-increasing quantity of work is to be carried on at all, if there is not to be such an accumulation of pending applications as will cause the whole examining system to fall of its own weight, there must be a greater uniformity of practice on the part of the various Examiners, there must be fewer needless objections, fewer needless rejections, better first searches, more carefully considered actions, both on the part of the Examiners and on the part of the applicants as well, and a more prompt conclusion of the pendency of cases before the corps.

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An Applicant's Statutory Remedies from Adverse Decisions

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An Applicant's Statutory Remedies From Adverse Decisions

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An applicant's remedies from adverse decisions are many. They comprise, in succession, an appeal from the decision of the Primary Examiner or the Examiner of Interferences to the Board of Examiners-in-Chief, to the Commissioner and to the Court of Appeals of the District of Columbia, which may then be followed by a bill in equity under section 4915, Revised Statutes, in one of the United States district courts and an appeal to the proper circuit court of appeals.

The reasons and circumstances which caused the enactment of laws providing for this elaborate system of remedies are interesting.

The first statute providing an appeal from a decision in a patent application is contained in the Act of 1836, but a brief survey of our patent system as it existed prior to 1836 is instructive and will assist in understanding the system of appeals finally established.

The Act of 1790, creating the patent system of the United States, authorized the "Secretary of State, the Secretary of the Department of War and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to be tested by the President of the United States." Thomas Jefferson was the Secretary of State while this act was in force. He is said to have inspired it, to have taken great pride in it and to have given personal consideration to every application. It

is related that when an application for patent was filed, he would summon Henry Knox, Secretary of War, and Edmund Randolph, Attorney-General, and that these three distinguished officials would examine the application with great care.

The granting of a patent at this time was quite an event in the history of the State Department where the clerical work of issuing the patent was performed. The law was construed to give this tribunal authority to refuse a patent if the invention did not come up to its standard of usefulness and importance. This tribunal was absolute in its authority and there was no appeal from its decisions. It is recorded that its members scrutinized the specifications and claims so critically and rigidly that most of the applications were rejected. Only three patents were granted during the first year and the total issue before the act was repealed in 1793 was only fifty-five. The severity of their examination and their lack of sympathy with inventors caused great dissatisfaction.

The Act of 1793, repealing the Act of 1790, took away this power of rejection and confided in the Secretary of State, alone, the duty of issuing patents. The certificate of the Attorney-General, however, was required as to the correctness of the forms and the signature of the President of the United States was still necessary. The patent issued as a matter of course if the application was in proper form and the required fee was paid. In other words, the issuing of patents was placed upon a recording or registration basis. This act also created a Board of Arbitration to pass upon interfering applications, one member of which was chosen by each of the applicants and one by the Secretary of State. Their decision was final and if either party refused to go into the arbitration, his opponent was given the patent.

It is recorded that for the twelve years prior to 1802, the entire work of the Patent Office was performed by a single clerk in the State Department and that all of the records filled but a dozen pigeon holes.

In 1802 Dr. Thornton was appointed a clerk in charge of the issuing of patents. Later he was given the title of "Superintendent." He was a man of scientific attainments and is one of the interesting characters connected

with the early history of our patent system. He exercised autocratic control over its affairs for twenty-six years.

Under the Patent Act of 1793 no investigation was made as to the novelty or utility of the invention, the oath of the applicant that to the best of his knowledge the invention was new, being accepted as sufficient. Under this practice, the patentee received his patent with only such assurance as to its validity as he might gain from his own investigation. Necessarily, the patent was of small commercial value. The total number of patents issued prior to 1836 was only nine thousand nine hundred and fifty-seven (9,957).

The Act of 1836 reorganized the Patent Office and inaugurated practically the present system of granting patents only after examination has shown the invention to be new and useful. This change in the patent system introduced by the Act of 1836 is referred to in the Patent Office Report for 1848, page 84, as follows:

Perhaps the most important feature of this law is that which relates to the examination to which applications are required to be subjected. Prior to its passage the examinations consisted merely in a comparison of the specification, drawings and model, to ascertain that they agreed together and with the claims made; but the law of 1836 required the examination to enter into the questions of novelty, utility, and priority of invention—a provision which largely added to the labors and responsibility of the office.

The Act of 1836 made the Patent Office a separate bureau of the State Department and provided a head therefor, designated the Commissioner of Patents. It provided also for a chief clerk, an examining clerk, two other clerks, one of whom was to be a competent draughtsman, a machinist and a messenger.

Section 7 of the Act of 1836 provides, *inter alia*, that when an application is filed—

. . . the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination,

it shall *not* appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. . . .

The words "sufficiently useful and important" are the identical words that were contained in the Act of 1790. In this respect it is, therefore, a return to the practice under the original Patent Act of 1790. It indicates that if the practice under the latter act had been unsatisfactory, the practice under the Act of 1793 had proved even more unsatisfactory. Instead of the three secretaries of departments, however, it is now the newly created official, the Commissioner of Patents, who was to pass upon the applications. Moreover, to prevent an arbitrary exercise of power certain restrictions were placed upon the authority of the Commissioner and an appeal was provided from his decisions. The system inaugurated by the Act of 1836 remains our system today with but few changes in its essential features. The machinery for carrying it into effect has been expanded and improved in an endeavor to keep pace with the enormous growth of business.

Section 9 of this act fixed the application fee for citizens of the United States and aliens who had resided here for one year, at \$30; for subjects of Great Britain, \$500, and for all other persons, \$300. No further or final fee was required and a rebate of \$20 was given if the application was withdrawn after rejection. Section 12 of the Act of 1837 fixed the amount returned to the applicant under these circumstances at two-thirds of the application fee. This schedule of rates remained in force until the Act of 1861 when the discrimination in favor of citizens of this country was abolished and the present schedule of fees was established.

APPEALS FROM ADVERSE DECISIONS OF THE COMMISSIONER.

The Patent Act of 1836 (5 Stat., 117) providing for a Commissioner of Patents and for an examination as to the novelty and utility of the invention, also provided for an appeal from the adverse decision of the Commissioner to a board of examiners. This board was to consist of three disinterested persons appointed by the Secretary of State, one of whom at least, was to be selected "if practicable and convenient, for his knowledge and skill in the particular art, manufacture or branch of science to which the alleged invention appertains." The applicant was required to pay a \$25 appeal fee. Each member of the board was to receive in each case a compensation not to exceed \$10. Section 8 of the act provided for interference proceedings between pending applications, or a pending application and an unexpired patent, and an appeal from the decision of the Commissioner on priority on like terms and conditions to those mentioned above.

The Act of 1839 (5 Stat., 353) substituted in place of this board of examiners, as the appellate tribunal, the Chief Justice of the District Court of the United States for the District of Columbia who was to be paid annually out of the Patent Fund in consideration of such duties, the sum of \$100. The reason for this change in the appellate tribunal is set forth in the report of the Commissioner of Patents for 1860, as follows:

But this board, temporary in its nature, its members being appointed for each occasion, and their services inadequately remunerated, experience proved to be an entire failure; and hence, by the eleventh section of the Act of 1839, it was abolished; and the appellate jurisdiction transferred 'to the chief justice of the District Court of the United States for the District of Columbia.' This was a step in advance. It was a decided improvement upon the original tribunal, and gave rise to no complaint, until the year 1850, when Chief Justice Cranch announced to this office that he was unable by reason of the infirmities of age, to discharge the duties imposed upon him by the acts of Congress.

Under the law of 1839 it was the duty of the Chief Justice, after a hearing of the case, to return the papers to the Commissioner together with a certificate of his proceedings and decision which the act directs shall be entered of record in the Patent Office and shall govern the future proceedings in the case.

The Act of 1852 (10 Stat., 75) provided that appeals from the Commissioner of Patents "may also be made to either of the assistant judges of the Circuit Court of the District of Columbia," and further provided "that in case appeal should be made to the said Chief Judge or either of the said assistant judges, the Commissioner of Patents shall pay to such Chief Judge or assistant judge, the sum of \$25 required to be paid by the appellant into the Patent Office." This act, giving concurrent jurisdiction to the assistant judges was passed by Congress on account of the infirmity of the Chief Justice.

As stated above, Chief Justice Cranch notified the Patent Office in 1850 that he was unable to hear any patent appeals on account of the infirmities of age. This continued until his death in 1855. The injurious consequences resulting from this state of affairs are set forth in the Commissioner's Report for 1860. It appears that in *ex parte* appeals, the appellant was unable to have his case heard, while in *inter partes* cases, the defeated party by an appeal was able to hold up indefinitely the issuance of the patent to the successful party. Even after the Act of 1852, the defeated party was able to do this by taking his appeal to the infirm Chief Justice. Commissioner Hodges attempted to prevent this injustice by ordering that where appeals had been taken to the Chief Justice, the appellants should transfer them to one of the assistant judges and that all appeals thereafter should be taken to one of the latter judges. Attorney General Cushing, however, held that the Commissioner had no authority to do this and that Congress alone had power to remedy the evil (6 Opinions, Attorney General, 39).

The reason for the change made by the Act of 1852 in the compensation allowed the judges from a hundred dollars a year to twenty-five dollars in each case is not clear. The evil resulting therefrom, however, is set

forth in the annual report of the Secretary of the Interior for 1857, as follows:

The appellant not only selects the judge who shall try the case, but also pays the fee of twenty-five dollars allowed him. The amount of compensation thus received will depend upon the number of cases brought before him; that number will inevitably be influenced by his course of decision. The judge is thus placed in a position of embarrassment, if not of humiliation, alike to be deplored by himself and the country.

This matter is again referred to by Commissioner Fisher in his annual report for 1869 where he recommends doing away with appeals to the court from decisions of the Commissioner of Patents and advances ten reasons in support of his recommendation. The fourth and eighth of these reasons read as follows:

(4) The allowance of a fee of twenty-five dollars for each appeal has a tendency to encourage appeals. When there are frequent reversals of the Office, attorneys are inclined to appeal from every decision; and the more frequent the appeal, the larger the aggregate of fees paid to the judge; in this connection, as a simple matter of fact, it may be mentioned that during the administration of my immediate predecessor, forty-two cases were appealed from him to one of the judges, and of these, thirty-eight were reversed and only four affirmed.

(8) Nine-tenths of the cases appealed involve mere questions of fact, upon which the judgment of the primary examiner is as likely to be correct as that of the Commissioner or judge.

Commissioner Fisher took a conspicuous part in framing the Act of 1870 and it was undoubtedly largely due to his recommendation that the appellate practice from the Commissioner's decisions, while not entirely abolished, was modified by that act.

Section 48 of the Consolidated Patent Act of 1870 (16 Stat., 198) provides:

And be it further enacted, That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

It should be noted that this act eliminated the appeal from the decision of the Commissioner in an interference case and provided for the hearing of the appeal in *ex parte* cases by the Supreme Court of the District of Columbia, sitting in banc, or general term, this court being the successor of the old Circuit Court of the District of Columbia.

Section 4911 of the Revised Statutes approved June 22, 1874, reads the same as section 48 of the Act of 1870.

The last change in the appellate tribunal having jurisdiction of appeals from decisions of the Commissioner is contained in the Act of February 9, 1893, creating the Court of Appeals of the District of Columbia (27 Stat., 434). This act vested in the above-mentioned court the determination of appeals from the Commissioner formerly vested in the general term of the Supreme Court of the District of Columbia. It also restored the appeal from the decision of the Commissioner in an interference case, which, as noted above, existed prior to the Act of 1870, by providing that "in addition any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

This court construes the statute as permitting appeals from the decision of the Commissioner in interferences only in cases where there has been a final determination of priority, and holds that its jurisdiction is limited strictly to the question of priority. In numerous decisions it has refused to consider the patentability of the issue in an interference case or to entertain an appeal from a Commissioner's decision on any preliminary or interlocutory matter arising in the interference.

In *ex parte* cases the court holds that the right of appeal is confined to those cases in which an application

for patent has been finally denied by the Commissioner.

The jurisdiction of this court in patent applications is set forth succinctly in its decision, *In re Fullager*, 138 O. G., 259; 32 App. D. C., 222, as follows:

The jurisdiction of this court to entertain appeals from decisions of the Commissioner of Patents, in proceedings relating to patents, is limited to two classes of cases. The first is where the claims of an applicant for a patent, or the reissue of a patent, after having been twice rejected, have been finally rejected on an appeal to the Commissioner in due course of procedure. The second is where on an appeal to the Commissioner in an interference proceeding there has been a final decision of priority in favor of one of the parties thereto (R. S., secs. 4909, 4910, 4911; *Westinghouse vs. Duncan*, C. D., 1894, 170; 66 O. G., 1009; 2 App. D. C., 131, 132; *Allen vs. Lowry*, C. D.; 1905, 643; 116 O. G., 2253; 26 App. D. C., 8, 17, 26; *Union Distilling Co. vs. Schneider*, C. D., 1907, 613; 129 O. G., 2503; 29 App. D. C., 1).

Examination of this decision shows that Fullager was involved in an interference with one Emmet; that in said interference a decision had been rendered by the Commissioner affirming the decision of the lower Patent Office tribunals dissolving the interference upon the ground that Fullager had no right to make the claims of the issue, since his verified showing was insufficient to warrant granting him a reissue patent. From the decision of the commissioner, Fullager attempted to appeal *ex parte* and the court held that it has no jurisdiction to entertain an appeal from a decision of the Commissioner on a motion to dissolve an interference under such circumstances.

In passing upon the question of its jurisdiction the court considers the effect rather than the form of the Commissioner's order or decision from which appeal has been taken. This is set forth in *Moore vs. Heany* (149 O. G., 831; 34 App. D. C., 31), where the court was considering whether an appeal would lie from a

Commissioner's order striking an application from the files, as follows: "A court would look to the substance, the necessary effect and operation of the order rather than to its formal recital merely."

Examination of a few cases will show how this principle has been applied by the court. These cases also show that although the court has indicated in the case of Fullager, *supra*, that its jurisdiction does not attach until after the case has been appealed in succession from the Examiner to the Examiners-in-Chief and to the Commissioner, decisions in the case by the tribunals below the Commissioner have not been uniformly insisted upon.

In the case of *In Re Selden* (164 O. G., 741; 36 App. D. C., 428), the claims had already been allowed by one primary examiner, and the application was ready for issue, subject to some slight amendments. Upon compliance by the applicant with these suggestions the successor of the first primary examiner called the case to the attention of the Commissioner and stated that he proposed to reject three of the twenty-four claims as not patentable. The Commissioner, upon consideration of the application, held it abandoned for lack of sufficient prosecution within the statutory period of two years.

An appeal from the Commissioner's decision was entertained, the court holding that the action of the Commissioner was in effect a rejection of the claims.

A similar holding was made by the court in the case of *Mattulath* (179 O. G., 833; 38 App. D. C., 497) where the Examiner's holding that an application was abandoned was affirmed by the Commissioner on petition from the Examiner's ruling.

In *Cosper vs. Gold and Gold* (151 O. G. 194; 34 App. D. C., 198), the court dismissed an appeal taken from a decision of the Commissioner dissolving an interference because one of the parties had no right to make the claims of the issue, upon the ground that the decision of the Commissioner was interlocutory and not a final award of priority. After the return of the case to the Commissioner, he set aside his decision dissolving the interference and entered an award of priority. Upon an

appeal from that judgment the court entertained the same and passed upon the question of priority, notwithstanding no decision on the question of priority had ever been rendered by the Examiner of Interferences (*Cosper vs. Gold and Gold*; *Cosper vs. Gold*, 168 O. G., 787; 36 App. D. C., 302).

Townsend vs. Thullen (142 O. G., 1116; 32 App. D. C., 575), was a case where the Primary Examiner granted a motion to dissolve the interference as to certain counts on the ground that Townsend had no right to make them. His decision was affirmed by the Examiners-in-Chief and by the Commissioner. An appeal was taken to the court and was entertained, the court holding that the necessary result of the Commissioner's action was an award of priority to Thullen.

In the *New Departure Manufacturing Company, vs. Robinson* (188 O. G., 1056; 39 App. D. C., 504), the Examiner of Interferences directed the attention of the Commissioner to a prior interference and the Commissioner dissolved the interference upon the ground that the question of priority was *res adjudicata* by reason of the final decision in the prior interference. An appeal to the court was entertained, notwithstanding no decision in the proceeding had been rendered by any of the tribunals subordinate to the Commissioner.

In the case of *Moore vs. Chott* (192 O. G., 520; 40 App. D. C., 591), the Examiners-in-Chief reversed the action of the Primary Examiner rejecting the claims of the application. The Commissioner took up the case under his supervisory authority and refused the patent. The Court of Appeals of the District of Columbia held that the Commissioner acted within his authority and that the applicant's remedy was by regular appeal and not by a writ of mandamus. An appeal to the United States Supreme Court was dismissed for lack of jurisdiction (*Chott vs. Ewing*, 215 O. G., 1264; 237 U. S., 197).

In *Mann vs. Brown* (214 O. G., 1026; 43 App. D. C., 457) where an interference was appealed to the Commissioner and he dissolved the interference in view of a reference that applied to the party Mann and entered an order in his application refusing him a patent and

Mann appealed, the court held that the proceeding can not be changed from one statutory class to another and dismissed the appeal.

In *Carlin vs. Goldberg* (236 O. G., 1222) a motion to dissolve on the ground that Carlin's structure was inoperative had been granted by the various Patent Office tribunals. On petition of Carlin the Commissioner changed his decision to one awarding priority to Goldberg on the ground that Carlin had no right to make the claims. The court held that the Commissioner had no jurisdiction to convert an appeal on the motion to dissolve into an appeal on priority. It attempted to distinguish from the *Cosper vs. Gold* case, *supra*, by stating that in the latter case the interference had been tried and was ripe for an award of priority and that the issue of priority turned upon Cosper's right to make the claim, but that in the case at bar a reversal of the Commissioner would operate as a grant of priority to Carlin and Goldberg would be deprived of his day in court on that issue.

No appeal lies from the decision of the Court of Appeals of the District of Columbia on an appeal from the Commissioner of Patents (*Frasch vs. Moore*, 137 O. G., 230; 211 U. S., 1; *Johnson vs. Muesser*, 145 O. G., 767; 212 U. S., 283; sec. 250 of the Judicial Code, and *Chott vs. Ewing*, 215 O. G., 1264; 237 U. S., 197).

APPEALS TO THE EXAMINERS-IN-CHIEF AND TO THE COMMISSIONER.

The first statutory provision for appeals within the Patent Office is found in the Act of March 2, 1861, which provides for an appeal from the Primary Examiners to the Examiners-in-Chief and from the Examiners-in-Chief to the Commissioner. The reasons and the conditions in the Patent Office which led to the enactment of this statute legally creating the lower appellate tribunal and providing for appeals to the Examiners-in-Chief and to the Commissioner may well be considered together.

At the time of the passage of the Act of 1836 creating the Patent Office as a separate bureau of the State Department and for a long time thereafter, the amount of

business transacted by the Office was small and did not require the establishment of an appellate tribunal within the Office although, as heretofore noted, the act did provide an appeal from the decision of the Commissioner. For example, the number of applications filed in the year 1840 was 765 and the number of patents granted, 473. In fact, the establishment of the Patent Bureau by the Act of 1836, with an office force of seven persons, as stated above, was generally regarded as extravagant. At that time the number of applications was so small that the Commissioner was presumed to examine them himself or to have the examinations made directly under his eye by the examining clerk. For a long time thereafter, the amount of work was not too great for the Commissioner personally to supervise it.

The number of examiners did not exceed four until the year 1848, when the force was increased by the addition of two principal examiners and two assistant examiners. During this year the number of applications was 1,628 and the number of patents granted 660. The entire Patent Office was, therefore, about the size of one of the present forty-three examining divisions and the relation of the Commissioner to his examining force at that time is comparable to that existing at present between the principal examiner of a division and his assistant examiners.

The Patent Office was transferred from the jurisdiction of the State Department and made a bureau of the Interior Department upon the establishment of the latter in 1849. For a number of years prior to the establishment of the Agricultural Bureau, the Commissioner of Patents had charge of the collection of agricultural statistics and some of the Patent Office reports in the forties are filled principally with matter relating to agriculture. For some years the duty of registering copyrights was also added to the other duties of the Commissioner of Patents.

By 1853 the number of applications filed annually had increased to 2,673, and the Rules of Practice of the Patent Office for that year, page 16, states:

It is not often that the Commissioner is able to investigate a case in person, and only in very especial circumstances can he undertake it.

In the Rules of Practice issued February 20, 1854, first appeared the following rule:

114. Should there be—notwithstanding these reasons—a second rejection, the applicant may in person, or by his agent, or in writing, as above contemplated, bring the matter before the commissioner, who will, if possible, examine the case in person; but should he not be sufficiently at leisure, it will be referred to a board of examiners.

The decision attained in either of these modes will be final, so far as the action of this office is concerned. The only remaining remedy will be by appeal in those cases allowed by law.

Up to about this time apparently the Commissioner had endeavored to exercise a personal supervision over the actions of the examiners whether they were favorable or adverse to the grant of a patent. The annual report of the Commissioner of Patents for the year 1855, however, contains the following statement:

The multiplicity of business in the office renders it wholly impossible for the Commissioner to exercise a personal supervision over the decisions in each of the numberless cases presented for official action. When the Examiner reports in favor of granting a patent it is issued without further question or examination.

This annual report for 1855 contains the first suggestion of "the appointment of an examiner-in-chief, whose sole duty would be to review the actions of the present examiners with a view to introducing correctness and uniformity of decision."

Rule 114 of the Rules of Practice of 1854, quoted above, indicates that at this time the business of this Office had become so heavy that it was impossible for the Commissioner personally to review the actions of examiners in all cases brought to his attention and that he instituted a board of examiners to relieve him of some of this work. This board, which was the forerunner of

the board of examiners-in-chief, is referred to in the annual report of the Commissioner of Patents for 1857, as follows (pp. 7-8):

Whatever might be the capabilities of the Commissioner for physical and mental labor, it would be impossible for him to discharge the administrative duties of his office, and hear, in person, all the appeals brought before him from the decisions of examiners. The usage has hence grown up of referring the investigation of most of these appeals to a board constituted for the occasion, consisting of two or more examiners, who make their report to the Commissioner. As these boards lack permanence, and from necessity, indeed, have been constantly changing without a critical examination of each report by the Commissioner—which is not practicable—uniformity in action and in the assertion of principle can not be maintained. To prevent in future that conflict, which has been so often deplored in the past, it has been recommended that there shall be appointed a permanent board of three examiners-in-chief, who shall be charged with the duty of hearing and determining upon all appeals from the judgment of the primary examiners. Such a tribunal would, no doubt, attain the end sought, and the members of it—should their appellate duties not fully occupy their time—could, by the Commissioner, be assigned labor in the classes requiring such assistance with much advantage to the public service.

In the Patent Office Report for 1858, the Commissioner states (p. 5):

Since the month of November, 1857, a board temporarily organized, and consisting of three examiners, specially detailed for this duty, have been occupied in the examination of appeals from the decisions of the primary examiners to the Commissioner. During the past year they investi-

gated and disposed of 535 cases, in-most of which they have submitted elaborately prepared reports. The results of their action have been eminently satisfactory, and have commanded, it is believed, the entire confidence of the country.

This matter is again referred to in the Commissioner's annual report for 1860 (p. 6), as follows:

Previous to the month of December, 1857, it was the practice of the Commissioner to hear appeals in person from the adverse action of the examiners; but it was soon found, from the natural increase of the business of the Office, that this was becoming a physical impossibility; and hence was adopted the alternative of deputing temporary boards of examiners, which, in some measure, relieved the Commissioner of the burden thrown upon him. But the plan soon developed its own imperfections. Each board had its own principle of action, and, in many instances, this differed from the rules prescribed by the Commissioner. As a corrective, it was at length determined by Commissioner Holt to establish a permanent board of appeal within the Office, whose members, three in number, should be taken from the examining corps, and whose duty it should be to examine all *ex parte* rejected cases, and submit their report and recommendation, as to their final disposal, to the Commissioner for his approval. This board has now been in existence for over three years, and the wisdom of its creation is a matter placed beyond all doubt.

The volumes of the Commissioner's Manuscript Decisions shows that the action of this board was in the form of a report which if satisfactory to the Commissioner, was approved and adopted by him.

The above excerpts from various reports of the Commissioner show that prior to 1861 the matter of ap-

peals to the Commissioner and later the reference of them largely to a board was not provided for by statute, but was a matter of usage or practice that gradually developed in the Office due to its growth and to the consequent inability of the Commissioner to attend in person to all the duties imposed upon him.

The repeated recommendations of the Commissioners finally produced the desired result and Congress provided for the board of examiners-in-chief and for appeals within the Office in section 2 of the Act of March 2, 1861 (12 Stat., 246) which reads as follows:

And be it further enacted, That for the purposes of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners-in-chief, at an annual salary of \$3,000 each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners, when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

Section 10 of the act fixed the fee for an appeal from the examiners-in-chief to the Commissioner at twenty dollars but no fee was required on an appeal from the examiners to the examiners-in-chief.

The report of the Commissioner for 1865 contains the following recommendation for a ten-dollar fee on appeal to the examiners-in-chief:

The Act of March 2 1861, provided for the appointment of a board of examiners-in-chief, whose duty it should be to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent. An experience of five years has fully confirmed the wisdom of the enactment, but it has at the same time demonstrated the necessity of additional legislation upon the subject. While a fee of twenty dollars is charged upon an appeal from the examiners-in-chief to the Commissioner, no charge is made for an appeal from the examiners to the board. It results from this that appeals are taken in many cases without a shadow of ground, and, in contested cases, merely for the purpose of delay. During the year 1865 there were 495 appeals taken to the board, of which number 166 remained undisposed of at the close of the year. If a fee of ten dollars were charged on appeals to the board it would check the number of frivolous appeals, and would be gladly paid by those inventors who are confident of the justice of their claim, as they would recognize it as securing them an early decision in place of the delay of months to which they are now so generally subjected.

After consultation with many inventors, and with solicitors in extensive practice, I am satisfied that the proposed amendment would be received with almost universal favor.

This recommendation resulted in the Act of June 27, 1866 (14 Stat., 76) fixing the fee for such appeal at ten dollars.

The Act of 1870 and the Revised Statutes contain similar provisions and no material change appears until last year when Congress increased the number of examiners-in-chief from three to five (Act of Feb. 15, 1916).

BILL IN EQUITY UNDER SECTION 4915, REVISED STATUTES.

An applicant has still another remedy from an adverse decision; namely, by bill in equity. Provision for this remedy is first found in section 16 of the Act of 1836 which contained certain of the provisions now embodied in sections 4915 and 4918 of the Revised Statutes.

The first portion of section 16 of the Act of 1836 reads:

And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity.

At this time it will be recalled, the appellate tribunal to the Commissioner was a "board of examiners." The Act of 1839, which substituted for this tribunal the Chief Justice of the District of Columbia, also changed and enlarged the remedy by bill in equity. Section 10 of the Act of 1839 provides—

And be it further enacted, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

The provisions of this act are substantially the same as those of section 52 of the Act of 1870 and of present section 4915 of the Revised Statutes, except for the substitution of the "Supreme Court of the District of Columbia" in the latter in place of "Chief Justice of the District of Columbia" in the former. Since the Act of 1893, it is the refusal of the patent by the Court of Appeals of the District of Columbia that entitles the applicant to a remedy by bill in equity.

The remedy provided by bill in equity under section 4915, Revised Statutes, is not an appeal from the decision of the Commissioner or the decision of the court rendered on appeal from the Commissioner's decision, but is an original proceeding in which new or additional testimony may be taken and the case determined upon a new record. Referring to section 4915, Revised Statutes, the United States Supreme Court states in *Butterworth vs. Hoe* (112 U. S., 50; 1884, C. D., 429):

It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits.

It appears to be settled that a bill in equity under section 4915, Revised Statutes, can not be maintained until the complainant has exhausted his remedy by appeal (*Kirk vs. Com. of Pats.*, 37 O. G., 451; *Prindle vs. Brown*, 136 F. R., 616; *Walker on Patents*, p. 118). It is not clear that there are now any cases in which a bill in equity to obtain a patent can be maintained until after an appeal has been taken from the decision of the Commissioner to the Court of Appeals of the District of Columbia. Between the years 1870 and 1893, however, the statutes did not provide an appeal from the decision of the Commissioner on priority in an interference case

and the defeated party's only remedy was by this bill directly from the Commissioner's decision. Walker (p. 118) states that "where the Commissioner withholds a patent by virtue of his general supervisory authority, the remedy now under consideration is the only one to which the applicant can resort, for no appeal lies to the Court of Appeals of the District of Columbia," citing in support thereof *Hull vs. Com. of Patents*, 7 O. G., 559; 8 O. G., 46. In the recent case of *Moore vs. Chott*, 192 O. G., 520; 40 App. D. C., 591, where a patent had been refused by the Commissioner under his supervisory authority even after it had been allowed by the examiners-in-chief, the Court of Appeals of the District of Columbia held that the applicant's remedy was by direct appeal to that court from the decision of the Commissioner.

In view of this case and of the court's decisions in the cases of *Selden* and *Mattulath*, *supra*, where appeals were entertained from the holding of the Commissioner that the applications were abandoned, and of the case of *Heany* and others, heretofore cited, in which the court indicated it had jurisdiction by appeal from any holding of the Commissioner that had the effect of denying an applicant a patent, it appears that the above statement of Walker is not now correct and that the portion of section 4915, Revised Statutes, providing that an applicant may have remedy by bill in equity "whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia" is a dead letter so far as the reference to the Commissioner is concerned.

The remedy by bill in equity is a part of the application for the patent and is governed by the rule of section 4894, Revised Statutes, as to laches. In other words, unless the bill is filed within one year from the decision of the Court of Appeals of the District of Columbia, it must be shown to the satisfaction of the court that the delay was unavoidable (*Gandy vs. Marble*, 39 O. G., 1423; 122 U. S., 432; *Westinghouse Electric & Mfg. Co. vs. Ohio Brass Co.*, 186 F. R., 518).

The complainant in the suit may be the applicant or the assignee (*Smith vs. Thompson*, 177 F. R., 721; *Wende vs. Thompson*, 191 F. R., 620).

If there is a party whose interests are adverse to those of the complainant, such as an opponent in an interference, he should be made the defendant and the bill filed in the federal district court for the judicial district of which that party is an inhabitant. Where there is no opposing party, the bill must be served on the Commissioner of Patents and filed in the Supreme Court of the District of Columbia unless he consents to accept service and appear elsewhere (*Butterworth vs. Hill*, 31 O. G., 1043; 114 U. S., 129; *Illingworth vs. Atha*, 51 O. G., 803; 42 F. R., 141).

Where the defeated party in an interference proceeding seeks remedy by bill in equity, the question of the patentability of the claims may be raised and will be considered by the court (*Hill vs. Wooster*, 50 O. G., 560; 132 U. S., 693; *Richards vs. Meissner*, 155 F. R., 135; *Hansen vs. Slick*, 216 F. R., 164).

The court is without authority under section 4915 to enjoin the Commissioner from issuing a patent to the successful party in an interference proceeding (*Illingworth vs. Atha*, 42 F. R., 141), and it is the practice of the Patent Office not to withhold the patent to the successful party pending the determination of a suit in equity under section 4915, Revised Statutes (*Sargent*, 12 O. G., 475; *Wells vs. Boyle*, 43 O. G., 753; *Dunbar vs. Schellenger*, 128 O. G., 2087; *McIntyre vs. Perry*, 169 O. G., 943).

An appeal lies from the decree of the Supreme Court of the District of Columbia to the Court of Appeals of the District of Columbia or from a federal district court to the Court of Appeals of the same judicial circuit in cases under section 4915, Revised Statutes, as in other equity cases. Formerly an appeal could be taken to the United States Supreme Court as shown by the fact that that court entertained jurisdiction in *Gandy vs. Marble*, 39 O. G., 1423; 122 U. S., 432; *Hill vs. Wooster*, 50 O. G., 560, 132 U. S., 120, and *Morgan vs. Daniels*, 67 O. G., 811; 153 U. S., 120. In *Durham vs. Seymour*, 74 O. G., 1731; 161 U. S., 235, the Supreme Court held that the Acts of March 3, 1891, and of March 3, 1885, respectively, did away with appeals of this kind from the circuit courts and the Supreme Court of the District of Columbia.

The Judicial Code, Act of March 3, 1911, continues the practice of *not* permitting appeals in such cases to the United States Supreme Court.

As shown by this elaborate system of remedies, the patent laws are, as stated in one court opinion, supremely indulgent to the claims of inventors. Various Commissioners, and others, have recommended doing away with some of these remedies and appeals, both within and without the Office.

In view of the expense to which a defeated party in an interference proceeding may subject the successful party and of the length of time during which it is possible to prevent him from receiving his patent; also of the long period an applicant may keep his rejected application alive, much may be said in favor of limiting the number of remedies. A discussion of the subject, however, would unduly extend this paper.

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Patents and the Preparation and Prosecution of Applications by Applicants Themselves

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Patents and the Preparation and Prosecution of Applications by Applicants Themselves

By

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A PATENT.

A patent is a Government grant to an inventor, securing to him for the period of seventeen years the exclusive privilege of making, using and vending and of authorizing others to make, use and vend, any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

Patents are also granted for designs but this paper is restricted to the consideration of only such patents as are referred to in the definition just stated.

According to Walker on Patents, 4th Edition, paragraph 172:

“Letters-Patent are documents consisting of the grant and the specification; and where drawings form a part of the application, they also form a part of the letters-patent. The grant is a paper, issued in the name of the United States, under the seal of the Patent Office, and signed by the Commissioner of Patents. It contains a short title of the invention, and purports to grant to the patentee, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use and vend the invention, throughout the United States and the territories thereof; and it refers to the specification for the particulars of the invention covered by the grant, and each of the three rights granted by letters-patent is a separate substantive right.”

Inventors should study the Patent Laws and the Rules of Practice in the United States Patent Office.

Pamphlet copies of the "Patent Laws" and of the "Rules of Practice" may be obtained free of cost upon request therefor addressed to the Commissioner of Patents.

The decisions of the Commissioner are published in the "Official Gazette," published weekly, and furnished to subscribers for \$5.00 a year, payable in advance, and in the bound volumes of the Commissioner's Decisions, published annually and sold in law binding for \$2.00 per volume and in paper covers for \$1.00 per volume. Subscriptions to the Official Gazette and copies of the Commissioner's Decisions should be addressed to the Superintendent of Documents, Government Printing Office.

Throughout this paper reference to the laws is by Section number and to the Rules of Practice by Rule number.

Decisions of the Commissioner are referred to in the Official Gazette by the title of the case, and the Volume and page, as: Branna, 97 O. G., 2533, and in the Commissioner's Decisions by title of the case, year and page, as, Branna, C. D., 1901, 232.

PATENTEES.

To ascertain who may obtain a patent for an invention reference may be made to Section 4886 of the Revised Statutes, which provides that:

"Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned,

may, upon payment of the fees required by law and other due proceedings had, obtain a patent therefor."

And to Section 4887 which, in part, provides that:

"No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented, or caused to be patented, by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of Section forty-eight hundred and eighty-six of the Revised Statutes, prior to the filing of the application in this country in which case no patent shall be granted in this country."

And to Section 4923 which provides that:

"Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known and used in a foreign country before his invention or discovery thereof, if it had not been patented or described in a printed publication."

Such patent or printed publication if published in any country prior to the invention by the applicant is a bar to the grant of a patent in this country, but not so if the applicant made the invention prior to the date of the patent or printed publication unless the date of such patent or publication is two years prior to the date of filing of the application in this country.

It may be here noted that the date of the completion of an invention may antedate the filing of an application by a considerable period of time.

There are no restrictions to the personality of the

inventor to prevent him from obtaining a patent for his invention except as provided in Section 480, that "all officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take directly or indirectly except by inheritance or bequest, any right or interest in any patent issued by the Office."

The applicant may be man, woman or child, of any nationality or color.

The law, Section 4896, even provides for the protection of the inventions of insane persons by their legally appointed conservators, guardians, or representatives and in event of the death of the inventor the patent may be applied for by the executor or administrator of the estate of the deceased inventor.

Furthermore, Section 4898 provides that the inventor may convey all or part of his interest in an invention to another, as follows:

ASSIGNMENTS.

"Every patent or any interest therein is assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under the patent to the whole or any specified part of the United States."

"An assignment, grant, or conveyance will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice unless recorded in the Patent Office within three months from the date thereof."

The assignment records of patents in the Patent Office are open to the inspection of the public and any recorded assignment constitutes a notice to the public of the contents of such assignment. Anyone desiring a fuller knowledge of the Patent Office assignment records should consult Mr. Magruder's valuable paper entitled "The Records of Assignments of Paper Prop-

erty" read before the Examiners of the Patent Office, May 28, 1914.

"Patents may be granted and issued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer if he is living." Section 4895.

Rule 26 of the Rules of Practice in the United States Patent Office requires that the request of the applicant for the grant of the patent to the assignee or to the inventor and assignee as joint patentees must be embodied in the assignment and that the assignment must be entered of record at a day not later than the date of payment of the final fee; and if it be dated subsequently to the execution of the application it must give the date of execution of the application, or the date of filing, or serial number, so that there can be no mistake as to the particular invention intended.

It is important to particularly note the provisions of Rule 186 relating to assignments:

"No instrument or writing will be recorded which is not in the English language and which does not, in the judgment of the Commissioner, amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title (or legal ownership) of the patent or invention to which it relates. Such instrument or writing should identify the patent by its date and number; or, if the invention be unpatented, the invention should be identified by a statement of the name of the inventor, the serial number of the application and the date of filing of the application."

When an applicant has assigned his rights in an application embracing two or more inventions and such application is divided it is the uniform practice of the Office to apply to the divisional applications assignments

of the original cases and the Commissioner of Patents has said no good reason is seen why the same practice should not be applied to subsequent applications for the same subject-matter by the same inventor. Wurtz, 120 O. G., 2441.

"It is a firmly established rule that a part owner of a patent has a legal right to convey to others the right to make, use and vend the invention without the consent of his co-owners." *Lalanc Grosjean Manufacturing Co. vs. National Enameling Co.*, 108 Fed. Rep., 77.

"An assignee of a half interest can not prosecute the application to the exclusion of the inventor; but, on the contrary, the inventor can prosecute it to the exclusion of every one save the assignee of the entire interest." 113 O. G., 850; C. D., 1904.

"An assignee of an equitable interest in an invention has the right to inspect the file and obtain copies of the same." Hertford, 113 O. G., 851; C. D., 1904.

Inventors should carefully note the distinction between the terms "joint inventors" and "joint patentees." Joint inventors are persons who have jointly discovered and developed an invention. Joint patentees are persons who are joined in the grant but who were not joined in discovering and developing the invention.

The term "joint inventors" does not properly belong to an inventor and one who has received a grant of a part interest in the invention. The inventor and the assignee may become joint patentees (Section 4895).

INFORMATION FOR CORRESPONDENTS.

All business with the Office should be transacted in writing in compliance with Rules 1, 2, 8, 9 and 10 of the Rules of Practice.

To avoid delay in obtaining information from the Office, applicants should particularly note and comply with the requirements of Rule 8.

When a letter concerns an application, it should state the name of the applicant, the title of the invention, the serial number of the application and the date of filing the application. Rule 9. If the letter is in response to an examiner's action on the case the letter should refer

to such action by the words "in response to the Office Letter of . . . " and to further facilitate correspondence, in response to an examiner's action the letter should refer to the examiner's division by the caption—"Before the Examiner in Division . . ."

Applicants should preserve lineal and verbatim copies of all papers filed in the Office to facilitate making amendments and corrections.

The Office can not respond to inquiries as to the novelty of an alleged invention in advance of the filing of an application for a patent, nor to inquiries propounded with a view to ascertaining whether any alleged improvements have been patented, and, if so, to whom. Rule 14. Should the inventor desire to ascertain what has already been done by predecessors in a certain line of invention he can purchase a "Classification Index" from the Commissioner of Patents at a cost of twenty-five cents. He can then obtain from the Commissioner an estimate of the cost of all of the patents in a selected class or sub-class of inventions or he may order any number, as, the last ten of the patents granted in that particular class or sub-class, the cost of which will be five cents each, payable in advance. A study of these patents will generally give the inventor a fair idea of the state of the prior art and will also furnish him with examples of the character of drawings and specifications required and the nature of what his claims should be. If he does not wish to purchase a copy of the Classification Index, he may write to the Commissioner asking for an estimate of the number of patents relating to his particular invention, describing it in general terms, as—spring jaw rat traps, rotary egg beaters, disk harrows, etc., and after such information has been obtained he may purchase as many copies of such patents as he desires.

"The Office can not act as an expounder of the patent law, nor as counselor for individuals, except as to questions arising within the Office." The Office can not undertake to advise an inventor whether his invention infringes, or, if patented, whether his patent is infringed by others. Such questions are for the courts to decide

when the questions are properly brought before them for decision.

“Of the propriety of making an application for a patent, the inventor must judge for himself. The Office is open to him, and its records and printed drawings pertaining to all patents granted may be inspected either by himself or any attorney or expert he may call to his aid.” Rule 14.

Since this paper is prepared for the assistance of inventors who desire to prepare and prosecute their applications for patents without the assistance of an attorney, reference will not be herein made to attorneys except to say that although an applicant or an assignee of the entire interest may prosecute his own case, he is advised, unless familiar with such matters, to employ a competent patent attorney, as the value of patents depends largely upon the skilful preparation of the specification and claims.

The Office can not aid in the selection of an attorney.

THE APPLICATION.

“A complete application comprises the first fee of \$15.00, a petition, a specification, and oath; and drawings, when required.” Rule 30.

“An application will not be placed upon the files for examination until all its parts shall have been received.” Rule 31.

When a complete application has been filed in the Application Division of the Office, it is given a serial number in its regular order and the applicant is notified of its serial number and its date of filing. A record of the application is made in the Application Division to identify the application and the division to which it is sent for examination.

The examination of the application on its merits is made in the Examiner's division in accordance with the provisions of Section 4893.

All the papers of a complete application should be

attached together and deposited in the Office at the same time; otherwise a letter must accompany each part accurately and clearly connecting it with the other parts of the application.

STATUTORY REQUIREMENTS OF APPLICATIONS.

The Statutes require a written application comprising a specification and claim:

“Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and the manner and process of making, constructing, compounding and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from the other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor.”
Section 4888.

To properly prepare a specification and claims requires a thorough knowledge of the Patent Laws and Office Rules of Practice and skill in writing clear, technical descriptions of inventions. These qualifications are acquired by specification writers only by long study and constant practice.

The preparation of an application is the subject-matter of Rules 30 to 55.

The requirements of a petition are stated in Rule 33 and perhaps the best way of preparing a satisfactory petition is by following the proper form from the Ap-

pendix of Forms. It will be noted that there are seven forms given and of these seven but one is the proper one to be copied.

"It sometimes happens that the petition does not refer to or identify a specification. Such a petition is defective." Mason, 43 O. G., 627; C. D., 1888.

"It (the petition) does not itself disclose the invention, and is therefore incomplete unless it refers to some paper which does disclose it." Buddington, 84 O. G., 1728; C. D., 1898.

SPECIFICATION.

By referring to the forms for a specification given in the Appendix of Forms published in the Rules of Practice, it will be observed that all specifications begin with the set or formal words "To all whom it may concern:" followed by a paragraph constituting a formal preamble which should be copied verbatim, with the blanks filled in, and the proper title of the invention substituted for that given therein.

All the requirements of Rules 34 to 40, inclusive, of the Rules of Practice should be closely studied and observed in the preparation of the specification.

The full first name of the applicant should be given in the preamble and if the first name resembles an abbreviation of a well known name, as Fred or Jack, or a diminutive form of a name, as Harry or Johnnie, the oath or affidavit of invention should have added to it a statement that the first name as given by the applicant is his full first name.

"The form of applicant's name should appear the same in the different places in the papers constituting an application. Where different forms appear, one of them presumably a corruption or nickname, an affidavit will be required stating which is the correct form of the applicant's name. Where the incorrect form appears in the preamble, correction may be made by amendment. Where the abbreviated form or nickname appears in the signature, the patent may issue after filing of the affidavit above referred to." Clark, 124 O. G., 910; C. D., 1906.

"Where a foreigner declares his intention of becoming a citizen of this country, he remains a citizen of the foreign country until his citizenship of this country becomes effective." Rhodes, 105 O. G., 1261; C. D., 1903.

Following the preamble there should be a general statement of the object and nature of the invention. This should, in a few well-selected words, state in general terms the purpose of the invention and in what it consists, see examples in the "Appendix of Forms" before referred to.

"A statement of invention should not be made in a specification which amounts practically to a mere repetition of the claims in different language." Edwards, 137 O. G., 1711; C. D., 1908.

In recent years it has become customary to reduce the statement to a mere formality such as:

"The invention consists in the construction and novel combination and arrangement of parts hereinafter fully described, illustrated in the accompanying drawings and pointed out in the claims hereunto appended."

Such statement appears to be sufficient since the courts look to the claims for the definite statement of the invention.

If the invention is capable of illustration the statement of invention in the specification should be followed by a brief description of each of the several figures of the drawing.

Then should follow a detailed description of the invention with reference to each of the several parts by a reference numeral applied to such part in each of the several figures of the drawing. If the reference numeral be applied to the part it represents in each of the several figures of the drawing, it will greatly assist in reading and understanding the drawing.

The detailed description should start with the framework, if the specification be that of a machine, and work towards the details. Everything necessary to a clear understanding of the invention should be described referring in the specification to the parts of the drawing by

reference numerals and no important part of the invention should be overlooked. But it is not necessary to mention every bolt or connection, nor should dimensions be stated unless essential.

At the end of the detailed description in the specification should be the words "I claim" followed by one or more formal claims and the signature of the inventor.

Rule 34, founded upon section 4888, requires the description "to be in such full, clear, concise terms as to enable any person skilled in the art or science to which the invention or discovery appertains or with which it is most nearly connected, to make, construct, compound and use the same."

By persons skilled in the art is meant persons having the usual or expected skill of those engaged in that art. Not those having the highest skill, but those having the average skill and intelligence of persons engaged in the business to which the art relates.

"A patent is addressed to those having a peculiar and technical knowledge of the subject." *Webster Loom Co. vs. Higgins*, 105 U. S., 580; 54 O. G., 388; C. D., 1888.

"If the description of a patent be so vague and uncertain that no one can tell, except by independent experiments, how to construct the patented device, the patent is void." *De Lamar vs. De Lamar Mineral Co.*, 54 C. C. A., 272; 117 Fed. Rep., 240.

One would not be required to describe his invention in the glass maker's art in such terms as to be understood by those engaged in felt hat making, or vice versa, although there might be many engaged in the hat making art who would understand a clear specification of the invention in glass making. The terms used by the glass maker might be familiar to the ears of glass makers generally, yet strange and unintelligible to the hat maker.

"The specification must set forth the precise invention for which a patent is solicited, and explain the principle thereof, and the best mode in which the applicant has contemplated applying that principle, in such

manner as to distinguish it from other inventions." (Rule 35.)

The specification should not merely define in general terms the type to which the invention relates but should direct the description to just what has been invented by the applicant. The prior art is presumed to be known to those skilled in the art, and to describe in a specification what is already known is not the purpose of a specification. Sometimes it is permissible to refer briefly to the prior art for the purpose of more clearly bringing out by comparison the distinction between the applicant's invention and the prior art but the main reliance for the distinction should be the full, clear and distinct description of what the applicant has invented.

"It is not necessary to state what others have failed to do, but merely what the applicant has done. If the invention is a pioneer, it will receive a liberal construction because of that fact, if claimed, whether or not a statement to that effect is included in the descriptive part of the specification. A statement such as, 'Many attempts have been made to impart drying properties to the non-drying fatty oils in combination with pigments, but, up to the present time, all such attempts have failed and these oils are still unsuitable for use for many purposes' should be omitted." Blakeman, 98 O. G., 791; C. D., 1902.

"A party may in his specification distinguish between what is old and what is new, but there is no warrant for permitting a party to recite the history of the art as he understands it, together with statements as to the disadvantages of the several old forms and the advantages of his invention thereover, or to illustrate in his drawings the old devices which he regards as constituting the prior art." Wadsworth, 92 O. G., 1798; C. D., 1900.

"Statements should not be included in the specification which are merely laudatory of the applicant's invention." Blakeman, 98 O. G., 791; C. D., 1902, and

"Matter which is of an advertising nature will not be permitted." Wellington, 113 O. G., 2218; C. D., 1904.

The specification should not be verbose, nor should it refer to prior art in disparaging terms. Should the specification be objectionable on these grounds, it would

be the duty of the Examiner to require the cancellation of such remarks.

"Under no circumstances should an applicant in his specification make derogatory statements as to the inventions of others; within reasonable limits he may point out the advantages of his invention and indicate also what he regards as the defects or delinquencies common to structures representing the unimproved art." Heylman, 126 O. G., 1066; C. D., 1907.

"The Office will not knowingly permit a patent to contain a false suggestion of fact which may mislead the public to its prejudice." Lewis & Ungerer, 106 O. G., 543; C. D., 1903.

"In case of a mere improvement, the specification must particularly point out the parts to which the improvement relates, and must by explicit language distinguish between what is old and what is claimed as new; and the description and the drawings as well as the claims, must be confined to the specific improvement and such parts as necessarily cooperate with it." (Rule 36.)

If the applicant has invented a yieldable pitman for a mowing machine it is not necessary to describe an entire mowing machine nor even the specific construction of cutter bar with which the pitman is connected. It is enough to say that the pitman was designed for use in a mowing machine, although not restricted to that use since it might be useful in other machines.

It has been held that where the claims were directed to the bearings and mode of connecting the driving device of a centrifugal machine the title "Centrifugal Machine" did not correctly indicate the nature and design of the invention as required by section 4884, Revised Statutes.

"The specification of a patent is sufficient if it fully discloses the principle of the invention and it is not necessary that the relation of the parts should be stated with mathematical exactness." Hancock *vs.* Boyd & Getty, 170 F., 600.

"The discussion of the theoretical result to be attained by the use of the invention is not proper matter for a patent specification. A specification for a patent should

be confined to a description of the structure of the device and the manner of its use. Such matter, while proper for advertising circulars, should not be included in a specification which is to form part of a patent." *Wellington*, 113 O. G., 2218; C. D., 1904, 564.

"Where a patent discloses means by which a novel and successful result is secured, it is immaterial whether the patentee understands or correctly states the theory or philosophical principles of the mechanism which produces the new result." *Van Epps vs. United Box Board & Paper Co.*, 143 F., 869.

If not inaccurate, the applicant may use the terms with which he is most familiar to describe his invention.

"It is the policy of the Office to permit an applicant in describing his invention to select his own terms of reference so long as their use does not lead to ambiguity." *Hollis*, 86 O. G., C. D., 1899; *Petzold*, 58 O. G., 1091; C. D., 1892.

"A patentee in describing his invention may assume that what is already known in the art is understood and may begin at the point where his invention begins and describe what he has made that is new and what it replaces of the old." *Carnegie Steel Company vs. Cambria Iron Co.*, 99 O. G., 1066; C. D., 1902.

"The operation of the invention should be set out in the specification." *Bradford and Chatfield*, 152 O. G., 731; C. D., 1910.

"Where a specification fails in any material respect to make the invention fully known and accessible to the public skilled in the art to which the invention relates, it is fatally defective, and the patent based upon it ipso facto becomes void." *The Tannage Patent Co. vs. Zahn*, 71 O. G., 1161 (1895).

"When a specification requires to be supplemented by experiment and inventive skill, it is fatally defective and the patent is void." *Id.*

CLAIM.

"The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery. (Rule 37.)

"A patentee's claim is the measure of his right to relief, and while the specification may be referred to to limit the claim it can never be made available to expand it. *McClain vs. Ortmyer*, 57 O. G., 1129; C. D., 1891.

"The terms of the claim are coextensive with the description of the patent." *Perrin vs. Manhattan Ry. Co.*, 69 O. G., 1209 (1893).

"The true meaning of claims must be gathered by comparing them with the context of the specification." *Celluloid Co. vs. Arlington Mfg. Co.*, 64 O. G., 1263 (1893).

"Where the claims in a patent are not supported by a description in the patent, such claims are of no validity." *Pacific Cable Ry. Co. vs. Butte City Street Ry. Co.*, 66 O. G., 1758 (1894).

Walker says:

"It is a proper practice to make a generic claim and also a specific claim, in an application for a patent on a generic invention, even where only one species is described in the specification. In such a case, if the inventor's understanding that his invention is primary turns out to be true, both claims will be valid. But, if some invention is afterwards discovered in the prior art, which relegates the patent to a secondary place, the specific claim may stand and be valid, though the generic claim is too broad to be maintained." Walker on Patents, 4th Ed., sec. 116.

"A claim should itself clearly set forth the structure which it is intended to cover, and not merely by the use of reference letters refer to the drawing and specification for a disclosure of it. A claim which relies entirely upon reference letters to indicate structure is objectionable." *Osborne*, 92 O. G., 1797; C. D., 1900.

The claim must be complete in itself and definitely outline and limit the invention.

"It is no more permissible on principle to refer to the description for some of the limitations which should be and are intended to be included in a claim than it is to refer to the description for all of the limitations." *Shepler*, 102 O. G., 468; C. D., 1903.

"If the claim does not include sufficient mechanical elements to effect the function stated, it will be rejected

on the ground that it does not comply with section 4888 of the Revised Statutes." Hoge, 173 O. G., 1081; C. D., 1911.

Nor should a claim be verbose or prolix.

"A claim may be so prolix as not to comply with the requirements of the statute that an applicant 'shall particularly point out and distinctly claim the particular improvement or combination which he claims as his invention or discovery.'" Iagan, 162 O. G., 538; C. D., 1911.

"Claims will not be allowed merely because they represent a multitude of elements all of which do not appear in one or two or even more references." Sheppler, 102 O. G., 468; C. D., 1903.

The elements specified in claims for combinations should be substantive and tangible.

"An 'opening' should not be made a positive or direct element in combination claims, for the reason that an opening is not a tangible thing. It can exist only in connection with some other elements. If it is desired to describe this element as provided with an opening there is no objection to such a course." Davin, 100 O. G., 452; C. D., 1902.

"A claim for an article of manufacture should not, as a rule, be defined by the process of producing it; but when an article of manufacture is a new and useful thing and embodies invention and can not be properly defined except by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule." Painter, 57 O. G., 999; C. D., 1891. Scheckner, 106 O. G., 765; C. D., 1903, 315.

"Where a claim to an article refers to an etched plate. This is not objectionable on the ground that it defines the article by the process of making it, since etched plates have well-known physical characteristics." Scheckner, 106 O. G., 765; C. D., 1903, 365.

"One can not have a valid patent for a principle or law of nature. But, having invented and practically exemplified a process for utilizing this principle he is entitled to a patent for that process." U. S. Supreme Ct. in *Tilghman vs. Proctor*, 19 O. G., 859; C. D., 1881, 163.

"A principle covers every mode, apparatus or process that accomplishes the result." *Id.*

Claims must not be worded to merely set forth a result. They must define a composition, a structure, a process or a method.

"It is a well-settled law that a patent can not issue for a result sought to be accomplished by the inventor of a machine, but only for the mechanical means or instrumentalities by which that result is to be obtained. One can not describe a machine which will perform a certain function and then claim the function itself and all other machines that may be invented by others to perform the same function." Gardner, 140 O. G., 256; C. D., 1909.

"But where a claim distinctly specifies a certain structure which is adapted to perform a particular function there is no objection to setting that function out in the claim." Hoge, 173 O. G., 1081; C. D., 1911.

"If the claim does not include sufficient mechanical elements to effect the function stated, it will be rejected on the ground that it does not comply with section 4888 of the Revised Statutes." *Id.*

"An applicant can not be permitted to use in his claims terms which are indefinite and general in their meaning without such qualifying words as shall make clear what is intended to be covered by them and shall be expressive of the purpose, location or function of the elements intended." Hamilton, 85 O. G., 1742; C. D., 1898.

"The terms of description used in the claims should accurately describe the construction disclosed in the application." Mueller et al., 118 O. G., 270; C. D., 1905.

"A claim should not be drawn in an alternative form even where the alternative elements are equivalents, but should use some broad term of description which will include both forms."

"A claim including a description of an element as 'brick or the like' is alternative in form and is indefinite, since the word 'like' fails to identify the characteristics of the substance." Caldwell et al., 120 O. G., 2125; C. D., 1906.

The phrase "brake or locking device" is either alternative or so inapt to define the desired construction as to be objectionable on the ground of indefiniteness." Leon, 164 O. G., 250; C. D., 1911.

"To merely state in a claim the function or result with-

out first including therein the structure by means of which the function or result is obtained renders a claim vague and indefinite." *Kotter*, 95 O. G., 2684; C. D., 1901.

"A statement of the purpose, result, operation, or advantages of a mechanical invention should not be included in the claims, but should be embodied in the specification. The claims should be limited to statements of structure." *Schweitzer*, 97 O. G., 1371.

"In a combination claim the use of the word 'means' limited by a statement of function has long been recognized as the proper method of stating an element of the combination." *Young vs. Eick*, 113 O. G., 547; C. D., 1907.

"Where the invention claimed is a combination the term 'means' followed by a statement of function is properly readable on a structure in which such means consists of more than one element." *Lacroix vs. Tyberg*, 148 O. G., 831; C. D., 1909.

"To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty is contrary to a well-settled rule of patent law." *Fred'k R. Stearns & Co. vs. Russell*, 84 O. G., 1434; C. D., 1898.

"Where an element is mentioned in a claim and intended to be included as an element of the combination it is in the interest of clearness and good form to positively and directly include it instead of making an indefinite reference to it." *Vincke*, 96 O. G., 2061; C. D., 1901.

A claim may be had because it does not set out a complete combination or because it includes more than is necessary.

"A patent based on an alleged combination which is inoperative without the addition of another element is void." *Terrant vs. Duluth Co.*, 39 O. G., 1425 (1887).

"It is fatal to a patent for a process that a patentee claims as essential a step which is unnecessary." *Van Camp vs. The Maryland Pavement Co.*, 43 O. G., 884 (1888).

"It is unnecessary to include in the claim such words as 'substantially as described' since the law makes the description a part of the patent, and therefore the claim must be construed with reference to the description

whether the words are included or not." Shepler, 102 O. G., 468; C. D., 1903.

"The Patent Office in determining the meaning and legal effect of a claim regards the presence or absence of the words 'substantially as described' as immaterial." *Id.*

"A claim which differs from another merely by the use of the words 'substantially as described' can not be permitted in the patent, since the words impart no definite limitation into the claim where used." *Id.*

"An applicant should not needlessly multiply claims by the inclusion of well-known elements which do not cooperate therewith to produce a new result or in any manner add to the patentable novelty of the device." Griffith, 85 O. G., 936; C. D., 1898.

"The practice of presenting a needless multiplicity of claims of substantially the same scope is to be condemned." Kadow, 154 O. G., 1412; C. D., 1910.

"Where the claims in an application are drawn to cover a mechanical structure capable of performing several functions and the claims differ from each other only in the statements of function attributed to the device it has been held that the claims are substantial duplicates, for upon elimination of the statements of function each claim would cover the same combination of elements." Jacobson, 107 O. G., 1378; C. D., 1903.

"Where the invention can be clearly defined by means of four claims, the presentation of twelve claims is objectionable because then the claims are unnecessarily multiplied." Carpenter, 112 O. G., 503; C. D., 1904.

"Where it appears that one claim includes limitations not found in the other, such claims are not duplicates." Massie, 113 O. G., 2505; C. D., 1904.

"An applicant may properly in one case have claims covering the principal or essential steps of a process and other claims including those steps, together with other specific steps which are not absolutely necessary to the performance of the process, but which add to its efficiency or make its operation more perfect." Oxnard & Baur, 88 O. G., 1526; C. D., 1899.

If there are more than one claim they should be consecutively numbered.

"It is to avoid confusion in examining cases that claims must be numbered in consecutive or regular order." Tuttle, 102 O. G., 1781; C. D., 1903.

DIVISION.

"An applicant is permitted to show several species of an invention when the state of the art permits a claim to be presented and allowed which is broad enough to cover all of the species shown and described." Herreshoff, 106 O. G., 1779; C. D., 1903.

"He may include in one case generic claims and claims to one species, but may not include claims limited to different species." Dallas, 106 O. G., 996; C. D., 1903; Eagle, C. D., 1870, 137.

For example:

"Joints for metal plates have acquired a distinct status in art and manufacture and one form may be used as a substitute for another. Two forms constitute two species of the invention and can not be claimed in the same case." Burmeister, 101 O. G., 662; C. D., 1902.

"Two different constructions for fastening calks to horseshoes constitute independent inventions although both might be used on one shoe." Rodinbaugh & Laurentz, 101 O. G., 1830; C. D., 1902.

DRAWINGS.

"When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact." Section 4889.

Formerly the specification and drawing were both required by statute to be signed by the inventor, or the drawing might be signed by the attorney in fact, and the signatures were required to be attested by two witnesses. Now, however, by recent amendments to the Statutes and to the Rules of Practice in conformity therewith, the requirement for witnesses is not made.

When the invention can be illustrated by drawings the formal and technical requirements of the Rules of Practice concerning drawings should be strictly observed, and, inasmuch as the artistic requirements of patent drawings are beyond the ability of most inventors and applicants, applicants are advised to employ competent draftsmen to make drawings for them. If the services of such are

not available elsewhere, the Office will furnish drawings at cost to the applicant as promptly as the draftsmen can make them.

"The statute requiring a drawing means one showing what is described, and a part can not be omitted any more than the whole of it. The question is not whether the construction can be understood without a drawing, but is whether it can be illustrated." Edgerton, 101 O. G., 1131; C. D., 1902.

"It is a great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation; which should be apparent upon inspection." Sturtevant et al., 108 O. G., 563; C. D., 1904.

"Where the invention relates to the arrangement of engines, tanks, receivers, and connecting pipes and valves all of known construction, diagrammatic illustration is probably clearer than views showing parts in detail." Clark, 109 O. G., 2169; C. D., 1904.

"When possible, a drawing should be so complete that the purpose and operation of the invention may be readily understood by one skilled in the art by a mere inspection of the drawing." Hartley, 97 O. G., 2746; C. D., 1901.

"Where a conventional device is referred to in the specification and it does not form part of the invention • it should either be illustrated in a conventional way, in order that any one skilled in the art can understand from a mere inspection of the drawings what the device is, or if it is illustrated in an unconventional way an amendment should be made to the specification clearly describing the construction and operation of said device." Morse, 97 O. G., 2982; C. D., 1901.

"It is not necessary in Patent Office drawings that the exact proportions of the parts should be indicated. All that is required is that such an operative device be shown that one skilled in the art can make and use the same." Creveling, 98 O. G., 1708; C. D., 1902.

The drawing must show the structure so completely as to enable one skilled in the art to construct it.

"It is not sufficient for the purpose of a Patent Office drawing that the illustration be such that a person skilled in the art could supply the parts not shown; but when

possible the drawing should be so complete that the purpose and operation of the machine illustrated may be readily understood by one skilled in the art by means of a mere inspection of the drawing." Motsinger, 110 O. G., 601; C. D., 1904.

"Where a party discloses two or more forms of some of the elements of his invention in the drawings and claims the general combination of parts and the specific form of some of the elements he should include the preferred form of the elements in the figure of the drawings illustrating the combination which he wishes to claim, so that all claims will read upon the device shown in a single figure." Welch, 93 O. G., 2104; C. D., 1900.

"A modification of the invention should not be shown in dotted lines on the same figure which shows the preferred form in full lines, but should be shown if at all, in separate figures and in full lines." Badger, 97 O. G., 1696; C. D., 1901.

"When the application fully discloses the construction of the alleged invention which is of general application, the illustration of the invention applied to a particular use will not be required." Perkins, 142 O. G., 855; C. D., 1909.

"The number of sheets of a drawing in an application should not be greater than is necessary to clearly illustrate the invention." Roadhouse, 111 O. G., 1368; C. D., 1904.

"Nor should the drawing include matter which is unnecessary and ineffective for a clear understanding of the invention claimed." Anderson, 113 O. G., 2504; C. D., 1904.

"There are two principal reasons for the rule requiring drawings to be limited to as few sheets as possible consistent with a clear showing of the invention; one is that it has now come to be a serious problem to find space for the storage of drawings, whether they form a part of a patent or of an abandoned application, and the other is that it is a useless expense to photolithograph an unnecessary number of sheets of drawings for the purpose of attaching the same to patents." Pfautz, 159 O. G., 489; C. D., 1910.

OATH.

Section 4892 requires that the inventor shall make oath to certain matters therein mentioned and Rule 46 further requires that the oath shall be signed by the inventor.

In case of the death of the inventor the application and oath may be made by his executor or administrator, and in case of the insanity of the inventor the application and oath may be made by his legally appointed guardian, conservator or representative.. Section 4896. (Rule 25.)

The acknowledgment of the oath before a notary, or other proper officer designated in section 4892 and Rule 47, should be executed shortly before filing the application in the Office.

The form of the oath should be copied from that given in Form No. 18 in the Appendix of Forms in the Rules of Practice. Particular attention should be given the explanatory footnotes concerning the blanks to be filled in in the form. By carefully following the directions delay and annoyance will be avoided.

If the full first name of the applicant resembles an abbreviation of a nickname the oath should have added to it the words "and the first name as given by the applicant is his full first name."

An additional oath will be required under Rule 46 where the delay in filing the application after the execution of the original oath is longer than three weeks in addition to the time which may naturally be expected to be required in transmitting the papers by mail to the Patent Office. Branna, 97 O. G., 2533; C. D., 1901, 232.

EXAMINATION.

On the filing of the application and the payment of the filing fee an examination will be made in compliance with section 4893, and if any claim is found to be unpatentable for any reason whatever, it will be rejected under the provisions of section 4903, which also gives the applicant the privilege of amending the claim or asking for a reconsideration on the merits.

The order of examination of applications is stated in Rule 63.

"Applications must be examined in regular order; the Office can not give one case precedence over others because of the applicant's business arrangements which are dependent upon a speedy allowance of the patent." *Bischoff*, 100 O. G., 2603; C. D., 1902.

In an action on the merits of a case in the examination thereof—

"Rule 66 merely requires that an Examiner in citing references shall, if the pertinence of the same is not obvious, clearly explain the grounds upon which he has rejected the claims. It is necessary only that the Examiner's position be made plain upon the record, so that the applicant may intelligently amend his claim or present his case for appeal. The rule does not require that the Examiner shall 'meet' every argument advanced by an applicant." *Stier*, 110 O. G., 599; C. D., 1904.

"Where the Examiner has clearly and explicitly given his reasons for rejection yet admits that the disclosure of the references is not in all respects identical with the applicant's disclosure, on which the rejected claim is based the provisions of Rule 66 have been complied with and the issue between the Examiner and the applicant should be determined on appeal." *Fletcher*, 114 O. G., 545; C. D., 1905.

"In many cases a mere statement that the claims are rejected on specified references is sufficient, in view of the character of the invention; but in all cases where references are grouped together it should be clearly stated whether the claims are anticipated by each of the references separately or in what manner the references are to be combined." *Harris*, 140 O. G., 756; C. D., 1909.

"When the pertinency of the references is obvious, as where the disclosure is simple or includes only the invention of the applicant, a detailed application of the references is unnecessary." *Inman*, 160 O. G., 1038; C. D., 1910.

"But where an Examiner rejected claims upon an 'old way' of doing a thing and upon request of the applicant refused to make a particular citation of this old way or to furnish the affidavit required by Rule 66, there is no excuse for failure on the part of the Examiner to be guided by the Rules of Practice, particularly where the

language admits of but one construction." Garms, 93 O. G., 190; C. D., 1900.

"Where an applicant is attempting in good faith to further the prosecution of his application the Office should give him all reasonable assistance." Starr, 106 O. G., 263; C. D., 1903.

"If any doubt exists as to the interpretation placed by the Examiner upon a feature of the drawing or portion of one specification, he will furnish an explanation in response to a specific request making clear the uncertainty existing in the mind of the applicant." Lincoln, 127 O. G., 3216; C. D., 1907.

AMENDMENTS.

"When claims are rejected as anticipated by prior patents they should be amended, if possible to set out the difference between the applicant's construction and that shown in the patent; the differences must be indicated in the wording of the claim. The patentability of claims can not properly be predicated on alleged differences of construction which are not specified therein. McNeil *vs.* Sturtevant, 124 O. G., 2177; C. D., 1906.

In amending his specification, drawings or claims the requirements of Rules 68 to 78 should be observed and closely followed.

The heading of an applicant's letter amending an application should have the name of the inventor, title of the invention, serial number, and date of filing placed in one corner, at the top of the page, and in the opposite corner of the page should be placed the division number and room number, which may be found at the top of the Examiner's letters. The applicant's letter should be addressed to "The Commissioner of Patents" and should open with the clause "In response to the Office action of (date) amendment is hereby made as follows:"

Following the specific directions for amendment should be the "remarks," signature of the inventor, and the date of the letter.

"The applicant when amending his case by canceling rejected claims should request that the claims be renumbered consecutively. Should he neglect to do so the Examiner may properly so renumber them and the ap-

plicant should be notified of the renumbering." Tuttle, 102 O. G., 1781; C. D., 1903.

"Amendments to an application should be actually signed by the applicant or his attorney with pen and ink or equivalent writing material. Amendments signed by means of a rubber stamp will not be accepted." Minehan, 134 O. G., 1298.

"When there has been an assignment of an undivided part of an invention the amendments to an application must be signed by both the inventor and assignee." (Rule 6.)

"It is a well-settled practice of the Office that an amendment can not be entered in part, since for the Examiner to undertake to enter an amendment so far as it is responsive and to refuse to enter the remainder thereof would lead to endless confusion." Hodge, 173 O. G., 1079; C. D., 1911.

"A substitute specification is objectionable and in general should not be filed unless required by the Office in view of the number and nature of the amendments to the original specification." Oreweiler, 170 O. G., 481; C. D., 1911, 100.

REQUESTS FOR RECONSIDERATION.

"A mere request for second consideration without explanation or argument, and without 'distinctly and specifically pointing out the supposed errors in the Examiner's action,' Rule 69, is not sufficient to entitle an applicant to reconsideration." Appel, 84 O. G., 1145; Krejci, 121 O. G., 1011; C. D., 1906.

"Should the applicant file a paper containing merely such request it would be proper for the Examiner to inform the applicant that the paper is not responsive to the Examiner's action and should the proper response not be filed by the applicant within the year running from the date of the Examiner's previous action the application will become abandoned." La France, 105 O. G., 262; Busenbenz, 117 O. G., 600; C. D., 1905.

The action of the applicant should be fully responsive to the Examiner's action.

UNRESPONSIVE AMENDMENTS.

"Should an applicant present an amendment canceling two of his six rejected claims and substitute others therefor and take no action whatever as to the remaining claims, the action would be considered unresponsive and insufficient to save the application from abandonment." Schmitt and Tanody, 121 O. G., 688; C. D., 1906.

"Where the Examiner has made requirements as to matters of form and has found that any of the claims are allowable, an amendment which does not comply with the requirement of matters of form or point out wherein they were improperly made is not completely responsive." Fox, 211 O. G., 955; C. D., 1915.

AMENDMENTS TO DRAWINGS.

"Where an applicant makes claims to a certain feature of an invention clearly described in the specification but not illustrated in the drawing an amendment to the drawing illustrating the feature described and claimed is justified." 110 O. G., 1428; C. D., 1904, Zwiebel.

"Where photographic prints of the original drawings have been made part of the record, it is permissible to make slight changes in the original drawing, but not such changes as practically obliterate the identity of any of the original figures." Kuhlman et al., 102 O. G., 229; C. D., 1903.

Permissible changes in the construction shown in any drawing may be made only by the Office and after an approved photographic copy has been filed (Rule 72). No changes should be made in the drawings until the approval of the Examiner of the proposed changes has been obtained.

SUPPLEMENTAL OATH.

"Where an amendment is filed claiming matter not covered by the original statement of invention or claim, a supplemental oath should be attached to the amendment, since an oath to matter presented for the first time after filing is just as important as is the original oath." Rurich & Bode, 106 O. G., 765; C. D., 1903.

"An applicant for a patent may properly file new claims

in the Patent Office without verification where they are within the invention disclosed in the specification and drawings and narrower than the original claims." *Gen'l Elec. Co. vs. Morgan Gardner Electric Co.*, 168 F., 52.

NEW MATTER.

"New matter can not be inserted in a case by amendment simply because the invention originally shown is inoperative and the amendment will make it operative." (Ex parte Snyder, 22 O. G., 1975; construed) Willits, 115 O. G., 1064.

"Mere clerical or draftsman's errors may be corrected where the errors are clear from the application itself; but changes can not be made in the application based upon allegations of fact not shown in the record." *Id.*

"Matter not originally shown in a second application can not be entered therein by amendment, although shown in a prior application abandoned in favor of the latter application." Hagey, 173 O. G., 1081; C. D., 1911.

"Matter can not be read into a case or inserted merely because it was invented before the application was filed and was intended to be included." *Dow vs. Converse*, 106 O. G., 2291; C. D., 1903.

"A general statement in the original specification as to a modification of the invention does not warrant an amendment to the drawing showing a species of the invention not originally disclosed." Mothes, 113 O. G., 1146.

"The fact that no claim is made to new matter inserted by amendment furnishes no good reason for permitting it to remain in the case." *Id.*

FINAL REJECTION.

"Where an applicant files an argument traversing the action of the Examiner and the Examiner insists upon his action without citing new reasons for rejection, a final rejection is in order." Casselman, 102 O. G., 230; C. D., 1903.

"Where the amendments or reasons presented by an applicant in response to an action by the Office do not necessitate the citation by the Examiner of additional

references or reasons, applicant's rights to further prosecution of the application before the Examiner is at an end, and the permission of further amendment is within the discretion of the Office." Miller, 139 O. G., 730; C. D., 1909.

"Where the Examiner points out certain formal objections in his letter finally rejecting the claims of an application the final rejection is not thereby rendered premature." Green, 130 O. G., 299; C. D., 1907.

AMENDMENTS PRESENTED AFTER FINAL REJECTION.

"Where after a final rejection an amendment was filed directing that the finally rejected claims be canceled and presenting new claims, held that a statement that neither the applicant nor his attorney had looked for a final rejection and in view of the Examiner's action applicant was willing to take narrower claims was not such a showing as required by Rule 68." (Citing *Ex parte* Miller, 91 O. G., 1033); Dietrick, 174 O. G., 829; C. D., 1911.

That the importance of features covered by proposed claims was previously overlooked is not a sufficient excuse for failure to file them before final action. Nettles, 107 O. G., 541; C. D., 1903.

That an applicant did not properly understand the invention is not a sufficient reason to warrant the admission of an amendment after final rejection. Schmidt, 100 O. G., 2602; C. D., 1902, 327.

An amendment presenting new claims filed after final rejection will be refused admission where the applicant has had ample opportunity to present such claims and the only excuse given for failure to do so was that it did not appear to be desirable until he was convinced that the broader claims presented were unpatentable in view of the references cited. Lange, 163 O. G., 727; C. D., 1911.

An applicant will not be permitted after a final rejection to file an amendment canceling the original rejected claims and inserting in lieu thereof new claims if such new claims differ in scope from the original claims and are not merely the original claims presented in better form. Landsing, 96 O. G., 2063; C. D., 1901, 129.

A party can not demand the admission of an additional claim after final rejection as placing the case in better forms for appeal, since if it differs from other claims it affects the merits. *Downing*, 100 O. G., 2176; C. D., 1902, 317.

SUBSTANTIVE PATENT LAW.

In preparing claims in an application an applicant should know that in the patent law—

“A combination as claimed is an entirety and disappears with the removal of one of its elements, and therefore it is a stated principle of law that where an element of the combination claimed is omitted there is no infringement.” *Lane vs. Levi*, 104 O. G., 1898; C. D., 1898.

“No one is an infringer of a combination claim unless he uses all the elements thereof.” *Cimiotti Unhairing Co. vs. American Fur Refining Co.*, 116 O. G., 1452; C. D., 1905.

“Where claims cover a product disclosed in references the fact that the references propose to produce the product by different processes is immaterial.” *Pratt*, 224 O. G., 1407; C. D., 1916.

“Under the court decisions the introductory phrase is not an element of the combination and does not limit the claim to such apparatus.” *Casler*, 90 O. G., 448; C. D., 1899.

The Circuit Court of Appeals has held a claim to a grab-hook bad because it included a draft appliance as an element of the combination. The grab-hook was new but grab-hooks and draft appliances in combination were old. The patentee did not invent the combination and should not have claimed it. The draft appliance acted in the same way as heretofore in the combination; that is, the new grab-hook did not act differently in the combination from old grab-hooks; hence the combination was not the new invention of the patentee. *Langan v. Warren Axe and Tool Co.*, C. D., 1911.

The mere function or effect of the operation of a machine can not be the subject-matter of a lawful patent but a process is something different.

“A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts,

performed upon the subject-matter to be transformed to a different state or thing. If new and useful, it is just as patentable as a piece of machinery. In the language of the patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable, while the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence." *Cochrane vs. Deener*, C. D., 1877, 242; 94 U. S., 78.

Applicants unfamiliar with patent laws frequently can not understand why their claim is rejected on two or more patents, taken together. To such, the decision of Assistant Commissioner Newton in *Ex parte McCollum*, as follows, may be of assistance:

"When legitimate combination claims . . . are rejected on two or more references, the trend of the best authorities indicates that at least one of the references ordinarily should show the general combination claimed. . . . Then if the specific features claimed and shown by the other reference or references may be substituted without such changes as require invention and perform the function intended the two references may be legitimately combined against the claim; otherwise not. . . .

Legitimate combination claims are for constructions or mechanisms for performing a function, and it is improper to reject them on ideas extracted from various references unless those ideas are accompanied by constructions that may be put together without so changing them as to require invention to adapt them to perform the desired result.

In determining the patentability of a claim found only in a plurality of references, it is necessary to consider the structural differences specified in the claims, as well as their functional difference or result. If the structures of the several references can not be combined without the exercise of invention, even though the result is old the claims should be allowed. If the structures of the references may be combined or substituted one for the other and the combined function or result is new, the claim should be allowed. It is only when both the structural features found in the references may be com-

bined without invention to meet the structure called for by the claim and the function or result involves no invention that the claim should be rejected." *McCol-lum*, 204 O. G., 1046; C. D., 1914.

DESCRIBED IN PRINTED PUBLICATION.

A device is "described in a printed publication" within the meaning of the Revised Statutes, section 4886, and therefore not patentable as a new invention, where it is shown in the drawings of a prior patent. *Keene et al. vs. New Idea Spreader Co.*, C. C. A., 230 O. G., 1185; C. D., 1916.

The question whether a patented device is the result of invention, or only mechanical skill, is one of fact. *Id.*

Where the elements of a combination claim were not merely old, but in point of equivalency had for years been devoted to the same uses in the same art and with substantially like results, the combination shows mechanical skill rather than invention. *Id.*

While a patented combination may not be anticipated by any single prior patent, such patents showing elements of the combination, are a part of the prior art, properly to be considered on the question whether invention or only mechanical skill was required to make the combination. *Id.*

COMPOSITION OF MATTER.

Where a claim for a composition of matter gives the names of the substances which are to be mixed together without stating any relative proportion, so that it would require experimentation to determine what proportions were necessary to secure the described result, the claim is void for failure to describe the invention in such full, clear and exact terms as to enable a person skilled in the art to practice the invention. *Panze vs. Battle Island Paper Co.*, 138 F., 48.

Where the only novelty involved in a device lies in the proportions of the parts and the description does not set forth these proportions, the patent therefor must be invalid for lack of sufficient description. *Electro-Dynamic Co. vs. Westinghouse Electric & Mfg. Co.*, 191 F., 506.

EQUIVALENTS.

The range of equivalents depends upon the extent and nature of the invention. If the invention is broad and primary in its character, the range of equivalents will be correspondingly broad under the liberal construction which the courts give to such inventions. *Continental Paper Bag Co. vs. Eastern Paper Bag Co.*, 136 O. G., 1297; C. D., 1908.

IMPROVEMENT IN DEGREE.

The mere carrying forward of an original conception, resulting in an improvement in degree simply, is not invention. *Keene et al. vs. New Idea Spreader Co.*, C. C. A., 230, O. G., 1185; C. D., 1916.

CLAIMS OF UNWARRANTED BREADTH.

Claims broader than an applicant's conception, presented for the purpose of covering something different than the essential elements of the applicant's idea of means would be rejected.

An applicant will not be allowed claims made broader than the essential element of his idea of means by the use of indefinite terms or by the omission of things essential to his idea as conceived and disclosed. *Fritts*, 237 O. G., 737; C. D., 1916.

APPEALS.

Should an applicant traverse the propriety of a final rejection of his claim by an Examiner he may appeal from such rejection to the Examiners-in-Chief as provided in Rules 133 to 137.

INTERFERENCES.

An applicant, unless he has had previous experience, is advised against attempting to personally prosecute an interference proceeding should he be advised by the Office that his claim interferes with that of another applicant. The prosecution of an interference proceeding is so technical and complicated as to require the services of a competent patent attorney.

March 8, 1917.

The Development of Fundamental Principles Involved in the Patent System and Their Relation to the Examination of Applications for Letters Patent.

A paper read September 28, 1912, before the Engineering Corps of the United States Patent Office.

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The Development of Fundamental Principles Involved in the Patent System and Their Relation to the Examination of Applications for Letters Patent.

BY

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INTRODUCTION.

This paper is of a general elementary character, intended to be at least suggestive of a field of study which, because of its elementary character, may have been to some extent neglected and it contains reference to fundamental principles involved in the establishment of the patent system and in the grant and refusal of letters patent and some consideration of statutory provisions relating to the examination of patent applications which, it is thought, are in accord with elementary principles and fundamental law.

In this the most remarkable of all industrial ages men are studying and seeking as never before to find fundamental truths in all departments of human knowledge and effort. Men well know that the deeper and the more profound the ascertained fundamental facts and principles upon which human knowledge is based, the higher will be the character and substance of the structure and system of human attainment based thereon.

In the more limited field of law and jurisprudence, there are clear indications that men of profound thought upon the bench and in the profession of the law, are of the opinion that existing law and procedure should be revised and simplified so that legal fiction and technicality may not stand in the way to prevent the rendition of

decisions that accord with fundamental truth and simple justice.

And in a very special way the investigation of fundamental truths involved in the development of industrial progress, if applied in the work which we as judicial officers of the government are called upon to do, should, in some measure at least, result in a fairer view of the matters of substance which must be considered in determining whether products of man's creative genius shall or shall not be published to the world as patented inventions.

Moreover, it is believed that the work of examining applications for patents should be vitalized and made of more lively and absorbing interest to the examiner, and it is submitted that the thorough study of fundamental principles and the full and deliberate application of them to the examination of alleged inventions, may to some extent at least, assist in attaining this much desired end.

It is believed that before an examiner can appreciate the full importance and true significance of the judicial and technical work that he has to do, he should be thoroughly familiar with all fundamental principles involved in the grant or refusal of letters patent for inventions.

He should know whether patents are in fact monopolistic or not monopolies in restraint of trade; he should know of the educational character of the grant and its bearing upon the question of patentability; he should know of the contractual character of the grant and how it is involved in the proper attitude and point of view of the examiner in considering cases before him; he should know the true meaning of the constitutional provision upon which our patent system is based and its true relation to the character of the grant that should be issued; he should know the real meaning of the statutes, and he should know that existing statutes are absolute controlling factors in determining the practices involved in the examination of patent applications; he should know the law of evidence and how to weigh evidences of patentability or the want of it, upon the scales of evenly balanced judgment and justice alike to the inventor and to the people; and he should know that he, himself, is a very important positive factor, in probably the greatest constructive, industrial educational

system that the world has ever known, designed to create and encourage the industrial progress of the nation, and that he is not a mere negative element standing as an obstruction to prevent the publication in patents of new discoveries and inventions that may promote the progress of the industrial arts and the consequent prosperity of the people.

NON-MONOPOLISTIC FUNDAMENTAL PRINCIPLE.

It is believed to be a matter of some importance that it should be known in the first place that the rights conferred upon true inventors by valid patents are not in and of themselves monopolies in restraint of existing trade, although letters patent, like any other form of personal property, as coal, wheat, sugar or meat, may or may not be a basis for monopoly if all or a controlling number of patents in given arts be bought up and improperly manipulated.

In order to contrast the kind of industrial grants which have been held to be monopolistic and other grants under valid letters patent which have been held to be not monopolistic, your attention is invited to the foundation decision in the case of *Darcy vs. Allen*, Kings Bench, 1602, in which it was sought to enforce a grant of the exclusive right to import and sell playing cards within the realm.

In this case it was decided upon demurrer that the grant was *void* because against the existing rights of the people, and that it was a monopoly under the common law, the court holding that:

“There are three inseparable incidents of every monopoly against the commonwealth, (1st) that the price of the commodity will be raised, for he who has the sole selling of any commodity may and will make the price as he pleases; (2nd) that after the monopoly is granted, the commodity is not so good and merchantable as it was before, for the patentee having the sole trade regards only his private benefit and not that of the commonwealth, and (3rd) that it tends to the impoverishment of divers artificers and others who

before the grant, by the labor of their hands in their arts or trade, had maintained themselves and their families, but who now will of necessity be restrained to live in idleness and beggary."

Following this decision the same question came up in the well-known Clothworkers of Ipswich case Kings Bench (1615), and in this case it was held that the grant by the Crown of the exclusive right to work in the tailors' trade in the town of Ipswich was void as being a monopoly against the existing rights of the people who, it is held, "have the free and common right to work in any existing trade as the birthright of every subject."

However, in this same decision it was stated:

"But if a man hath brought in a new invention or if a man hath made *a new discovery of anything*—in such cases the King of his grace and favor, in recompense of his costs and travail, may grant by charter unto him that he shall use such a trade or traffic for a certain time, because at first the people are ignorant and have not knowledge or skill to use it; but when that patent is expired the King can not make a new grant thereof, for when the trade has become common and others have been bound as apprentices in the same trade, there is no reason why such should be forbidden to use it."

This decision may properly be termed, it is thought, about the first to sharply distinguish between those grants of industrial privileges conferred by the Government in derogation of the prior existing rights of the people and commonly called monopolies and those other grants to men for limited times of rights to the exclusive ownership of the products of their own genius for invention and discovery, which are not grants in derogation of prior existing rights of the people, but, on the contrary, create new forms of property for the education and benefit of the whole people for all time.

Following this decision the Statute of Monopolies, enacted in 1624, especially excepted from its provisions the grants to inventors of the exclusive ownership of

their inventions for a limited time and thereby legally established in England the non-monopolistic character of the grant.

In this connection your attention is invited to a decision rendered more than two hundred years later by Justice McLean in the case of *Parker vs. Haworth*, 4 McLean, 370, in which he said:

"The policy of the law which protects inventors is wise. It stimulates genius by endeavoring to secure a reasonable compensation to those who have spent their time and money in producing something of utility to the public. *It is not a monopoly the inventor receives.* Instead of taking anything from the public, he confers on it the greatest benefits; and all he asks and all he receives is that for a few years he shall realize some advantage from his own creation; not that he withholds his machine or discovery from the country, but that in distributing it he may receive a small compensation for the great benefit he confers. The triumphs of the inventor are intellectual triumphs. His demonstrations are made through mechanical agencies, but these in the highest degree are attributable to mind; and the same may be said of useful inventive mechanics generally. The usage of their thought embraces the system of natural philosophy in all its practical bearings; and, in carrying out their views, the highest degree of mechanical ingenuity. Through the labors of these men our country has been advanced by machinery on the land and on the water; in the saving of labor and in a rapid and increasing intercourse, and especially in the communication of intelligence in the last forty years more than could have been hoped for without their instrumentality, in many centuries."

FUNDAMENTAL EDUCATIONAL PRINCIPLE.

Besides bringing out the distinction between void grants of monopolies in restraint of trade and valid grants in letters patent for invention, this foundation decision

in the Clothworkers' case indicates the fundamental reason why grants of letters patent should be issued, as shown in the following statement:

"because at first the people of the Kingdom are *ignorant* and have not the *knowledge* or *skill* to use it."

Thus the education of the people in the practice of new and useful inventions, by the patented disclosures of inventors, is shown to lie at the very foundation of the patent system and to constitute the real reason for its establishment.

And although the fundamental object of the establishment of the patent system was to *educate the people* in the practice of new inventions and thereby to promote industrial progress and prosperity, and although the patent system has developed into an enormous industrial educational system in which should be interested every person, firm or corporation that may make, use, or sell manufactured commodities, it is probable that there is greater elementary ignorance among the people in relation to this great system than about almost any other important subject. And this leads to the conclusion that the people generally should be educated, in an elementary way at least, about the provisions of this system which was established in their interest.

FUNDAMENTAL PRINCIPLE INVOLVING ANTICIPATION.

Referring again to the Clothworkers' case it will be seen that it contains also the first indication of the fundamental principle involved in the question of anticipation and the refusal of letters patent as shown by the following statement:

"But when that patent is expired the King can not make a new grant thereof, for when the trade has become common and others have been bound as apprentices in the same trade, there is no reason why such should be forbidden to use it."

Thus it will be seen that not only is the education of the people in the practice of the new and useful inventions the fundamental object of the establishment of the patent system and the reason for the grant of letters patent, but the fact that the people have already been educated to practice alleged inventions is the fundamental reason for the refusal of grants therefor.

FUNDAMENTAL CONTRACTUAL PRINCIPLE.

This early decision also brings out to distinct view the first conception of the contractual character of the grant, for therein it is stated that it would be lawful to issue such a grant because it would be "in recompense for the costs and travail" of the inventor. And two hundred and seventeen years later, in the familiar case of *Grant vs. Raymond*, Chief Justice Marshall said:

"To secure to inventors the exclusive rights to their discoveries is the reward stipulated for advantages derived by the public for the exertions of individuals and is intended as a stimulus to those exertions" and "The laws which are passed to give effect to this purpose ought to be considered in the light in which they have been made and to execute the *contract* fairly on the part of the United States where the benefit has been received."

SOME OTHER FUNDAMENTAL DECISIONS.

In the interval of time between the enactment of the Statute of Monopolies in 1624 and the adoption of the Constitution of the United States, there were several recorded decisions in patent cases in England which contain some of the fundamentals upon which our own patent system was established and among these decisions may be briefly mentioned the following:

(1) *Edgeberry vs. Stevens* (K. B., 1691) containing reference in a rudimentary way to the later provision of law that prior knowledge abroad of an invention will not defeat the grant of a domestic patent for the same invention.

(2) *Dolland Case* (C. Pleas, 1766) in which prior secret use of an invention in England, by which the public could not have been taught to practice the invention, was held not to invalidate a patent to another for the same invention, because the later inventor and patentee and not the earlier secret inventor was the means by which the invention was made known to the public.

(3) *Roebuck vs. Stirling* (House of Lords, 1774) in which prior public use of the invention in England was held to invalidate a later patent to another for the same invention.

(4) *Arkwright vs. Nightingale* (Com. Pleas, 1775) in which it was held that—

“the specification is addressed to persons in the profession having skill in the subject, not to men of ignorance, and if it is understood by those whose business leads them to be conversant in such subjects, it is a sufficient specification under the law.”

(5) *Liardet vs. Johnson* (K. B., 1778) in which a patent was declared void because the specification did not constitute a complete description of the invention, the court holding that—

“the meaning of the specification is that others may be taught to do the thing for which the patent is granted and if the specification be false, the patent is void, for the meaning of the specification is that after the term, the people shall have the benefit of the discovery.”

These decisions, it is thought, indicate the first evidences of a system of fundamental laws involving patents at the dawn of the modern industrial era, in that, even at that early date across the seas, there were distinct indications of the industrial value to the people that resulted from granting to inventors the exclusive ownership of their inventions for limited times as a consideration for the publication thereof in the interest of the people and to educate them in the establishment and practice of new arts and industries.

FUNDAMENTAL CONSTITUTIONAL PRINCIPLE.

It was probably with these facts in mind and having in mind also that the newly formed Union of States could not progress industrially without new means for solving the new industrial problems that lay before them, that Mr. James Madison on August 18, 1787, presented for the consideration of the committee of eleven of the constitutional convention, a memorandum of the several powers which he thought should be conferred upon Congress.

This memorandum contained the following two separate paragraphs:

- (1) "Congress shall have power to secure to literary authors their copyrights for a limited time" and
- (2) "Congress shall have power to encourage by premiums and provisions the advancement of useful *knowledge* and discoveries."

It will thus be seen that the fundamental conception in this country that is involved in the establishment of a system of industrial development is shown to have involved primarily the advancement and dissemination of *knowledge* of new discoveries and inventions and this conception of the educational character of such a system is clearly consistent with that earlier conception at first referred to in the Clothworkers case one hundred and seventy-two years prior thereto.

In the final form in which this matter was presented to the constitutional convention by the committee of eleven on September 5, 1787, the two separate paragraphs above referred to were combined into one and in the words so familiar to you all, it was adopted unanimously and without debate.

And sitting, as those men were in convention assembled, to invent and establish a new form of government consisting of the combination of executive, legislative and judicial elements which have cooperated to produce a new result in governmental machinery such as the world had not known before, it was but natural that they should have laid this foundation for the great industrial progress of this nation.

In plain and unmistakable terms, the constitutional provision tells the purpose and object of the establishment of the patent system in the words, "To promote the progress of science and the useful arts," and in so far as the writer has been able to discover, this is the only paragraph of the constitution which in terms provides for the promotion of industrial progress in the interest of the people.

As the phrase quoted clearly indicates the purpose and object of the establishment of the patent system, so also the only *means* provided by the constitution to be employed to carry that purpose and object into effect, is found in the words "by *securing* for limited times to inventors the exclusive rights to their discoveries."

It was to the ingenuity of the American inventors, then, that the founders of the Government looked to establish industrial enterprise and the fact that this nation today stands second to none in general industrial importance, is proof of the accuracy of the prophetic vision of those who placed the foundations of American material progress upon the shoulders of men who have been and are endowed with the power of original thought and the courage of original action.

GENERAL OBSERVATIONS AS TO FUNDAMENTALS CONSIDERED.

With these general considerations in view with regard to the historical development of the educational, contractual and constitutional characters of the grant, it may be assumed that the first and most fundamental test to be applied to the examination of alleged inventions in patent applications is this: Would the subject-matter if patented or published educate the people to practice a new or improved industrial art or construct a new or improved industrial instrumentality.

A favorable opinion of this question should be very helpful to the examiner in deciding doubtful legal and technical problems in favor of the applicant.

Viewed also from the standpoint of their educational character, patents should be granted in the interest of the people in all cases except where evidences of prior public knowledge of the alleged invention make it clear

that those of ordinary skill in the arts are, constructively at least, already in possession of that knowledge and, in view of the fact that it is in the interest of the public that they should without delay obtain this instruction, it is a matter of much consideration that patents be expeditiously granted, due regard being had, however, to thoroughness of the examination which eventuates in the final refusal or grant of the patent.

Viewed from the standpoint of the contractual character of the grant, patents should be granted in all cases where the consideration offered by the applicant in the character of the disclosure of the inventive subject-matter would be "sufficiently useful and important" (R. S. 4893) to the public and would constitute an adequate consideration for the rights conferred by the public upon the inventor in the character of the exclusive ownership of the right thereto. The contract should be fair in its terms equally to the inventor and to the public, and for this reason, the examiner should learn to study each case before him both from the standpoint of the inventor and from the standpoint of the public. In this way only will the examiner acquire such an unprejudiced, judicial attitude as is essential to the rendition of fair and impartial decisions in matters relating to patentability.

It may be helpful to the examiner to view the application as having an inter-partes character and as if it were an executory contract and to consider that he sits as a judge to determine from all the facts and the law involved, what the terms of that contract shall be when executed; remembering full well that if the terms of the contract are to be fair, the scope and character of the claims allowed should be in direct correspondence with the extent to which the people will have been instructed by the disclosure.

In the earlier ages of the patent system, some examiners held that they represented the people only and that it was their duty in the interest of the people to prevent the allowance of patents to inventors. A deeper study of fundamental principles, however, now reveals a fairer and better conception of the examiner's duty, a conception that is helpful to the examiner in that it cultivates the habit of evenly balanced judgment and

relieves him of the monotonous strain of one-sided effort, a conception that lubricates the machinery of legal and technical labor and that results in fairness and fundamental justice alike to the people and to the inventor. This conception is—that the examiner as a judicial officer of the government of the people, represents equally the interests of the people on one hand and those of the inventors, who are of the people, on the other. And then, this judicial character of the examiner's work in considering the rights of inventors as well as the rights of the people in cases before him, if pursued with an open, fair mind, will more eminently qualify him for the more remunerative but less important work of the patent solicitor and lawyer, or the more responsible but less remunerative work of the Primary Examiner, Examiner-in-Chief or Commissioner of Patents.

Viewed from the standpoint of the constitutional provision, patents should not be granted except in those cases where the arts and sciences may be promoted thereby and only in those cases in which inventors may be made *secure* in the *exclusive* rights to their inventions. It constitutes an obvious violation of the constitution to grant patents for alleged inventions which do not promote the progress of the useful arts, which do not make the inventor *secure* in his rights and which do not confer upon the inventor the *exclusive* right to his invention. In this connection it should be borne in mind that inventors may not be made secure in the exclusive right to their inventions if the claims granted be so broad or so improperly drawn as to be invalid in view of the prior art, or if the claims patented contain useless or unrelated limitations in addition to a fair definition of the real invention. This indicates the fundamental importance of mature and earnest endeavor to make thorough searches to find statutory bars if they exist and to so act upon applications as to eliminate from claims limitations that may be unnecessary and unrelated to the real invention.

ESSENTIALS IN THE APPLICATION OF FUNDAMENTAL PRINCIPLES.

Having now taken the liberty of inviting your attention generally to the non-monopolistic character, the educational character and the contractual character of the patent grant and to the constitutional provision relating thereto, it may be found of some little interest to consider some of the essentials that should be involved in the work of the examiner if applications are to be examined and patents granted in accordance with fundamental principles and fundamental law.

First, therefore, it would seem to be essential that the examiner should clearly appreciate the difficulty, dignity and importance of the work before him and the serious responsibility of deciding questions that may involve the material progress and prosperity of the nation and the failures or fortunes of men. Prominent jurists have expressed the opinion that the preparation and consideration of applications for letters patent involve the consideration of some of the most difficult legal and technical problems and that they themselves have ascertained from the judicial consideration of cases before them that the patent law constitutes what may be termed *the metaphysics of the law*. If this be the opinion of the justices of our Federal courts who, while maturely deliberating upon the questions at issue, are aided in rendering their decisions by the opinions of experts, by practical demonstrations, by the fullest possible presentation of facts bearing upon the question of validity both from the standpoint of the people and from the standpoint of the patentee, and by exhaustive briefs disclosing the law and the facts as presented by well qualified lawyers; if this judicial work under these helpful and favorable conditions be considered most difficult and metaphysical, then surely the work of the examiner, who must often be his own legal and technical expert, who must search and produce evidences of invalidity as well as legal precedent for his own judicial decisions, who is often without the assistance of proper disclosure and practical evidences of patentability and without sufficient time and facilities to permit proper consideration of the serious questions presented—surely such combined legal, technical and judicial work may properly be

termed still more difficult than that of the jurist and may justly be termed the super-metaphysics of the law.

Having been thus impressed with the serious importance of the work before him the examiner should realize that there is no easy or superficial process of properly examining applications, and that the interests of the people and the interests of inventors alike demand the mature and thoughtful examination of all subjects matter presented, and full and fair consideration of all legal questions before him.

Secondly, Matters of Substance and Matters of Form.

If applications are to be granted in accordance with fundamental principles and fundamental law, the mind of the examiner should be trained and directed to an important consideration of all matters of substance and to relegate to a secondary position matters of form.

In order that the relative values of these questions may be gauged with some degree of accuracy, it must be determined in the first place what generally are matters of form and what generally are matters of substance.

The conclusion as to this question seems necessarily, under the law, to be that all matters that would affect the validity or the scope of the patent when granted may be considered matters of substance, and all matters which, according to statute and court precedent, have been considered *not* to affect the question of validity or scope of the patent may be considered matters of form.

If these holdings be accepted, it follows that matters of substance must be of material and controlling importance, and matters of form must be of secondary importance.

So far as the statutes are concerned it does not appear that they give prominence to any formal matter within the scope of the examiner's work, and in view of the fact that a court will presume that all such formal requirements have been complied with even where from the patent file it does not appear positively that such requirements were in fact complied with, the small, relative value of mere formal matters may be clearly seen.

However, it appears that in office practice and apparently without basis in fundamental law, there has developed some phases of the so-called question of "form" that should be considered. This is especially true of what have been termed claims "bad in form."

In so far as known neither does the statute nor does any controlling foundation decision prescribe any form for any claim.

Claims that have expressed elements in the alternative have been considered "bad in form" as likewise have claims which have been held to be ambiguous, and such claims as are indefinite and such as may not define sufficient elements to support functional expressions. Yet the only fundamental legal requirement as to claims is that they shall "particularly point out and distinctly claim the part, improvement or combination" which applicant claims to be his invention. (Revised Statutes 4888.)

The writer can see no fundamental distinction in general character between claims which in the past have been objected to because bad in form and other claims which have been rejected because indefinite, and it is submitted that it would be conducive to a more expeditious consideration of applications if both the claims hitherto held bad in form and those hitherto held indefinite or functional were grouped together and all rejected because not drawn in compliance with the provision of the statute.

Thirdly, Complete Disclosure of Alleged Invention and of All Matters of Fact Supporting Patentability.

If applications are to be examined and patents granted in accordance with the educational, contractual and constitutional requirements, it is submitted that before, and as a condition precedent to the first consideration and examination thereof, there should be not only a full and fair disclosure of the alleged invention, which disclosure should be so clear and exact as to enable any one skilled in the art without further experimentation and without the exercise of higher than ordinary skill to produce the invention and practice the same, but also as a condition precedent to the first consideration of a case there should

be a full presentation of facts and matters of truth substantiating the patentability of the alleged invention presented just as it is a condition precedent to a *reconsideration* of an application that facts and reasons supporting patentability be presented. The writer is not unmindful of the difficulties experienced by solicitors in extracting from their clients all matters of fact relating to the substance of the invention, but this condition does not alter the fact that frequently the examiner, whether through ignorance or preconceived design of the applicant, has only the skeleton of the alleged invention to consider and examine, while the meat and the spirit of the invention are withheld from his consideration.

The consideration of applications has shown that only after a threat of final rejection, or after five or more years of prosecution of cases, have the real facts as evidence substantiating patentability been revealed to the examiner, whereas if these facts had been presented to the examiner in advance of his first consideration of the cases, it is probable that but one or two actions in these cases would have been necessary. What new result the alleged invention actually accomplishes in the art, whether the invention is practical or not, whether the invention accomplishes in fact the new results claimed therefor as indicated by a practical working of the invented subject-matter, and whether it does in fact promote science and the useful arts, are all material factors often already within the knowledge of the applicants and their attorneys at the time of filing applications, and it is submitted that as an essential condition precedent to a full first examination of applications, such matters of fact should be presented to the examiner in proper form as evidence along with the application when filed.

It is a known fact that upon appeals to the Board of Examiners-in-Chief fuller disclosures of facts bearing upon the question of patentability are presented than had been presented for the consideration of the examiner, and the longer the course of appeal the fuller the disclosure of these pertinent facts, and finally when, after the patent has been granted litigation ensues, then, may be, for the first time all the real reasons substantiating

validity that can be marshalled by the plaintiff are presented for the consideration of the court.

Besides the fact that both a disclosure of the alleged invention in such full, clear and exact terms as to enable those of ordinary skill in the art to practice the invention, and also a full presentation of facts as evidence substantiating patentability are essential to a full first consideration of an application by the examiner in accordance with fundamental principle, it seems clear that the public who permit the grant of patents and who are mainly interested and benefited by the grant of the patent should be advised of all facts bearing upon the matter of patentability, and these facts should be made a matter of record in each case whether they be presented before the first examination by the examiner or in response to official actions. There is no place in the proper prosecution and examination of cases for the allowance of claims in view of mere oral interviews, or in view of any reasons not of record of which the people may not be informed. See *ex parte Eckbo*, 116 M.S. Dec., 60.

In the case of every judicial tribunal known to the writer, excepting the examiners of patents themselves, the trial judge has all attainable affirmative and negative evidence before him *before* he renders his first decision, and no reason is seen why the examiners should be made an exception to this well established general rule.

Fourthly, Examination of the Alleged Invention. (Rev. Stat. 4893.)

If patents are to be granted with due regard to the rights of inventors as well as the rights of the people and in harmony with constitutional provisions, it is essential that a full and complete examination of applications such as is contemplated by Revised Statute 4893 be made. This examination should include not only a mature and critical reading and study of the specification and claims, and also drawings, if there be drawings, to determine whether the disclosure is as full, clear and exact as the statute (4888) requires, and to determine whether the matter as disclosed is operative or may lack utility, but the examination should also include a *fair*

search for patentable subject-matter in the disclosure as well as a full and complete search for references and other statutory bars, not only to the claimed subject-matter, but also to the disclosed subject-matter upon which the claims may be based, thereby forestalling the common practice of solicitors of shifting from one claimed subject-matter to another within the attainable prior art.

Were it true that claims presented in applications always are directed to the patentable subject-matter disclosed therein, the practice of searching for and examining only the matter claimed would obviously be the proper practice, but it is a conservatively stated fact in a fair proportion of applications presented, that the claims drawn are not directed to the patentable matter that may be disclosed in the specification and drawing. To substantiate the view that the whole application should be examined with a view to ascertaining what is the real essence and scope of the invention, if any therein, your attention is invited to Revised Statutes 4893 which provides that:

"On filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the *alleged new invention or discovery*; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is *sufficiently useful and important*, the Commissioner shall issue a patent therefor."

From a fair interpretation of this statute it would appear, it is thought, that not only the claims, but the subject-matter upon which the claims are based and all allegations in the specification should be examined and considered with a view to ascertaining what is the real invention, if any, and it is to be noted that this provision is mandatory and not discretionary.

In this connection it appears to be contrary to a plain rule of reason that the word "examination" in Revised Statutes 4893 be given any peculiar, unusual or hyper-technical meaning.

In every other line of work wherein analysis, diagnosis,

examination or judicial determination may be involved, the matter considered is generally subjected to thorough investigation from all points of view. In all such cases, not merely one-sided statements or claims as to the matter under consideration, but the result of the investigation itself, determines the exact character of the matter being examined. Accordingly it is submitted that applications for letters patent should be subjected to such analysis and investigation as generally are all other kinds of work subject to investigation and analytical research.

In further support of the view that, under Revised Statutes 4893, a proper examination of an application should be directed to finding out what is the real invention disclosed therein in view of the prior art, your attention is invited to Vol. 1, page 155, Robinson on Patents, in which it is stated that:

"The claim is to define what the Patent Office, after due examination, has ascertained to be the real discovery of the inventor, and it must be amended or withdrawn according to the judgment of the officers to whom this duty is committed."

In still further support of the view that the proper examination of an application should extend through and beyond the claim made to the "alleged invention," to the real invention, if any, that may be disclosed, attention may be directed to the fact that there are clear indications that judges of the Federal courts, who are best grounded in fundamental patent law, are looking beyond the claims in suit, through mere "environments," to the real essence of the invention made and, where the terms of the claims make it possible, are construing patented claims so as to give them the scope and meaning necessary to cover the real invention made by the patentee. In this connection see the very able decision recently rendered by Judge Dennison in the case of Davis Sewing Machine Co. *vs.* New Departure Manufacturing Co., 212 O. G., 1057.

And if it becomes thus necessary for the courts to construe claims and go beyond them to find the real invention in order that the patentee may be given protection for that which he really has invented, it would

appear all the more important for the examiner to so examine applications as to ascertain what the real invention is and what are needless limitations, before the patent is granted, in order that the patent when issued may show upon its face what the real invention is and in order that this legal construction of the patent through and beyond the terms of improperly granted claims may be made unnecessary.

Aside from these considerations, if searches be made through and beyond the claim presented it may result in finding matter disclosed that would be of value to the public and which may form the subject-matter of patentable claims, but which would not have been found and claimed if the claims alone as drawn by applicant or solicitor had been examined, and if no search beyond the claim had been made for patentable matter.

It would appear to be quite clear, therefore, that only by a thorough search for patentable matter in applications as well as for statutory bars to the granting of patents will the grant be fair in its contractual terms and will it be made in accordance with the constitutional provision; and, moreover, this full first examination of matter in and beyond the claims would doubtless render subsequent searches largely unnecessary and would necessarily expedite the final disposition of applications.

Fifthly, Information in the Interest of Inventors and References in the Interest of the People Including Inventors (Rev. Stat. 4903).

If patents are to be granted in accordance with fundamental law, and also with fair regard to the interests of the two real parties to the contract, it is submitted that after examinations have been made of applications in accordance with an interpretation of the meaning of the Revised Statutes 4893 that is in harmony with the fundamental principles that have been referred to at length, official decisions rendered as the result of such an examination should be made in accordance with such an interpretation of Revised Statutes 4903 as will be in harmony with the contractual and constitutional principles involved.

Revised Statutes 4903 provides:

"Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such *information* and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specification, the Commissioner shall order a re-examination of the case."

It is to be noted that this statute contains a mandatory provision to the effect that *information* as well as references shall be furnished to applicants, and it is submitted that this information should be such as to aid in determining the true scope of the real invention disclosed in order that claims may be presented that may make the inventor secure in the exclusive right to his invention.

The term "references" doubtless applies to all matters of fact constituting, under the statute, evidences of want of novelty and also references to all matters of law and fact constituting evidences of lack of invention under the statute.

And since such references to matters of facts and law under the statute are to be cited in official decisions in the interest of the people to prevent the granting of patents that invade the existing rights of the people, and in order that the people as well as inventors may not be deceived by the grant of inoperative or invalid patents, it would seem only fair and reasonable to assume that "information" under the statute should be given in official decisions both as to matters of fact and matters of law that will aid applicants in securing patents that will conform to the elementary principles involved in the contractual and constitutional characters of the grant.

SOME APPLICATIONS OF ELEMENTARY PRINCIPLES.

It may now be of some little interest to apply, in a simple way, the elementary and fundamental principles to which reference has been made, to some familiar

cases that frequently come before the examiner for consideration.

(1) Let us consider a case involving mill construction in which upon a thorough examination of the alleged invention as required by the statute the examiner finds that the claims for a crushing roll *per se* as presented are anticipated by the prior art, but upon search for patentable subject-matter finds a new and patentable invention disclosed in the relation that one crushing roll bears to another crushing roll. It is submitted that it is in accordance with fundamental requirements involved in the educational, contractual and constitutional character of the instrument under consideration and in accordance with a fair interpretation of Revised Statutes 4903 in harmony with these fundamental principles that information be given to the applicant of this patentable matter in order that it may be published in a patent to instruct and educate the people.

(2) Let us now consider another case involving the alleged combination of a grinding element having a new grinding dress with a new means of fastening the element upon its shaft. This claim may be patentable in so far as the prior art is concerned and it may be in the selfish interest of the people as one party to the contract that such a restricted claim be allowed. But the interests of the inventor are of equal weight and value with those of the people and viewed from the inventor's standpoint, such a claim should not be allowed, because it does not make the inventor secure in the exclusive right to what he has really invented and because the contract would not be fair in its terms to the inventor if granted for this subject-matter. It is submitted that in such a case as this the claim should be rejected for want of patentable combination between the grinding element with its particular dress on one hand and the particular means of fastening the element to the shaft on the other, and in accordance with the provisions of Revised Statutes 4903 applicant should be informed that separate claims, some to the grinding element with its dress and others to the means of fastening the element to its shaft may be allowed and that it is a useless limitation to claim such features in combination. It is submitted that there is just as much warrant in fundamental law for the refusal

of claims which by reason of unnecessary and unrelated limitations (whether they be new or old), may make inventors insecure and unexclusive in their rights, as there is for the refusal of claims which would deceive the public and be worthless to inventors, because invalid in view of the prior art.

(3) Let us consider a case for mill construction in which the **claims for a crushing roll having a special crushing dress and made, say, of manganese steel**, are found to be patentable in view of the prior art, **but upon a thorough examination of the alleged invention the examiner ascertains that the claims contain useless limitations by reason of the needless restriction as to the material of which the roll is made.** The examiner knows the fundamental principles involved in the contractual character of the grant in that the claims granted should be commensurate in scope and character with the scope and character of the disclosure made in the interest of the public, and the examiner knows that the presence of useless limitations in these claims may prevent the inventor from being made secure in the exclusive right to the real invention (the roll provided with the crushing dress) covered thereby as provided by the constitution, and accordingly in order that the patent may be granted in accordance with the provisions of fundamental law it is submitted that under the provisions of Revised Statutes 4903 the applicant should be given this information which has been acquired by the examiner, and he should point out to the applicant the true scope of his invention and what are the useless limitations in his claims.

(4) A case for, say, a grain thrashing mechanism is now considered in which is presented claims for alleged combinations of distinct and separate subjects-matter, for instance, the feeder and the cylinder threshing mechanism. The examiner in examining this case finds that the combination broadly is old and that each element is old as claimed. Both from his own study of the law relating to patentable combination and from a careful study of the very able but conflicting opinions expressed in papers read by examiners during the past year, the examiner has a very clear conception of the law relating to the patentability of combinations of old

devices. He therefore cites references to show that the combination claimed is old and that the separate devices are old and rejects the claims for want of invention in assembling the old devices in one structure, if no new relation or result appear to the examiner. However, in order that the decision of the examiner may be in conformity with the elementary principles referred to and comply with a fair interpretation of Revised Statutes 4903, it is submitted that the applicant should be given information as to the law points involved, to the effect that the rejection is made in the absence of evidence of patentable combination among the parts indicating the production of a new or improved result, the production of an old result in a better way or in the absence of a showing that one or more of the parts are caused to operate differently in the alleged combination than it or they did before in their separate capacities; and as indicating what is meant by a "new result" under the law, it is suggested that the decision in the case of *Deere & Co. vs. Rock Island Plow Co.*, 82 O. G., 1561, be studied. In this case the judge said:

"The new result of a patentable combination is a result which is new and distinguishable as compared with results produced by the elements in their separated state or as assembled in a mere aggregation without functional relations to each other. A combination is not unpatentable merely because its results may also have been accomplished by other combinations."

If, in searching for patentable matter, however, in the above noted case it appears from the disclosure that, for instance, there is a new relation of the feeder to the thresher in that the material is so fed and controlled by the feeder as to prevent choking the thresher cylinder, it is submitted that information as to the matter should be given under the statute.

(5) Another case involving mill construction may now be considered in which a thorough examination under Revised Statutes 4893 discloses the fact that the claims define a new and distinct subject-matter patentable in itself in view of the prior art, in the character of new grinding mechanism *per se*, in alleged combination with

feed mechanism, screens, and discharge mechanism which, together with the grinding mechanism, constitute the whole machine.

In such a case as this, it is submitted, references should be cited to show that the general combination is old; that therefore the people need no further instruction as to how such devices should be combined and such claims should be rejected because it is shown that applicant did not invent the combination, but he should be informed that he did invent the crushing mechanism *per se*.

There are several reasons why such claims as this, whether they be the only class of claims in the case, or are claims needlessly drawn in addition to other claims which properly define the real invention in view of the prior art, should not be presented or granted, some of which reasons are the following:

(1) Because, if such claims be presented for examination they complicate the work of the examiner by requiring searches for and examination of a plurality of distinct and often unrelated inventive subjects-matter in each claim and thus materially prolong the examination and prosecution of applications in this office.

(2) Because, if granted, such grant would be violative of the basic principle involved in the educational character of the grant in that the public having been once educated to make such combinations there is no reason or warrant in fundamental law for granting a subsequent patent to again educate the people to combine such devices.

(3) Because such claims are violative of the contractual agreement of the applicant to comply with the terms of the statute (4888) which provides that:

“Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall . . . particularly point out and distinctly claim the part or improvement . . . which he claims as his invention or discovery.”

(4) Because such claims in patents are violative of the contractual character of the grant, in that they do not define the real invention in terms coextensive with a less limited inventive subject-matter disclosed and in

that being thus unduly limited they constitute invitations to the patent expert freely to extract the essence of the real invention and conceal it in other material embodiments thereof.

(5) Because such claims in patents are violative of the constitutional provision in that they may not make inventors secure in the exclusive rights to their real inventions.

(6) Because such claims in patents have confused the minds of the trial justices and have led to many inconsistent and conflicting decisions in the various judicial circuits.

(7) Because such claims in patents make more difficult the task of the highest and best type of legal practitioner, who in more modern times, in the interest of their clients, seek to prevent litigation where possible, whereas, such claims constitute an obvious means of promoting prolonged entangling litigation so harmful alike to the public and to inventors.

(8) Because such claims if granted in patents may deceive the public in the belief that the patentee had invented the whole defined subject-matter; and in this connection your attention is invited to the foundation decision in the case of *Evans vs. Eaton*, 7 Wheaton, 356. In this case the plaintiff brought suit upon a patent for hopper-boy construction in a mill. The claim in this case covered inferentially, at least, the whole of the hopper-boy construction though the plaintiff had in fact made merely an improvement upon prior general machines. The plaintiff held that his patent was to be construed for either the whole machine or, if not susceptible of this construction, it should be construed as being for an improvement. So, thus early in the judicial consideration of patents we find the court confronted with one of the now familiar claims in the character of a nose of wax in which the real invention is so obscured in "environments" or additional matter as to permit the plaintiff to conceal his real invention and then, if his patent be litigated, he may seek to have it construed in one way to suit one condition, or in another way to suit another condition.

Justice Story, the famous patent jurist of the early days of the patent system, in deciding this case after

referring to the claim drawn as having "a double aspect" said:

"The very terms of the patent, as they have been already considered, and as they have been construed at the bar by the plaintiff's counsel, at the present argument, seem almost conclusively to establish that the patent is for the whole machine, that is, for the whole of the improved hopper-boy, and not for a mere improvement upon the old hopper-boy.

"It is clear that the party can not entitle himself to a patent for more than his own invention; and if his patent includes things before known, or before in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. If the same combinations existed before in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement, for if it includes the whole machinery, it includes more than his invention, and therefore can not be supported.

"The specification has two objects: one is to make known the manner of constructing the machine (if the invention is of a machine), so as to enable artisans to make and use it, and thus to give the public the benefit of the discovery after the expiration of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not, is not material to the present inquiry. The other object of the specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise

innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent, and at the same time of taking from the inventor the means of practicing upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification. How can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends—which describes the machine fully and accurately as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own? It seems to us perfectly clear that such a specification is indispensable, and we are of opinion that the inventor ought to describe what his own improvement is, and to limit his patent to such improvement."

The concealment of the real invention in alleged combination claims, whether through ignorance or by design, constitutes at the present time, as it did in 1822, one of the most serious abuses existing in patent practice, and unless the allowance of such claims be discontinued, it will constitute one of the most potent causes in impairing the usefulness of the patent system. These views in relation to the inclusion of useless limitation in claims containing patentable subject-matter are not only those of the best informed of the jurists of the early period of the patent system, but are also those of a thorough student of patent law upon the Federal bench and of two of the foremost patent lawyers of today, as have been evidenced by addresses made by them before this body of men, and the fact that examiners have been deciding cases for some years in accordance with these fundamental principles in order that patents granted by them may make inventors secure in the exclusive right

to their inventions, constitutes conclusive evidence that the opinions of Justice Story and those of the able gentlemen who have appeared before us are absolutely correct.

It is submitted that in decisions by the examiners in such cases as this, references showing the general combination should be cited, references to the fundamental law should be cited, and "information" under the statute should also be given to the applicant to show that his real invention may consist in the distinct inventive subject-matter that is original with himself and not in the alleged combination and, moreover, that it is a needless limitation to claim other matter in alleged combination with the real inventive subject-matter.

This does not mean that in all cases where novel inventive subject-matter of a distinct character is claimed with other matter, the claim should be rejected for reasons above stated. In many cases the novel subject-matter is in such relation with the other matter as to cause it to operate differently than it did before, and this may be termed a patentable combination of a new subject-matter and other devices. In such cases if claims for the patentable combination only be presented, it is submitted that, in the interest of the inventor he should be informed that claims for the patentable improvement *per se*, as well as for the patentable combination including the same may be allowed, for only in this way may the contractual and constitutional essentials be embodied in the grant of the patent therefor.

It is believed that a sufficient number of cases has been referred to, in order to indicate to some extent the writer's impression of the true meaning of Revised Statute 4903 and of its accord with fundamentally right principles as applied in rendering decisions as to patentability, and accordingly more extended specific references to cases will not be given. The examiners well know the law relating to all of the other grounds of rejection constituting bars to grants of claims, whether they involve the question of change of material, substitution of equivalents, duplication of parts, omission of parts, mere mechanical skill, etc., and it is submitted that, in decisions in all of such cases, not only references to prior

art and references to legal precedent unfavorable to the grant should be cited, but also "information" under the statute that will aid inventors as to how to overcome statutory bars, should also be given therein.

Sixthly, Notice of Prior Pending Art Under Revised Statutes 4904.

If patents are to be examined and granted with a view to making inventors secure in the exclusive rights to their inventions, in accordance with constitutional requirements, it is essential that notices of the prior unpublished pending interfering art be sent in all applications which would be anticipated or interfered with by the prior pending art disclosure, just as notices of prior published art are sent in *ex parte* cases.

Your attention is now called to Revised Statutes 4904 which is as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant or patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

It is to be noted that the statute refers to interfering "applications" and "interfering applications and patents," and not to mere *claims* for substantially the same invention, as per Rule 93.

Now, since it is essential that patentable matter be found in alleged interfering applications before an interference can be declared, and if a proper determination of the fundamental meaning of Revised Statutes 4893 and 4903 resides in the requirement that the examiner search for patentable matter as well as search

for statutory bars if they exist, and to furnish helpful information to inventors as well as to cite references, and if it be fundamentally right to set aside legal fiction in favor of fundamental fact and truth, then the essential is that an application interferes with another application or patent under the statute when the real invention in one application interferes with the real invention in another application or patent without reference to the particular claims which may happen to be drawn, whether by those who, having proper qualifications, draw claims to the real invention disclosed, or by those who by reason of ignorance, inadvertence, accident or mistake draw claims that are not directed to the real invention disclosed. It is believed that under the plain broad terms of the statute interference exists whenever co-pending applications or applications and patents contain common patentable subject-matter, and whenever the allowance of patentable matter in one case would interfere with the exclusive rights granted in another case. The terms "application" and "interfere" should be given their broad, plain and ordinary meaning and not a forced meaning based upon the legal fiction that the claim already presented defines the real invention and that the question of interference must be decided upon the claims that happen to be drawn in the respective cases no matter how ignorant the claimant may be in one case or how skilled the applicant may be in another case. An invention properly claimed in one case is not a different invention when, through inadvertence, accident or mistake, it is improperly claimed in another case or even when disclosed but not claimed at all therein. Proper prosecution and examination of both of such cases would necessarily result in finally allowing claims to the same real invention in both cases, and it seems quite reasonable to assume, therefore, that in determining the matter of the declaration of interference, consideration should be given through and beyond the claims already drawn to the real invention in each case.

It is believed that, in the past, when considering whether an interference should be declared, much error and consequent injury has been occasioned by determining this important question before one or more of the applications under consideration have been fully

prosecuted and examined with a view to ascertaining what is the real invention made by the applicant, and it is believed that before an interference is to be declared, it should be fully determined by proper examination and prosecution what is the real common invention in all cases involved.

The view that applications or applications and patents interfere when the right to the real invention in one case interferes with the right to the real invention in the other case without reference to the particular claims that may be drawn, does not mean that interferences should be declared in all such cases, but it does mean that in all such cases "notice" under the statute should be given to each party of the real interfering invention of the other party.

The importance of this *notice* under the statute can not be over estimated, because if notice be withheld and patents be granted without notice of anticipating prior pending art or pending art that would render insecure the rights already granted in the patent, the fundamental contractual rights, the constitutional rights of the patentee and the plain broad terms of the statute would be violated.

A case in illustration may be given by referring to claims involving a crushing roll having a novel crushing dress as an element of an organized mill. In one application filed by one inventor merely the roll *per se* having a particular new grinding dress is disclosed and claimed. In a later application disclosing the same roll having the same dress filed by another inventor, through ignorance, inadvertence, accident or mistake, merely the alleged combination of a roll with a grinding dress together with the elements of one of the several different forms of general mill construction is claimed. Claims to the crushing roll *per se* having the particular dress if they were presented would be allowable in the second application in view of the prior art, and if an interference were declared, evidence might be produced to prove that the second applicant was the first inventor thereof. However, no interference is declared, and the combination claim is patented without notice to this later applicant of the existence of the prior application in which the roll *per se* is claimed. This patentee has constructive

notice of all published anticipatory matter affecting this claimed matter and having no actual notice of prior interfering pending matter he presumes that there is no pending anticipatory matter that would prevent him from enjoying the exclusive right under the constitution to his invention that has been granted him, and may be he has established a plant and has procured others to make investments therein. Then afterwards the grant of the patent upon the roll *per se* soon convinces him that there is an interference with this right to practice his real invention and that he has no secure and exclusive right to make the invention made by him and much business disturbance and financial loss results.

It may be said that this fundamental wrong may be righted by a reissue of the patent first granted or by filing a divisional application, but in such cases if either the reissue or divisional application eventuate in a patent for the roll *per se* there would be two patents for the same invention which is plainly in violation of the fundamental principles which have been referred to in so much detail in this paper and would doubtless result in injury to the public.

In order further to illustrate the broad fundamental principle thought to be involved in a fair interpretation of Revised Statute 4904, let it be presumed that case "A" is filed in which is claimed "A tablet of wax-like material having a record of sound vibrations *cut therein*." The applicant in this case being skilled in the proper practice of drafting claims for the real substance of inventions and having in mind correct fundamental principles, does not conceal this broad invention in an alleged combination of elements of a sound reproducing machine, but distinctly defines his real invention in order that the people may clearly know the precise scope and character of the invention newly made. The examiner upon examining the alleged invention presented finds that the claim is clearly patentable in view of the prior published art. But upon investigation of the pending art the examiner finds an application "B" long pending and disclosing and claiming a method of duplicating sound records, the first step of a claim therein being: The method of duplicating sound records which consists first, in cutting in a tablet of wax-like material

an undulatory record of sound vibrations and then electroplating, etc. There are no claims in this case "B" for the process of making records of sound *per se*, or for the record made as claimed, but this new and patentable matter is covered up in the complicated claim referred to and accordingly no interference may be declared between cases "A" and "B" under the terms of Rule 93. Application "A" is allowed and is patented for the *exclusive* right to make, use and sell the record tablet as claimed therein, notwithstanding the fact that the Government when granting this exclusive right has full knowledge of the prior pending art as in case "B," which would necessarily invalidate the patent and make it *unexclusive* when afterwards the patent in case "B" is issued. The patentee in case "A" then knows for the first time practically, if this office did not know technically, that there was and is interference between case "B" and his case and that the grant by this Government has been not only valueless, but has occasioned much loss and business disturbance.

It is submitted that the grant of a patent to "A" without *notice* under 4904 of the Prior pending art that would interfere with the rights granted therein is not only clearly in violation of the contractual and constitutional character of the grant, but also is in plain violation of the express terms of the grant.

It is submitted that in all cases in which the real invention in pending applications or applications and patents interfere, notices should be sent to the parties whose interests would be affected without reference to the particular claims in the cases and that interferences should be declared in all such cases.

While these elementary observations have been made with reference to the question of interference with a view to inducing the examiner to study the fundamentals involved in the matter of interference under the statute, yet in order that this general question may be pursued a step further, the practice under Rule 75 will now be considered.

We have in former lectures been well informed of the essentials of affidavits under Rule 75 filed in order that the bar of prior patents granted within two years prior to the application may be avoided.

It is, however, with reference to its relation to the matter of interference under section 4904 that consideration will now be given. And to illustrate the fundamental point sought to be made resort will again be made to the crushing roll and the machine including the crushing roll, for illustration. Let it be assumed that the application filed by one inventor for the alleged combination including the novel crushing roll was filed first and the application by another inventor for the novel crushing roll *per se* has been later filed. And let it be assumed that the application for the alleged combination has gone to patent without notice to the later applicant and the claim for the roll *per se* has been afterwards rejected upon the patent. The inventor of the roll *per se* files an affidavit under Rule 75 in which he states facts showing that he completed the invention in this country prior to the date of filing of the patentee's earlier application and his patent issues for the novel roll *per se*, so that we now have two patents granted, one for the combination including the novel roll, and one for the novel roll *per se* and the exclusive rights granted to the first patentee are thus interfered with by the superior exclusive rights granted to the second patentee without notice to the first patentee. The real invention in these two cases is the same, for as we have seen in considering the educational and the contractual character of the grant, the real invention is that embodiment of the inventive disclosure which corresponds in scope and character with the extent to which the people will have been educated thereby and in both of these cases the people will have been taught to make a new and useful crushing roll and if it be that the real invention is the same in both of these cases and that the invention in one case does not become a different invention in another case because in may be improperly claimed therein, then it is submitted as a matter for elementary consideration and study whether under Revised Statutes 4904 before the allowance of the later application the prior patentee should not have been notified of said later application, the grant of which would interfere with the already existing exclusive rights granted to him. Not only in order to prevent violation of exclusive rights in the patent when granted, but also to prevent double patenting and to prevent harmful

litigation, notices under Revised Statutes 4904 should be sent both under Rule 75 and Rule 96 to applicants and to patentees advising them of the pending art containing claims that would interfere with the exclusive rights to which they would otherwise be entitled, without reference to whether the properly or improperly drawn claims be directed to the same matter or not.

These are some of the fundamentals which, it is thought, should be considered by those who may be unfamiliar with the elementary principles involved in the establishment of the Patent System and in the grant or refusal of Letters Patent for inventions, and the deeper and more thorough the consideration of these fundamental truths involved in the study and application of the principles to which reference has been made, the clearer will be the course to be pursued, not only in facilitating, expediting and improving the examiners' work, but also in avoiding criticism of, and in dissipating opposition to, the Patent System and to the present system of prosecution and official examination of patent applications.

If at any time, however, criticism or opposition to the Patent System appear among the people in whose interest it was established, the attitude of those concerned will doubtless be attributable to the following causes:

1st. Because the people generally have not been informed and do not know that letters patent for inventions are not monopolies in restraint of the existing right of the people, but that they create new forms of property for the whole people to be freely enjoyed by them after a period of exclusive ownership by the patentees.

2nd. Because the people generally have not been informed and do not know that the Patent System was established in the interest of the people as an industrial educational system, to educate the people to establish and practice new or improved industrial arts and enterprises and thereby to promote the industrial progress and material welfare of the whole people.

3rd. Because the people generally have not been informed and do not know that Letters Patent for inventions, are contracts made in the ultimate interest of the people, between the people on one hand and inventors on the other hand, the terms of this contract being that

inventors agree to publish complete disclosures and distinct definitions of their inventions, which otherwise may be kept secret by them, and that the people in consideration of the disclosure and publication thereof agree to make inventors secure in the exclusive rights to their inventions, the Government through its designated officials being charged with the duty of seeing that the terms of these contracts are fair alike to the people and to inventors.

4th. Because the people have not been informed and do not know that the only means provided in terms by the constitution to promote industrial progress and prosperity, are the rights granted to inventors of the secure and exclusive ownership of their inventions for limited times.

And if criticism of or opposition to the present system of prosecution and official examination of patent applications at any time develop, this attitude of those concerned may be found to exist because of the following conditions:

1st. Because some of those who solicit patents are known to prosecute patent applications solely to obtain patents and the incidental fees, without regard to whether the alleged inventions may promote the progress of the useful arts in the interest of the people and without reference to whether inventors are made secure or exclusive in the rights to their inventions and,

2nd. Because we examiners, in some instances at least, have granted some patents the examination record of which shows the distinct need of:

1st. A uniform standardized system of instruction for assistant examiners (possibly in a single Division of Instruction), and,

2nd. A uniform standardized system of examination of applications consisting of:

1st. A mature and deliberate examination of the alleged invention in the whole disclosure to find patentable matter, in the interest of the inventor, and thorough search in the prior art to find statutory bars in the interest of the people as indicated in Revised Statute 4893.

2nd. Standardized official actions giving full information in the interest of the inventor and full citation of

references in the interest of the people as indicated in Revised Statute 4903.

3rd. Due and timely notice of all pending applications which would, if granted for the real inventions therein, interfere with and make insecure and unexclusive the rights to inventions in other applications or patents, as indicated in Revised Statute 4904.

It is submitted that only by some such uniform standardized system of examination of applications as this, may the work of examiners be made to conform to the fundamental principles involved in the educational character and in the contractual character of the grant and possibly only by such a system as this may the examiner's work be made to comply with constitutional requirements which are controlling.

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Building Structures as "Manufactures"

A paper read December 27, 1916 before the Engineering
Course of the United States Patent Office

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Building Structures as "Manufactures"

By

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The purpose of this paper is to consider the question whether such structures as buildings and parts of buildings fall within the term "manufacture" as used in Sec. 4886, Revised Statutes. Robinson in his work on Patents defines a manufacture to be—

"an instrument created by the exercise of mechanical forces and designed for the production of mechanical effects, but not capable, when set in motion, of attaining by its own operation to any predetermined result."

As he points out, a manufacture possesses no inherent law which compels it to perform its functions in a given manner, and in this absence of principle lies the distinction between a manufacture and a machine.

A building, or part of a building, such as a wall, roof, floor, etc., is believed to fall well within the above definition of a manufacture. They are created by the exercise of mechanical forces, are clearly designed for the production of mechanical effects, and are not capable, when set in motion, of attaining to any predetermined result by their own operation.

Robinson, in Vol. 1, footnote to page 249, states that:

"A distinction is necessarily drawn by the courts between a plan or project for doing something and the method by which it is to be physically effected. The former, if the ideas or mode of delineation are new, may be protected by copyright, not by patent since the plan or project though capable of being carried out by the use

of means is not in itself a means. Thus, an architectural plan for the building of a house, though new and original, is not an art or any other form of invention,"

and cites *Jacobs vs. Baker* (1868), 7 Wall, 295.

One question that presents itself from the above is, what is meant by the expression "a plan or project," in the statement—

"a distinction is necessarily drawn by the courts between a *plan* or *project* for doing something and the method by which it is to be physically effected."

Of course, it is obvious that as far as the *plan* of a building or jail, in so far as it appears on paper in the form of a drawing, is concerned, it could only be protected by copyright, since when the drawing or plan is completed the result is merely a sheet of paper with numerous straight and curved lines thereon. But how about the completed building and component parts thereof after they are actually constructed? It appears to be equally obvious that *they* would not be the subject-matter for copyright.

An inspection of the *Jacobs vs. Baker* case, *supra*, reveals that there were four patents sued upon, the first of which claimed "a secret passage, or guard-chamber" arranged in a certain way, and the fourth of which was for constructing and arranging cells in jails with spaces therebetween and one above the other, while the claims of the second and third patents were for the specific structure of the wall and the joint between the plates thereof. Mr. Justice Grier in delivering the opinion of the court said:

"Now a jail can hardly come under the denomination of 'a machine'; nor, though made by hands, can it well be classed with 'manufactures'; nor, although compounded of matter, can it be termed a 'composition of matter,' in the meaning of the patent act."

Nor did he appear to think that it would come under the head of an "art."

From the subject-matter of the four claims as outlined above, it can be readily seen how those of the first and fourth patents could not be classified under the head of "manufactures," for the reason that they recite no structure whatever, but merely the arrangement of things in space; but when the second and third claims are considered, it is not at all clear how the learned judge could hesitate for a moment to classify the subject-matter thereof under "manufactures," since what these two claims recite is the specific structure of a wall and of the joints between the plate sections of such wall. Such structures clearly would not be properly classifiable under either "art," "machine" or "composition of matter"; however, on the other hand, if they can not properly be called a "manufacture" then a large part of the work in Divisions 33 and 29 (including a great volume of existing patents) must be considered as outside of the provisions of the patent statutes, to wit, for an "art, machine, manufacture, or composition of matter, or any new and useful improvements thereon," and such patents accordingly invalid. This, however, is not believed to be the case, and it is thought that such wall and joint structures are properly classifiable under the term "manufactures" whether claimed as being in a jail, a dwelling house, or piece of cabinet work, the latter of which Webster's Dictionary cites as an example of a "manufacture."

The *Jacobs vs. Baker* case, however, was not decided on the above question of law, but it was decided on the issues of fact, the evidence showing that the plaintiff *Jacobs* was not the first inventor. The reason for devoting so much discussion to this case is because it has been accepted in subsequent cases, such as the *American Disappearing Bed Co. vs. Arnaelsteen*, 182 Fed., 324, the *International Mausoleum Co. vs. Sievert et al.*, 197 Fed., 936, and *Fond du Lac County vs. May*, 137 U. S., 395, as settling the above question.

The structure covered by the patent sued upon in the case of the *American Disappearing Bed Co. vs. Arnaelsteen*, *supra*, before the Circuit Court of Appeals, Ninth Circuit, was a number of rooms, in an apartment house, so arranged that a recess was formed between two of them; into which recess a bed was to be rolled with the

foot of the bed so designed that it would close the mouth of the recess. In arguing the question as to whether or not the invention in this case came within the meaning of that part of the patent statute which states that patents may be obtained for a new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, it was contended that it should come within the term manufacture, when that term was given the liberal construction which accords with the genius and purpose of the patent laws. Mr. Justice Gilbert, however, was of the opinion that it would be an undue expansion of the word "manufacture" to hold that it includes the construction of a house, or of any room or recess in a house; that as used in the patent laws, the term "manufacture" comprises articles or implements made by human agency from raw or prepared material; and that it would be a gross misuse of the word to say that a house or a room in a house is manufactured. The court then cited the *Jacobs vs. Baker* case, *supra*, in support of this view.

In the lower court, Judge Wellborn cited the following definition (among others) of the word "manufacture" as given by Webster: "anything made from raw materials by the hand, by machinery, or by art, as cloths, iron utensils, shoes, cabinet work, saddlery, and the like," and then stated, "These definitions as illustrated by the examples given, obviously do not include a building." He also cited one definition of the word "manufacture" as taken from the *Century Dictionary* to be, "Anything made for use from raw or prepared materials; collectively, manufactured articles; figuratively, anything formed or produced; a contrivance," and also concluded that this definition did not include a building.

The plaintiff in the lower court called the court's attention to the following paragraph from Walker on Patents (4th Ed.), pages 12 and 13, section 17:

"The word 'manufacture' has a much narrower signification in the American patent laws than it has in those of England. In the latter it includes everything made by the hand of man; and also includes processes of manufacture. According to the former, processes are patentable because

they are arts, while some of the things made by the hand of man are patentable as machines, and some others are patentable as compositions of matter, and some others are patentable as designs. Whatever is made by the hand of man, and is neither of these, is a manufacture, in the sense in which that word is used in the American patent laws. The term should be held to justify a patent for the invention of a new and useful human habitation, or a new and useful improvement of such a structure. This statement is ventured, notwithstanding the facetious obiter dictum of Judge Grier in the jail case."

Judge Wellborn, however, in dealing with the above quotation from Walker, stated in his decision:

"If 'manufacture' were held to include everything made by the hand of man, not only would its popular meaning be disregarded, but at least two classifications found in the patent statute would be useless, since manufacture would then comprehend all that is included, either in the word 'machine,' or the expression 'composition of matter.' Furthermore, the text above quoted, notwithstanding the high respectability of its author, is met by the case which he himself refers to as out of line with the statement he ventures, namely, *Jacobs vs. Baker*" (which is the "jail case").

The patent in the above case was held void, on the ground that the subject-matter was not within the patent law.

In considering the term "manufacture," it is believed that the extensive use of the word "article" in connection therewith, as in the expression "an article of manufacture," has possibly had much to do with creating an idea in the minds of some that an object in order to be a "manufacture" must possess portability, and be capable of being made in a factory and placed on the market as a thing which can be readily moved and handled. That this is not the true test, however, is apparent from the

many classes and subclasses in the U. S. Patent Office classification to the contrary, such as Bridges, Masonry and Concrete Structures (under which may be found massive integral column and floor structures, large chimneys, silos, foundations, stairs, arches, etc.), Wooden Buildings, Paving, Ships, and Hydraulic Engineering (with its massive retaining walls and dams). It is obvious at a glance that the above named structures are not built in a factory, but are built *in situ*, the buildings, pavements and the like in their permanent resting place on land, and the ships in dry docks, or on ways. To be sure the smaller component parts may be made in a factory, but can it be said that when these parts are patented nothing further remains to be patented? Clearly not, in view of the endless number of decisions on combinations. Further, if such structures as named above are clearly not within the purview of the patent statutes, is it not readily supposable that in the present endeavor to catch up with the work, the Office would direct that all applications for such structures be at once rejected, without further search, as not falling within the classes of the patent statutes and thus make available the time of more examiners and assistant examiners on other lines of work.

It is generally conceded that a button-hook and a telescope come within the term "manufacture," yet can we say that the former is such, more so than the latter because of its size? Again, where would there be any line of difference in this respect between the small spy glass and the massive astronomical telescope? Would it be with the three-inch stand telescope at the street corner, with the six-inch instrument, or where? Again, would the small pocket revolver be any more a "manufacture" than the hunting rifle, or the mammoth modern cannon with its complex disappearing carriage? In the opinion of the writer, a building, a dam, a bridge, or the like is a "manufacture" just as much as the button-hook, revolver, telescope or cannon.

In support of the contention that a building or a part of a building is properly classifiable under the head "manufactures," the following decisions will be discussed:

In the case of International Mausoleum Co. *vs.*

Sievert et al. (Circuit Court of Appeals, Sixth Circuit, March 3, 1914), reported in 213 Fed., 225, the structure involved was a mausoleum in the form of a community crypt, having a hallway or lobby of sufficient size to accommodate the funeral attendants, and protect them, during the services, from the weather. The catacombs were arranged in vertical rows, tier upon tier, were separated by partitions of cement, and provided with valved-ports which communicated with the air spaces in the outer walls. This structure was clearly a building, and the second claim read as follows:

"A burial crypt comprising a structure with a reception hall-way, seamless catacombs located therein and spaced from the walls thereof whereby an air passage is formed, said catacombs being provided with valve-controlled ports at their rear ends which communicate with said air passage, said passage being provided with an outlet at or near the top of the structure, also valve-controlled ports at the front ends of the catacombs through which the air may be exhausted therefrom after the same are sealed."

The lower court, following *Jacobs vs. Baker*, *Fond Du Lac County vs. May*, and *American Disappearing Bed Co. vs. Arnaelsteen*, *supra*, held the patent involved to be for a building and therefore void as for a subject-matter not within the patent laws. This was reversed, however, in the upper court, by Judges Denison, Knappen and Cochran; the court saying:

"It seems clear that the making of the various parts of the mausoleum would be manufacture. The subject, in our opinion, does not lose its nature from the mere fact of the bringing of the parts together in a complete whole. . . . We think an improvement in mausoleum construction, aimed at securing convenience, preservation of the body, and sanitary conditions, should be classed as a manufacture under the patent statute."

In *Johnson et al. vs. Johnston*, 60 Fed., 618, Judge Acheson stated:

"The term 'manufacture,' as used in the patent law, has a very comprehensive sense, embracing whatever is made by the art or industry of man, not being a machine, a composition of matter, or a design."

This was quoted with approval in *Traction Co. vs. Pope*, 210 Fed., 443, *Mausoleum Co. vs. Sievert*, 213 Fed., *supra*, and *Riter-Conley Co. vs. Aiken et al*, 203 Fed., 699.

In the latter case the Aiken patent No. 718,044 was for a roof structure designed for use on large manufacturing buildings. In holding this to be patentable subject-matter the court said:

"To us it is clear that as building is embraced in the inclusive scope of 'useful arts,' and as buildings, both as a whole and in their constituent parts of wood, brick, glass, iron, etc., are manufactured products, and not natural objects, they fall within the broad terms 'manufacture' of the act of Congress and 'useful arts' of the Constitution. . . . To say that a roof falls within the domain of architecture is not to decide the question; for the question is not whether a roof construction is included in architecture, which of course, it is, but whether the roof section here in question is, in view of its several constituents and cooperating elements, a manufacture. We must not be misled by the factors of size and immobility. The pyramids, by reason of their bulk and solidity, are none the less a manufacture, as distinguished from a natural object."

Attention is further called to this case, and the decision in the lower court found in *Aiken et al. vs. Riter Conley Co.*, 205 Fed., 531, and the cases cited thereunder, as containing an interesting discussion of this question.

Robinson, in Vol. 1 of his work on "Patents," section 183, says, in discussing the subject of "Manufactures":

"The species of inventions belonging to this class are very numerous, comprehending every article devised by man except machinery upon the one side, and compositions of matter and designs upon the other."

That an arch of a bridge or like structure is a "manufacture" within the meaning of the patent law, see *Thacher vs. Mayor and City Council of Baltimore*, 219 Fed., 909.

In *Turner vs. Quincy Market Co.*, 225 Fed., 41, the Turner patent, No. 985,119 for an improvement in steel skeleton concrete construction in structures erected at least in part of reinforced concrete, was held to be for a "manufacture," within the meaning of the patent law.

In conclusion, it is believed that a consideration of the foregoing cases establishes the fact that the weight of authority is clearly to the effect that a building, or part of a building, is properly classifiable under the term "manufacture," and therefore constitutes patentable subject-matter; and that the Patent Office is not in error in granting patents for this class of structures.

December 21, 1916.

Certain Phases of Reissues

Particularly

Delay in Filing the Application, and Inadvertence, Accident or Mistake

*A paper read November 5, 1914, before the Examining
Committee of the United States Patent Office*

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WASHINGTON, D. C.
1915

BRIEF OF POINTS.

The first reissue statute was passed in 1832.

Prior to that time, reissues were granted, and they were upheld by the Supreme Court in *Grant vs. Raymond*.

Up to about 1882, the practice was extremely liberal, allowing a reissue of a patent practically at any time during its life, for anything which might have been claimed in the original, and sometimes even for more than was disclosed.

This resulted in great hardships to manufacturers.

To correct these evils the Supreme Court, in the case of *Miller vs. Brass Co.* (decided in 1882), laid down the doctrine of laches.

This doctrine was founded upon the theory that the statute did not in terms, provide for enlarged reissues. A change in the rules immediately followed requiring the applicant to file an oath setting forth what the errors were which constituted the inadvertence, accident, or mistake, and how they arose or occurred.

Where the claims are restricted delay may be disregarded, unless the delay occurred after the defect was discovered.

"Inadvertence, accident, or mistake," is used in antithesis to fraudulent intent, and comprehends every error by which the patent fails to give the protection which it should have given.

Claims may be broadened by reissue filed within two years, where there has been a clear error, which may consist merely of want of knowledge or attention, experience, or capacity on the part of the solicitor or the applicant.

After two years each case must be governed by its special facts and circumstances.

Certain Phases of Reissues, Particularly Delay in Filing the Application, and Inadvertence, Accident, or Mistake.

By
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REISSUES BEFORE THE FIRST REISSUE STATUTE.

In the foundation of our Government it was deemed conducive to the progress of its people that a monopoly for a limited time be granted to the inventors or discoverers of new and useful inventions. In conformity with the Constitutional provision the first patent statute was enacted in 1790 authorizing the Secretary of State, or the Secretary of War, or the Attorney-General, to cause letters patent to be made out in the name of the United States, it being required that such letters patent be attested by the President of the United States, and certified by the Attorney-General upon his finding that the grant had been made in conformity with the act.

It was obviously the purpose of the law to protect inventors for the actual invention disclosed, for clearly it would be a miscarriage of justice should the public be given the benefit of the inventor's disclosure without at the same time securing to him a monopoly of the invention for the period set out in the statute, which originally was fourteen years. But it sometimes happened that a patent, while disclosing the invention fully to the public, failed for some reason to protect the inventor in his exclusive rights. It was then a serious question how the rights of the inventor could be secured as there was at first no authority given in the statute to amend or correct an imperfect patent. Notwithstanding the failure of the statute to give any express authority in this regard patents were frequently reissued

with a view to giving to the inventor the protection which it was intended that the original patent should give. Reissues were at first granted by the Secretary of State. The right to reissue came before the Supreme Court for the first time in January, 1832, and the power to grant reissues was considered. The objection was raised that the Secretary of State was merely a ministerial officer and could exercise no power not expressly given. On this point, the court, speaking through Chief Justice Marshall, said:

It is undoubtedly true, that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true, that the act of Congress contains no words which expressly authorize the secretary to issue a corrected patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it is felt. If the new patent can be sustained, it must be on the general spirit and object of the law, not on its letter.

The opinion then points out that a law for the protection of inventors was one of the first passed by Congress, and that it was the purpose of that law to confer on them an exclusive right to their inventions for a definite period as a compensation for their exertions and the disclosure of the invention to the public. The law should be construed, the court said, so as—

to execute the contract fairly on the part of the United States, where the full benefit has been actually received, if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full

benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it during that time, the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has been innocently committed by the inventor himself? *Grant vs. Raymond*, 6 Peters, 218-240.

The decision held the reissue valid notwithstanding the absence of statutory authority to grant it.

STATUTORY PROVISIONS.

This decision was rendered in January, 1832. On July 3, 1832, the first reissue statute was enacted which provided "that whenever any patent which has been heretofore, or shall be hereafter, granted . . . shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section" of the act of 1793 "have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intentions been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired." This act also gave the right of reissue to his assignees. In the law of 1836,

the provision for reissues is found in section 13, which provided that reissues should be granted whenever a patent was inoperative or invalid "by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had a right to claim as new, if the error has, or shall have arisen by inadvertency, accident or mistake, and without any fraudulent or deceptive intention." The portion of the act of 1836 quoted is in substantially the same words as section 4916, Rev. St.—the present reissue statute.

Although the statute as it stands today is essentially the same as the statute of 1836, the practice was considerably modified from time to time, changes being brought about by judicial interpretation. Let us look at the development of the practice and the reasons therefor.

PRACTICE UNDER THE STATUTE CHARACTERIZED BY GREAT LIBERALITY—CAUSES AND RESULTS.

Reissues were always granted for the purpose of securing to the inventor the real invention which he sought originally to protect, when the original patent failed to give adequate protection through some inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the early practice all that was necessary to establish inoperativeness or invalidity, and inadvertence, accident, or mistake, and absence of fraudulent intent was the affidavit of the inventor or assignee to that general effect. It was not necessary to make any statement, under oath or otherwise, showing in what respect the original patent was defective, what the errors were, or how they arose or occurred. The first provision in the rules requiring the applicant for reissue to specify the defects in the original patent and the errors which occasioned them occurs in Rule 46 of the Rules of September 1, 1863, which provided that "all applications for reissue must be accompanied by a statement clearly setting forth in what respect the original specification is inoperative or invalid,

and what inadvertency, accident, or mistake occurred, that the office may have the means of determining whether it was without any fraudulent intent." This was omitted in the next edition of the Rules of January 1, 1865, and a similar provision was not made until 1882.

The demand for the restriction of reissue was widespread but the remedy was not obvious. In 1876, a prominent attorney of Philadelphia—Mr. Howson—suggested that every applicant for reissue be required to "file a paper setting forth in full and explicit terms wherein consists the error, inadvertence, or mistake contained in the original patent which he desires to correct by reissue. If language is introduced which does not appear in the original patent, he must state why he introduced it, and whether it is based on the model, drawing, or specification. If new functions, which do not appear to have been contemplated in the original patent, are given in the new specification, a full explanation will be demanded from the applicant, tending to show the accuracies of the new assertions, and when expanded claims are asked, he must state the ground on which they are based." This suggestion however was not adopted.

Rule 86 of the Rules published September 1, 1880, provided that "the affidavit of the applicant will be *prima facie* evidence as to inadvertency, accident, mistake, fraud, and deceptive intent, subject to contradiction or confirmation by the records of the office, by the affidavit of employees of the office having personal knowledge of the facts, or by such other affidavits as the Commissioner shall, without disclosing the pendency of the application, admit as evidence in the case."

In the next edition of the Rules published April 15, 1882, a decided step was taken toward restricting reissues by requiring that the applicant set forth particularly the defects or insufficiencies in the specification which rendered the patent inoperative or invalid, that he explain how the errors arose in order that the question of inadvertence, accident, or mistake might be determined, and make oath that such errors arose without fraudulent intent. It was afterward required (Rules of

Practice, November 16, 1885), that all these allegations be made under oath. The practice in this respect is now covered by Rule 87 which was recently held valid by the Court of Appeals of the District of Columbia, in Fullagar, 192 O. G., 1263; 40 App. D. C., 510. The purpose of requiring a statement of the particular errors and how they arose or occurred was evidently to bring out on the record all the facts in order that the office could judge whether the alleged mistake was a *bona fide* mistake, or a deliberate act inconsistent with applicant's allegation. This requirement has an analogy in the requirement of Rule 75, that an affidavit filed thereunder shall state "facts" as distinguished from the conclusion of the affiant. In both cases, the purpose is to substitute the judgment of the officers who are charged with the duty to administer the law for the conclusion of another. Since 1885, the practice on this point has not materially changed.

From the facts stated it is apparent that the early requirements as to the showing of defects in the original claims and the mistakes which caused them were so easily complied with that, until 1882, they offered practically no obstacle to the reissue of any patent with either restricted or broadened claims.

Another matter which caused some difficulty in the development of the law involved the relation between the inventions covered by the original and reissued patents. It was always the purpose to restrict the invention covered by the reissue to the invention which the original patent was intended to protect. But views varied as to the right of the inventor to amend his specification, drawings, and model, or to add to the disclosure in the reissue application matter which the inventor intended to include in the original description, drawings, or model, but which he failed to include through some inadvertence. It was the established practice for many years to permit the inventor to include in the reissue anything which he might have included in the original. Hence he could amend the description by the drawings or the model, or the model and drawings each by the other, but he could not amend the model and drawings by the description except in a clear case, the description being considered as uncertain.

Rule 54, of the Rules of February 20, 1854, stated that "the general rule is, that whatever is really embraced in the original invention, and so described or shown that it might have been included in the original may be claimed in a reissue, but in case of machine, model and drawings must be amended each by the other; but when there is neither model nor drawings amendments may be made upon proof satisfactory to the Commissioner that such new matter was a part of the original invention and was omitted through inadvertence. The Rules of Practice of July 15, 1870, provided that "anything which might have been included in the original may be claimed in a reissue."

For a time prior to this it was the practice to permit the inclusion in a reissue of inventions not disclosed in the specification, drawings, or model on sufficient proof that such invention was a part of the original invention. This practice resulted from an extremely liberal interpretation of the statute to the effect that the inadvertence, accident, or mistake referred to inadvertence in a failure to disclose the invention rather than a failure to point out the invention so as to distinguish the old from what was claimed as new. It was soon decided however that this was illegal (*Carhart vs. Austin*, 2 Fisher, 543; *Goodyear vs. Providence Rubber Co.*, 2 Fisher, 499; *Sickles vs. Falls Co.*, 2 Fisher, 202), and that the reissue must be restricted to matter disclosed in the original patent. This dangerous tendency to claim even more than was disclosed in the original was definitely checked by the provision of Section 53 of the act of 1870, which provided that "no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other." It is to be noted however, that the present reissue statute still permits the insertion of matter not originally included in cases where there is no drawings or model, upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention and was omitted from the specification by inadvertence, accident, or mistake."

Another reason for the early liberal practice on the granting of reissues was the fact that the doctrine of laches in the filing of the application had not yet been

evolved. No statute that has ever been passed relating to reissues has made diligence a condition precedent to the grant. The statute gave the right of reissue to one who had inadvertently failed to secure the protection to which he was entitled. It was assumed that it was the intention to secure to the inventor what he should have secured in taking out the original patent even though a correction of the error long after the publication of the patent, and the public use of the invention, might work some hardship on the public. Therefore it appears that the length of time intervening between the grant of the original patent and the filing of the reissue application was not considered. Reissues broadening a patent were granted but a short time before its expiration. An instance of the length to which the practice went is found in the decision of the Supreme Court in the case of *Gage vs. Herring*, 22 O. G., 2119; 107 U. S., 640, involving reissue patent, 4712. The original patent, if its term had not been extended, would have expired on April 20, 1872. In December, 1871, four months before the time of expiration, a reissue was applied for (this being the second reissue), adding a claim to the single prior claim, which broadened the scope of the patent by omitting from the new claim two of the seven elements before claimed. The oath simply averred that the petitioner "verily believes that, by reason of an insufficient and defective specification, his aforesaid letters patent (the first reissue) are inoperative or invalid; that the said error (no error was stated) had arisen from inadvertence, accident, or mistake, and without any fraudulent intention, to the best of his knowledge or belief." The reissue was granted in less than a month without objection or comment.

On account of the extreme liberality of the practice upon the identity of the invention, showing of inadvertence, accident, or mistake, and the time within which reissues might be granted, a reissue was resorted to very frequently. In 1863, the number of reissues granted was 6 per cent of the total; in 1870, it was $3\frac{1}{2}$ per cent. Comparing these figures with a percentage of .24 for 1895, it is found that the percentage of reissues of 1863 bear to the reissues of 1895, the proportion of 25 to 1. Furthermore, the patents reissued

were those of most importance in the arts and industries. The evils resulting from this liberal policy were observed and commented upon, although it is due to the Patent Office to say that its policy was directed by the law and the decisions of the courts, and it could not materially restrict the right of reissue as it had always been recognized without assuming an arbitrary power.

On this point a prominent patent attorney in 1882 said:

Although the Patent Office may, in some instances, be directly responsible for the grant of outrageous reissued patents, it would be unjust to charge that bureau with the evils resulting from the prevailing latitude in acting on this class of cases, and the permission given patentees to absorb by reissue, the inventions of others.

Many expanded reissued patents of doubtful character have been sustained by the courts, while many others have been slaughtered.

The treatment of reissued and expanded patents by the courts has not been uniform, and in the light of apparently conflicting judicial opinions, the office has been unable to draw a well-defined line for the guidance of Examiners in their consideration of reissue applications.

The understanding and opinions of Examiners naturally enough differed on the subject, and the consequence of all this has been the long continuance of a system of so-called liberality in the grant of reissued patents with enlarged claims.

The Supreme Court gradually developed a strong antagonism to enlarged reissued patents.

In 1879, in the case of *Leggett vs. Avery*, 17 O. G., 445; 101 U. S., 256, commenting on a patent granted on October 9, 1860, surrendered and reissued on June 22, 1869, extended for seven years from October 9, 1874, and again reissued on November 10, 1874, it said:

The pretense that the error had arisen by inadvertence, accident, or mistake, within the meaning of the patent law, was too bald for human credence. . . .

The allowance of claims once formally abandoned by the applicant in order to get his patent

through is the occasion of immense frauds against the public. It not unfrequently happens that after an application has been carefully examined and compared with previous inventions, and after the claims which such an examination renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have been appointed, comes back to the Patent Office, and under the pretense of inadvertence and mistake in the first specification gets inserted into a reissued patent all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the office reversed, steals a march on the public, and on those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title.

General Leggett made the following comment:

“In these reissues more deviltry—if I may be permitted to use the phrase—creeps into the practice of patent law, than everything else put together.”

EVILS AND REMEDIES THEREFOR.

What were these evils which gave so much concern to the Patent Office and the courts?

Generally stated it was the withdrawal of rights which mechanics and manufacturers had exercised for years, not in favor of the real inventor or the one who had done most to advance the sciences and useful arts, but in favor of a mere speculator who had never done anything but conceive of a way in which an apparently worthless patent might be expanded into one of far-reaching importance. The practice which prevailed is quite fully set forth in a pamphlet written by Mr. H. Howson, of Philadelphia, published in 1877, when discussions relat-

ing to proposed patent legislation took place before the Senate Committee on Patents. He said:

"A patent, or series of patents, relating to some special branch of industry, has been obtained, and capital has been invested in the manufacture of the patented articles. Now in these days, the simplest objects of every-day use can not be economically manufactured without an outlay for machinery and appliances, and for carrying into effect a proper system of division of labor; the public demands not only new things but better things and cheaper things, and this demand can only be supplied by patents, and by the capital which patents invite. The remarkably cheap products of our workshops at the Centennial Exhibition were matters of surprise and astonishment to our visitors from abroad, where labor is much less expensive than in our own country.

"The factory, based on patents, is in full and successful operation, the proprietor is receiving a fair interest for the capital invested, and the public has the benefit of cheaper and better articles in return for the protection afforded by the Government in the shape of patents.

"The success of the establishment can not remain a secret, and it attracts the attention of a patent speculator, whose first move is to try to get hold of some patent preceding those which are owned by the proprietors of the establishment. Failing in discovering a patent to exactly meet the case, he takes an excursion to Washington, probably takes the advice of a solicitor there, to whom he explains what he wants, and together they go on a hunting expedition through the records and model halls, until they find some model of a patent which they think can be doctored by reissue to resemble a subsequent prominent patent of the manufacturer. The model has, perhaps, long since been almost forgotten by the inventor himself, and has remained on the shelves of the model room without attracting any notice. By cunning manoeuvres,

the patent to which the model appertains is purchased from the owner, perhaps for a mere song, and then commences the operation of re-issuing; the attorney has the copy of the recently discovered patent before him, and also a copy of that for the coveted machine of the successful manufacturer, and he is told that he must reissue the first patent so as to cover, or, to use a common phrase, wipe out the second.

"The most ingenious devices are adopted to bring this about,—the attorney receives high fees, and the Examiner is cajoled by all sorts of assertions into allowing claims which may appear to be innocent enough.

"The reissued patent is shown to the manufacturer, and he may be induced to purchase it for a large sum in order to avoid expensive litigation. Now this money is taken from the public to enrich the speculator, the non-producer, for, to make up for the withdrawal of capital, the price of the product is increased. Perhaps the manufacturer resists the demand made on him, costly litigation ensues, and the public and manufacturer suffer for the benefit of the owner of the reissued patent.

"The evil wrought by this system is incalculable; it not only disturbs the economy of manufacture, but brings disgrace on the whole patent system. A reissue of this character can not promote the progress of the useful arts, it must necessarily obstruct that progress."

There are scores of instances in which patents were issued, reissued, and re-reissued to keep pace with "the progress of the arts as developed by time and experience." In one instance, a patent was granted with a single, modest, and harmless claim; in the branch of industry to which it related, several valuable improvements were made, the patent was reissued to absorb these improvements, again reissued to cover other improvements, and again reissued, until at last, the little patent with a specification of 450 words and a single claim was

converted into two patents with 8,000 words and seventeen claims.

Remedies to correct these evils were suggested and attempted from time to time. Formerly the owner of the entire interest in a patent could reissue it without the knowledge or assent of the inventor; but since the act of 1870, the inventor if alive, must make the application. This remedy however, had little effect as it was generally an easy matter, by misrepresentation or through the intervention of emissaries, to obtain the signature of the inventor, who was kept in the dark as to the scope and object of the reissue.

In his report of 1871, Commissioner Legget suggested that the law should be so amended as to require that a notice of all applications seeking enlarged claims be published in the Official Gazette, for at least four weeks previous to the day set for examining the same, and that opposition be allowed as in extension cases. It was also suggested that there should be no reissue of a patent after it had been in existence for more than two years.

THE DOCTRINE OF DELAY OR LACHES.

Without any change in the law, however, the Supreme Court found a remedy in the doctrine of laches in filing the application. This doctrine was laid down in the case of *Miller vs. The Bridgeport Brass Co.*, reported in 104 U. S., 350; 21 O. G., 201. The decision is dated January 9, 1882. The facts in that case are briefly set forth in the decision as follows:

“The original patent described a combination of devices, amongst other things, *two domes or reflectors, one above the other, elevated above a perforated cap through which a wick tube and vapor tube ascended.*

“It was claimed that this combination of devices, especially including the two domes, which admitted the external air between them for producing a more perfect combustion, would make a lamp, which, *without a chimney*, and without danger of explosion, would burn those hydrocarbons which are volatile and contain an excess

of carbon. The invention proved a failure, but it was found that *the use of one of the domes* (and the other parts) *with the restoration of the chimney*, would be a real improvement, and both plaintiff and defendant made such lamps in large quantities. *Fifteen years after the original patent was granted*, the patentee (or rather his assignee) discovers that the improved lamp was really a part of his original invention, and that by inadvertence and mistake he had omitted to claim it.

"Upon this state of facts, the court said: 'We think, that the court below was clearly right in holding that the invention specified in the second claim of the reissued patent (the one in question) is *not* the same invention described and *claimed* in the original patent.' "

The court might have rested its decision on their conclusion that the reissued patent was not for the same invention as the original. Or they might have rested the decision on the finding of no inadvertency, accident, or mistake, for the opinion says:

"But there is another grave objection to the validity of the reissued patent in this case. It is manifest on the face of the patent when compared with the original, that the suggestion of inadvertence and mistake was a mere pretense."

But the court proceeds to say:

"Or if not a pretense, *the mistake was so obvious as to be instantly discoverable* on opening the letters patent, *and the right to have it corrected was abandoned and lost by unreasonable delay*. The only mistake suggested is, *that the claim was not as broad as it might have been*. THIS MISTAKE, IF IT WAS A MISTAKE, WAS APPARENT UPON THE FIRST INSPECTION OF THE PATENT, AND IF ANY CORRECTION WAS DESIRED, IT SHOULD HAVE BEEN APPLIED FOR IMMEDIATELY.

"These *afterthoughts*, developed by the subsequent course of improvement, and intended, by an ex-

pansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion.

"If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, *uses due diligence in returning to the Patent Office*, and says, 'I omitted this,' or 'my solicitor did not understand that,' his application may be entertained, *and on a proper showing*, correction may be made.

"But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, ARE IN LAW A DEDICATION TO THE PUBLIC OF THAT WHICH IS NOT CLAIMED.

"It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal effect of the patent can not be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. Any unnecessary laches or delay in a matter thus apparent on the record, affects the right to alter or reissue the patent for such causes. If two years' public enjoyment of an invention with the consent and allowance of the inventor, is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible where it is sought merely to enlarge the claim.

"Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake occurred, not from a mere error of judgment (for that may be rectified

by appeal); but a real, *bona fide* mistake inadvertently committed, *such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct.* Reissues for the enlargement of claims should be the exception, and not the rule."

Here the Supreme Court, fifty years after its first consideration of a reissued patent and forty-six years after the enactment of the statute, gave a new force to its terms, and laid down a doctrine never before known to the patent law—that of delay and intervening rights.

FOUNDATION OF DOCTRINE OF LACHES.

The decision of the court in *Miller vs. Brass Co.*, was intended to, and did, put a stop to the hardships placed upon manufacturers by the undue enlargement of patents many years after the invention covered thereby had gone into public use. Let us now look at the foundation of the doctrine as enunciated by the court. As shown by the decision itself the court found its authority for the doctrine in the general principles of the law, and in the equitable doctrine that laches may forfeit an existing right. The court reasoned in substance as follows:

That the law of 1832 provided for a reissue where there was a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention. That the law of 1836 enlarged the power to grant reissues by adding an additional ground for reissue, namely, that the patentee had inadvertently claimed more than he had a right to claim; that prior to this time no claim had been required to be made, and therefore that the enlargement of the claim was not in the mind of Congress when the statute was enacted; that the law in terms contemplated only a correction of the description and a restriction of the claim and not an enlargement of a restricted claim. They concluded that if the patentee was entitled to amend his patent when he had claimed too little it was only under the general terms of the law, and on principles of equity, and that in such case, equity would restrict the privilege so as to protect the public from

the evils to which it had been subjected by unwarranted reissues.

Robinson, in his work published eight years after the decision of the court, maintains that the reasoning of the court is founded upon a fundamental error in assuming that the word "specification" in the phrase "defective or insufficient description or specification" did not refer to the claims; that while prior to the law of 1836, no formal claim was required, nevertheless it had been customary to make a "claim" and this part was often referred to as the "specification" of the invention; that the statute therefore did in terms provide for the correction by reissue of an error by which the patentee failed to secure sufficient protection. The learned author contends that the statute might have been interpreted as providing for an enlargement of the claims and that the doctrine of laches might have been founded as well upon the theory that delay is inconsistent with the existence of inadvertence, accident, or mistake.

If we should regard delay merely as evidence bearing on the question of inadvertence, accident, or mistake, it would result probably in a more uniform application of the doctrine of laches; but that the courts have not adopted this viewpoint is believed to be evident from their decisions made since the publication of Robinson's work. If the doctrine of laches were brought within the statutory provisions it is not seen how any distinction could be made between enlarged reissues and those which were restricted or otherwise amended. But the decision of the courts since the decision of *Miller vs. Brass Co.*, make a clear distinction between broadened and narrowed reissues as will be shown later. Furthermore, the trend of the decisions bears out the conclusion that the doctrine of laches must be regarded as an equitable doctrine, and that the authority of the courts to hold a reissue invalid on account of delay in filing the application, is founded upon equitable principles and not upon the terms of the reissue statute.

As above pointed out in *Miller vs. Brass Co.*, the courts looked upon the failure to claim devices or combinations apparent on the face of the patent as a dedication to the public of that which is not claimed. "It is a declaration that that which is not claimed is either not the patentee's

invention, or, if his, he dedicated it to the public. The legal effect of the patent can not be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake. . . . Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible where it is sought merely to enlarge the claim." The nature of the mistake contemplated is referred to as a "*bona fide* mistake, such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct."

In *Topliff vs. Topliff*, 145 U. S., 156, 59 O. G., 1257, decided ten years later, the Supreme Court, after a review of the decisions of the courts since *Miller vs. Brass Co.*, stated the rule governing reissues as follows:

From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:

First. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original.

Second. That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

Third. That this court will not review the decision of the Commissioner upon the question of inadvertence, accident or mistake, unless the

error is manifest from the record; but that the question whether the application was made within a reasonable time is, in most, if not in all such cases, a question of law for the court.

Here the court reaffirmed the doctrine of *Miller vs. Brass Co.*, and treated the failure to claim in the original patent as a constructive abandonment. Furthermore, in the statement that the court would not review the decision of the Commissioner upon the question of inadvertence, accident, or mistake, but that the question of delay, was one of law for the court, is implied the thought that delay can not be considered merely as evidence bearing upon inadvertence, accident, or mistake.

CONFLICT OF DECISIONS.

The questions of identity of invention, inadvertence, accident, or mistake, delay and intervening rights, have been so confused by the courts that the correct principles which shall govern the practice of the Patent Office in the granting of reissues are very difficult to determine. On these points, one may find a decision of some court to sustain almost any position which one might wish to assume. Some of the courts drew from *Miller vs. Brass Co.*, the conclusion that a reissue could not enlarge the original claim; that this was wrong is indicated by the later decision in *Topliff vs. Topliff*. There is much conflict and uncertainty in the decisions upon each of these several matters.

If some of the controverted points can be settled to our satisfaction, it will aid materially in a ready disposition of the rights of reissue applicants.

RESTRICTED REISSUE—DELAY OF LITTLE CONSEQUENCE.

It seems to be fairly well settled by the best considered decisions of the courts that where it is sought merely to restrict the original patent, which is found to be too broad, delay is not of importance. The distinction between enlarged and narrowed reissues was made in the

case of *Miller vs. Brass Co.*, and reiterated in *Topliff vs. Topliff*. In the enunciation of the doctrine of laches, the court indicated that where it was sought to enlarge the claims greater diligence would be required than where it was sought merely to correct the description or restrict the claims. There seems to be no conflict of authority upon this point but no court has laid down any general rule. In *Sirocco Engineering Co. vs. B. F. Sturtévant Co.*, 173 Fed. Rep., 378, a reissue restricting the claims was held valid although the application was filed seven years after the granting of the original patent. In *Steiner & Voegtly Hardware Co. vs. Tabor Sash Co.*, 178, Fed. Rep., 831, a delay of twelve years was held not a bar where the patent was narrowed. The latest decision on this point is in the case of *Motion Picture Patents Co. vs. Laemmle*, 214 Fed. Rep., 787, in which the Edison reissue patent for motion picture machines, granted over fourteen years after the date of the original patent, was held valid. In this case, the court set forth the distinction between broadened and narrowed reissues in the following words:

“The books are full of cases where the courts have appreciated the importance of intervening rights, and have realized the injury which may or will be done to the public where, after either an unreasonable delay or a process of experimentation with court decisions, an attempt is made to broaden claims. In such instances, industry and commercial progress may be arrested if the courts were to hold to any doctrine which made it dangerous for energetic men to enter upon some well-defined field of activity only to discover subsequently that a grant theretofore given had been enlarged beyond the limits so defined. Thus it is that there is a line of cases of which *Miller vs. Brass Co.*, 104 U. S., 350, 26 L. Ed., 783, and *Thomson-Houston Electric Co. vs. Western Electric Co.*, 158 Fed., 813, 86 C. C. A., 73, are examples. Nowhere, however, has it been held that a reissue wherein the claims are narrowed is void for laches. It is true that in *Pelzer vs. Meyberg*, 97 Fed., 969, it was held that there were

degrees of diligence in applying for a reissue, and that a higher degree was required in the case of a broadened claim than in the case of a narrowed claim. The case came up on demurrer, and apparently there was no excuse for the delay set forth."

It is to be noted that in this case the reissue gave the patentee a distinct advantage over and above that which flows from the conversion of a claim invalid because too broad, into a restricted valid claim. It secured to him a valid patent on which he might maintain suit for infringement, whereas it was a matter of much doubt whether suit could be maintained at all on the prior patent by reason of the patentee's failure seasonably to file, under Section 4922 R. S., a disclaimer of a claim which had been held invalid by the Circuit Court of Appeals. It is to be noted also that the patentee had delayed the filing of the reissue for over three years after the Court of Appeals had held the claim invalid, thus being clearly put upon notice of the defect by the ruling of a court whose decision is final on patent questions.

From a review of the authorities on this point it seems fair to conclude that when it is sought to restrict a patent, delay is of no consequence. This should be true even where it is proposed to secure more restricted claims in addition to the broader claims of the original patent; in other words, the rule should be regarded as permitting the addition of claims at any time during the life of the patent which come within the scope of the original claims, providing, of course, a proper showing is made of inadvertence, accident or mistake, and providing due diligence was exercised after the discovery of the error.

INTERVENING RIGHTS.

Intervening rights, which has been fatal to so many reissues, is a question which does not often, if ever, come before the Patent Office. The prosecution of reissue applications is entirely *ex parte*, as in other cases, and the office has no way of investigating this matter. There is a question whether the granting of patents between

the date of the original and the reissue is an intervening right. The Circuit Court in Minnesota in the case of *American Bank Protection Co. vs. Electrical Protection Co.*, 181 Fed. Rep., 350, decided that it was not. To the same effect is *Gaskill vs. Myers*, 81 O. G., 1111; 1897, C. D., 699. The contrary holding was made by the District Court of New York in the case of *Specialty Machine Co. vs. Ashcroft Mfg. Co.*, 205 Fed. Rep., 760, where there had been a delay of three years. This point has but seldom been directly involved and it can not be said that the law in respect thereto is settled. See also *White vs. Dunbar*, 119 U. S., 51; 1886, C. D., 494; *American Soda Fountain Co. vs. Sweitusch*, 85 Fed. Rep., 968; *Clements vs. Odorless Apparatus Co.*, 109 U. S., 641; *Flower vs. City of Detroit*, 22 Fed. Rep., 292; *Horn & Brannen Mfg. Co. vs. Pelzer*, 91 Fed. Rep., 665.

INADVERTENCE, ACCIDENT OR MISTAKE— BROADENED AND RESTRICTED REISSUES.

. Some of the decisions appear to make a distinction between the character of mistake which would warrant a broadening of claims by reissue and those where other defects are sought to be corrected. This is intimated in *Miller vs. Brass Co.*, where the court says that a claim may be enlarged by reissue only when there has been a "real *bona fide* mistake, inadvertently committed, such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct." Since the decision of the court was founded upon the proposition that the statute did not specifically provide for the enlargement of claims by reissue, it might well have imposed the condition that in such cases only such errors as a Court of Chancery might correct would be considered as sufficient ground for reissue, while errors of lesser moment might be corrected where it was sought merely to limit the claims or correct the description. But a review of later authorities indicates that an inadvertence, accident or mistake, which will support a narrowed reissue will also support a broadened reissue. Let us now examine the question, what may be considered an inadvertence, accident, or mistake.

It is believed that the weight of authority will sustain the proposition that any failure to secure in the original patent the invention to which the applicant was entitled which was not the result of a deliberate act, or was not the result of an intention to deceive, may be attributed to inadvertence, accident, or mistake. One of the most thoroughly considered cases on reissue is that of *Crown, Cork & Seal Co. vs. Aluminum Stopper Co.*, 1901, C. D., 450, 108 Fed. Rep., 845, decided by the Circuit Court of Appeals for the Fourth Circuit. In that case, the court said:

“A review of the earlier decision of the Supreme Court would seem to show that by ‘defective or insufficient specifications’ was meant any failure to describe or claim the complete invention upon which the application for the patent was founded, and that ‘inadvertence, accident, or mistake’ was used in antithesis to fraudulent intent, and that the right to reissue depends upon any failure to make the specification and claims legally adequate for their purpose, if due to any cause except an intention to deceive.”

In the case of *In re Briede*, 1906, C. D., 677, the Court of Appeals found the existence of inadvertence, accident or mistake, where the error alleged was a failure to secure a certain claim arising from unfamiliarity of applicant and his solicitor with the English language.

In *In re Heroult*, 1907, C. D., 521, the same court found the existence of inadvertence, accident or mistake, where there was failure to secure a claim of sufficient scope which arose (according to the allegations of applicant, who was a citizen of France) because of ignorance of the difference between the laws of France and the United States.

In the case of *Crown Cork & Seal Co. vs. Aluminum Stopper Co.*, cited above, there was a broadened claim and no showing of any particular inadvertence, accident, or mistake except an allegation that the application papers were hurriedly prepared, and that neither applicant nor his attorneys noticed the defects throughout the years of the prosecution of the application.

In the case of *Houghton vs. Whitin Machine Works*, 153 Fed. Rep., 740, it was held by the Circuit Court of Appeals for the First Circuit, that the failure to make claims of sufficient scope may be regarded as inadvertence, accident, or mistake. In *Moneyweight Scale Co. vs. Toledo Computing Scale Co.*, 187 Fed. Rep., 826, 170, O. G., 728, the Circuit Court for the Seventh Circuit said:

“The original specification alone on its face was sufficient proof that, if a claim adequate to cover the improved scale was never drawn, the failure came from the lack of an attentive comparison of the submitted claims with the invention particularly pointed out in the specification. This was inadvertence, ‘lack of heedfulness or attentiveness,’ irrespective of the real competence or incompetence of the solicitors.”

In *Topliff vs. Topliff*, where the Supreme Court sustained a broadened reissue, there was no showing of inadvertence, accident, or mistake, the oath alleging merely that the patent was defective and insufficient, and that the defects and insufficiencies arose from inadvertence, accident, or mistake. It is to be noted however, that the application in this case was applied for before an applicant was required to set forth the particular defects of his patent, what the errors were, and how they arose or occurred.

From a review of the authorities it is believed to be a fair conclusion that a mere failure to claim what was indicated in the drawings and specifications as a part of the invention is an inadvertence, accident or mistake within the meaning of the statute, unless the failure was due to an intent to deceive, or to some deliberate act inconsistent with the theory of inadvertence. And it is believed that this rule is as applicable to broadened reissues where the application is filed within two years of the date of the original patent as it is to restricted reissues. As a general rule, the defects and insufficiencies of a patent are not the result of a failure fully to describe the invention, or a failure to claim it with sufficient particularity; but they result from a failure to make

claims of sufficient breadth to protect the real invention. For example, a claim is made to a combination of four elements whereas it is clear to one skilled in the art that one of those elements may be omitted without destroying the capacity of the device to perform the substantial function set out in the specification. An ordinary inventor, or even one who has had considerable experience in patent matters, could not be expected to know that his invention was not fully covered by the claim to four elements. It must be the common observation of any one who has had any intimate knowledge of these matters that it is difficult even for those who are most highly skilled in the interpretation of claims sometimes to determine the true scope of a claim once drawn, or to draw claims adequate to protect the real invention. These difficulties were forcefully pointed out in the case of *Crown Cork & Seal Co. vs. Aluminum Stopper Co.*, *supra*, where the Circuit Court of Appeals said:

The learned counsel for defendant assumes that the subject is so simple that Painter should have discovered instantly upon reading the original patent the occasion for the reissue, if it existed. He forgets that what seems so simple and easy to him, a past-master of the subject, was not so to a mere inventor, unskilled in the art of interpretation, who could not upon a mere reading of his patent determine what his claims covered. Painter had no hesitation and no doubt what his invention covered, and almost immediately upon the hearing of the issue of Hall's patent he said that it was covered by his invention; but it was not until he was advised by his lawyer that he learned that his claims were not commensurate with his invention, and there was no delay then in filing his application for reissue. Some allowance may well be made for an unlearned man, when we remember that in the recent case of *Westinghouse vs. Power-Brake Co.* (C. D., 1898, 443; 83 O. G., 1067; 170 U. S., 537; 18 Sup. Ct., 707; 42 L. Ed., 1136) the Supreme Court itself required three hearings before it could determine the meaning and scope of the patent claims, and the record

in this case shows that such learned experts as General Spear and Mr. Walker differ radically as to what the claims of the original patent cover.

In view of the difficulties of drawing up this very technical document and determining its metes and bounds, it is thought that it should be the general rule to regard any failure to secure to the owner of the patent adequate protection for the invention described and claimed as inadvertence, accident or mistake, if application is made for reissue promptly upon the discovery of the error, and within two years from the date of the original patent, unless the record itself is inconsistent with the allegation of inadvertence, accident, or mistake. In reviewing the showing of inadvertence, accident, or mistake, of course it is always necessary to examine the record of the original patent to see whether there is anything there inconsistent with the allegations of applicant's oath. If one in the prosecution of an application should make a certain claim, and, upon its rejection on references, cancel it in order to receive his patent, it is obvious that his act is deliberate and he will not be heard to say that he was mistaken in his judgment as to the pertinency of the references and desires a reissue to correct the error; the error in such case, if there was error, was not an error within the meaning of the statute, but an error of judgment merely. The same would be true if a disclaimer were entered in the specification during the prosecution of the case. If the record of the original patent is not consistent with the claim of inadvertence the intention of the applicant must be determined from the original record.

DELAY LESS THAN TWO YEARS.

The most difficult of all points to decide in passing upon reissue applications is whether the application has been seasonably filed. This does not present much difficulty when the application is filed within two years. By this I do not mean that any application filed within two years is seasonably presented. Reissues have been held void because of laches in filing the application in cases where

the delay was only a few months. An examination of those cases where a delay of less than two years was held fatal will show that in a majority of the cases there were actual intervening rights, or that the owner of the patent did not proceed with diligence after the discovery of the defects in his patent or after he was put upon notice of such defects.

DELAY MORE THAN TWO YEARS.

What are the principles to govern the grant of a reissue application for broadened claims which has been filed more than two years after the date of the patent? No general rules can be laid down. The decision in each case must depend upon the particular circumstances. See

30 O.G. 68

In the case of *Mahn vs. Harwood*, 112 U. S., 354, the Supreme Court said:

"In *Miller vs. Brass Co.*, by analogy to the law of public use, before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule. Nevertheless the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case."

It should appear from applicant's showing when the mistake was discovered, and if the reissue application was not promptly filed, the reason why. If circumstances were of a compelling nature delay should be excused, but delay on account of attention to other business matters should not suffice as an excuse.

It is not seen that the character of the mistake which it is sought to correct has any relation to the doctrine of delay except as it has a bearing upon its probable discovery. A mistake might be so plain that any interested party, upon reading the patent, would discover it. On the other hand it might be so obscure that one could

not be reasonably expected to discover it. In the latter case, a much longer delay would be excusable. In fact, if the mistake were such that by ordinary vigilance, it would not be apparent, and the owner of the patent is not put upon notice of its defect, it would seem that the Patent Office could not refuse a reissue even after a delay of several years.

But when the mistake is discovered, the practice requires that its correction be diligently sought, or that failure to act promptly be satisfactorily explained.

The Registration of Prints and Labels

A paper read April 29, 1913, before the Examining
Board of the United States Patent Office

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WASHINGTON, D. C.
1913

The Registration of Prints and Labels

By

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The registration of a print or a label is the registration of a claim of copyright. (Section 10 of the Copyright Act.) The provisions of the general copyright act, in so far as they are applicable, must be complied with before a valid registration can be obtained. The Copyright Act of June 18, 1874, provides *inter alia* that the copyrights of prints and labels shall be registered by the Commissioner of Patents. Section 3 of this act reads:

“That in the construction of this act the words ‘engraving, cut, and print’ shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trademark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the Commissioner of Patents, to the party entering the same.”

The act of March 4, 1909, is silent upon the subject of prints and labels. Therefore, after July 1, 1909, the date on which this act went into effect, applications for the registration of prints and labels were refused by the

Patent Office on the ground that the act of 1874 had been repealed by the latter act. On December 22, 1909, the Attorney-General of the United States decided that the act of 1909 had not repealed the former act, in so far as it related to prints and labels, and that it was still the duty of the Commissioner of Patents to register copyrights of prints and labels. This ruling was affirmed by the Attorney-General on May 16, 1914.

A print or a label may be registered either by the author or proprietor who is a citizen of the United States, or by his executors, administrators, or assigns; or by an alien author or proprietor, or his executors or assigns, who shall be domiciled within the United States at the time of the first publication of the work. Registration will be granted to an alien author or proprietor when the State or nation of which he is a citizen or subject grants, either by treaty, convention, agreement or law, to a citizen of the United States the benefit of copyright on substantially the same basis as to its own citizens. (Section 8 of the Copyright Act.) It is therefore required that the citizenship of the author be stated when application is made by a proprietor (Rule 18).

The statutory requirements which cause the most difficulty and which are least understood are:

1. Publication.
2. Notice of Copyright.
3. Descriptiveness.
4. Artistic Merit.

These subjects will be discussed in the order mentioned.

PUBLICATION.

Prior to the going into effect of the act of 1909, application for registration had to be made before publication, and a prior publication was held to be such a donation to the public as to bar copyright protection. (*Marsh et al. vs. Warren et al.*, 13 O. G., 7, 14 O. G., 678.) Section 9 of the act of 1909, however, provides in part:

"That any person entitled thereto by this act may secure copyright for his work by publication

thereof with the notice of copyright required by this act; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor."

This section reverses the former practice and requires publication with notice of copyright before the filing of an application for registration.

The common misapprehension is that it is unlawful to place a copyright notice on a work before an application has been filed and registration secured.

The rules require that the date of publication with notice of copyright be stated in the application, and it is the practice to require that the day, month, and year be stated. The reason for this requirement is that the period of twenty-eight years protection begins to run from the date so set up and not from the date of registration. The question as to how long an applicant may delay after publication with notice of copyright before filing an application has not been judicially determined. The Register of Copyrights, however, has held that sixty days is the limit of time after publication in which to make application.

Any work which was in the public domain prior to July 1, 1909, may not now be protected by copyright. (See section 7 of the Copyright Act.) Many applications are refused registration on account of this provision, it being a common occurrence for proprietors of prints or labels to use them for several years before attempting to protect them by copyright.

A publication without notice of copyright, unless by accident or mistake, was a bar to copyright protection under the act of 1874. It would therefore appear that the publication of a label for any considerable time before placing a notice of copyright thereon would prevent the securing of a valid registration unless it could be shown that the omission was due to accident or mistake. (*Pierce & Bushnell Co. vs. Werkmeister et al.*, 72 F. R., 54; and *American Press Association vs. Daily Story Publishing Co.*, 120 F. R., 766.)

NOTICE OF COPYRIGHT.

The form of copyright notice used must conform exactly to the provisions of section 18 of the act, and it is obvious from the language of this section that Congress intended that only the forms so provided are to be considered valid. The courts have held that a notice which is lacking in any essential is no notice. (*Hoertel vs. Raphael Tuck Co.*, 94 F. R., 844.)

It is the practice of the Patent Office to accept any one of the forms of notice provided by this section, probably for the reason that it has never been determined in which of the classes enumerated in section 5, prints and labels belong.

There are two improper forms of copyright notice which are frequently used. The first and most common is "REG. U. S. PAT. OFF." This is the form of notice of trade-mark registration, authorized by the Trade-Mark Act of 1905. The other form is "LABEL REGISTERED." Both of these forms are objected to as not complying with the statute, and their use is deemed sufficient ground for refusing registration. It appears that the publication of any copies without a notice of copyright is a donation to the public. Section 19 requires that the notice of copyright appear on each copy published.

DESCRIPTIVENESS.

Rule 30 of the Rules for the Registration of Prints and Labels, which is based on section 3 of the act, prohibits the registration of a label which is not descriptive of the article on which it is used. Its descriptiveness, however, may be either by words or by pictorial illustration. The word "REGINA" was held not to render a label descriptive of music boxes (*Ex parte Regina Music Box Co.*, 100 O. G., 1112) while the representation of a keg such as is commonly used for beer was held sufficiently descriptive of malt liquors. (*Ex parte Ruppert*, 121 O. G., 2327.) In a recent case the words "IRISH EMBROIDERED STYLE" were held to be sufficiently descriptive of sheets, pillow cases, etc. The name of the proprietor of a label was held not to render the label

sufficiently descriptive. (*Ex parte* The American Wire Weavers' Protective Association, 94 O. G., 586.)

The term "article of manufacture" as used in the statute has been very broadly construed, and labels for spring water, poultry, eggs, and fruit in its natural state have been registered. In a recent case, however, the Commissioner ruled that a highway was not an article of manufacture. It would seem that the statute has been interpreted to mean articles of merchandise rather than strictly manufactured articles.

ARTISTIC MERIT.

Rules 29 and 30 define prints and labels as "artistic and intellectual productions." This question of artistic merit has been the cause of many appeals to the Commissioner of Patents, and in one instance was passed upon by the United States Supreme Court. In this latter case (*Higgins et al. vs. Keufel et al.*, 55 O. G., 1139) the court held that a phrase descriptive of the goods (the words used were "WATERPROOF DRAWING INK") printed in ordinary type, did not constitute a label which could be protected under the copyright act. The use of a paraph under some of the words, or of printers' ornamentation, has been held not to render a label registrable. (*Ex parte* The Samuel Winslow Skate Mfg. Co., 131 O. G., 692, and *Ex parte* J. W. Howe & Son, 123 O. G., 1283.) The standard of artistic merit required is, however, very low, and any pictorial illustration or embellishment has been considered sufficient to warrant registration. In a recent case a label comprising printed matter and two circles, in each of which appeared the letter "G," was held to be registrable.

LABELS NOT REGISTRABLE.

The act incorporating the American National Red Cross makes it a misdemeanor for any unauthorized person or corporation to use the insignia of this society. Any labels, therefore, which contain such insignia are refused registration.

Prints or labels which bear portraits or names of living individuals are refused registration unless the consent of

such person is shown. (*Ex parte* John Dewar & Sons, Ltd., 98 O. G., 1037.) The reason for this practice is that it is against public policy for the Government to grant protection for the use of an individual's name or portrait without his consent.

TITLE.

The title of the print or label must appear upon the copies filed and must be stated in the application. (Rules 18 and 19, and *ex parte* Ruppert, 121 O. G., 2327.) An applicant, however, is not limited in his selection of a title and may use any word or phrase which appears on the specimens filed. In one case at least, applicant was allowed to write the title on the back of the copies. (*Ex parte* Pingree Traung Co., 197 O. G., 997.)

Appeal to the Commissioner of Patents from the action of the Examiner of Trade-Marks and Designs, refusing to register a print or label, may be taken without an additional fee. (Rule 31) and his decision refusing registration appears to be final. (U. S. *ex rel.* E. L. Moodie *vs.* Butterworth, 30 O. G., 97; Allen *vs.* U. S. *ex rel.* The Regina Music Box Co., 105 O. G., 747; and United States, *ex rel.* Lincoln Highway Association *vs.* Ewing, 213 O. G., 749.

April 29, 1915.

The Oath Required by Rule 46

A printed Decree of 1914, from the Honorable
Chief of the United States Patent Office

LESTER D. MANN,

Chief Assistant Examiner, Division Two,
U. S. Patent Office

E. H. MITCHELL, Principal Examiner

WASHINGTON, D. C.
1914

The Oath Required by Rule 46

By

LESTER B. MANN,

Third Assistant Examiner, Division Ten,
United States Patent Office.

OATH ORIGINALLY NOT NECESSARY.

Originally patents were granted on a petition to the Secretary of State, the Secretary of War, and the Attorney-General; and no oath of any kind was necessary, unless there was opposition. The Statute of 1793, was the first to require an oath to accompany the application and provided, "That every inventor before he can receive a patent, shall swear or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent." This was superseded by the Statute of 1836, under which the oath became enlarged and partook somewhat of its present form. Article 6 in part reads:

"The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen. . . ."

This statute had the peculiarity that, after search had been made and references cited, if the applicant elected to withdraw his application, he was entitled to receive back twenty dollars, part of the fee paid; but if he continued the prosecution he was required to "make oath or affirmation anew in manner as aforesaid" (Art. 7),

whether he altered the specification or not. Presumably, the theory was that the applicant's knowledge or belief might be modified, by the art revealed in the search, to such an extent that he would be unable to make the necessary averments laid down in the law.

The next change in the oath was made by the Consolidated Patent Act of 1870, Article 30 of which was word for word like the present Section 4892 of the Revised Statutes, except as to the persons before whom the oath could be taken. It also had articles corresponding to Sections 4886, 4887, etc., of the Revised Statutes, by which it was replaced in 1874.

OATH A PREREQUISITE TO GRANT.

There are a number of cases reported where the courts have refused to hold a patent void although the application papers contained either no oath at all or none that was valid. But that is no reason why the Office should be lax in enforcing the requirements of the law; for in these cases the courts have proceeded on the theory that, inasmuch as an oath is a prerequisite to the granting of a patent and the patent states that all the requirements have been complied with, it is presumed to have been made. Mr. Walker says:

"It is presumed that the Commissioner will never issue a patent till he is satisfied that the applicant has somehow made oath to the facts to which the statute requires him to swear" (Walker, 4th Ed., p. 105).

Such a presumption was made in *Hancock Inspirator Co. v. Jenks* (21 F., 913), where the court said:

"There is nothing in the act requiring this oath to be in writing, and . . . it is possible that the patentee appeared personally before the Commissioner and made the required oath in his presence."

Cyclopedia of Law and Procedure is in harmony with this view:

"A patent is not invalid merely because no written oath appears among the papers of the record, since it is presumed that an oath was taken" (30 Cyc., 888).

So also is American and English Encyclopedia of Law:

"A recital in the patent that the required oath was taken is conclusive, in the absence of fraud" (A. and E., 2d Ed., vol. 22, p. 364).

Cyclopedia of Law and Procedure also considers the oath a prerequisite:

"It is provided by statute that the applicant must make oath that he believes himself to be the original and first inventor, etc., and on construing this statute it has been held that the taking of the oath is but a prerequisite to the granting of the patent and in no sense essential to its validity" (30 Cyc., 888).

The illustrious William Wirt put a similar construction on the law:

"My opinion is, that the law is imperative; and that no patent can issue in the case until Mr. Duplat shall have taken the oath in the terms in which it is prescribed by Congress" (1 Op. Atty. Gen., 332).

MADE BY THE INVENTOR.

From the very nature of the averments to be made it would seem evident that the inventor, as long as he is alive and sane is the only proper person to make the oath; but ever-experimenting man is continually attempting to have some other perform that duty.

Apparently the earliest authority on the subject is the opinion of the Attorney-General in 1861 construing the

statute of 1836. This opinion is somewhat elaborate and only the last paragraph is quoted:

"In the present case the oath required is eminently one of substance. It compels the applicant to assert two facts, which necessarily can only be within his own personal knowledge, viz: that he believes he is the original inventor of the thing proposed to be patented, and that he does not know or believe that the same was ever before known or used. It is impossible that these facts can be originally known to any one but the inventor, and if they are sworn to by his agent or attorney, the evidence is nothing but hearsay. I can imagine no inconvenience which would excuse so wide a departure from the language and purposes of the act of Congress, and I am, therefore, of opinion that the oath prescribed by the 7th section must be taken by the applicant, and can not be taken by his agent or attorney" (Op. At. Gen., vol. 10, p. 137).

In 1888 the Supreme Court expressed a similar opinion in *Kennedy vs. Hazelton* (C. D. 1889-349). It said:

"The patent law makes it essential to the validity of a patent that it shall be granted on the application, supported by the oath, of the original and first inventor (or of his executor or administrator), whether the patent is issued to him or to his assignee."

There is nothing in this decision inconsistent with those cited above. The patent in suit was fraudulently obtained in the name of a third person and assigned to the inventor to avoid an agreement to assign any such improvements to the plaintiff. The fraud overcame the presumption that the proceedings in the Office were regular and allowed the court to go behind the grant.

Commissioner Duell recognized the authority of this in *Ex parte Tropenas* (90 O. G., 749; C. D. 1900-14), where it was sought to have a petition, specification, and oath executed by the inventor before the United States Consul in Paris on October 26, 1899, substituted for

those executed by his attorney and filed October 27, 1899, to enable applicant to obtain an application date of October 27, 1899, and thereby avoid the running of the statute set in motion by the issuance of a foreign patent. He held that the papers executed by the attorney could not be treated as forming any part of a valid application.

Ex parte Tropenas was followed by Assistant Commissioner Chamberlain in *Ex parte* Richards (95 O. G., 1853; C. D. 1901-46), where it was sought to file a supplemental oath executed by the assignee instead of the inventor. He said:

“Such an oath can not be accepted since the law does not authorize the execution of the oath by any one save the inventor as long as he is alive.”

Moreover, this situation seems to be covered by Section 4895 of the Revised Statutes (Sec. 33, Act 1870), which provides that:

“In all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer. . . .”

“Sworn to” here, of course, refers to the original oath, but as a supplemental oath is to cover matter disclosed but not substantially embraced in the statement of invention and original claims, it must necessarily be made by the inventor if alive and sane. For, as said by Commissioner Mitchell in *Ex Parte* Lillie (53 O. G., 2041; C. D. 1890-181):

“The statute (Sec. 4892) and the corresponding rule (46) imperatively require that when a patent is granted all the claims shall be warranted either by the original oath or by some supplemental oath of the applicant.”

Again in *Ex Parte* McCoy (80 O. G., 2037; 1897-74) the sufficiency of an assignee's oath was tried. Here the inventor executed the oath on September 1, 1894, and assigned the application to one Hodges at about that

time. He reexecuted the oath on November 3, 1894; but the application was not filed until April 4, 1896, when it was accompanied by the assignee's affidavit attempting to make the required averment with reference to public use. The examiner refused to consider the affidavit as an additional oath under Rule 46. The Commissioner said:

"In regard to this question it is noted that neither the statutes nor the rules make any provision for the filing of an oath to an application by any party other than the inventor so long as he is alive."

When the inventor dies or becomes insane Sec. 4896 of the Revised Statutes allows his Executor or Administrator, or his guardian, conservator, or representative in trust, as the case may be, to make application in his stead. It reads:

"When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator

duly authorized under the law of any foreign country, to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made." As to the change of form, see Walker, 4th Ed., 123.

VENUE.

The provision for a formal statement of venue, in the blank forms in general use, is in compliance with a very ancient custom, probably founded on good reason. But the failure to fill in the state and county or district, as the case may be, does not appear to be a fatal defect now, provided the seal shows the jurisdiction of the officer before whom the oath is taken. At least, this seems to be a fair deduction from *Prym vs. Heilbruner* (81 O. G., 2245; C. D. 1897-192). This case involved a preliminary statement affirmed before Acting Counsel Madden, at Cologne, Germany, but having no statement of venue: A motion to strike it out for irregularity was denied by the Examiner of Interferences and on appeal, the Commissioner said:

"The venue is one of the formal requisites of an affidavit. It states the county or district in which it is taken, and is *prima facie* evidence that it was taken in such place. In the older practice it was deemed so essential that without it the affidavit was treated as a nullity. Later cases modify this rule. (Enc. of Plead. & Prac., vol. 1, p. 313.) One of these cases is that referred to above. The purpose of the venue is to show that the officer administering the affidavit acted within his jurisdiction. The majority of cases now hold that it need not conclusively appear on the face

of the affidavit by venue that the officer acted within his jurisdiction. It would be presumed that he so acted if nothing appears to the contrary. (Same authority.)"

From the last paragraph of the case, however, it seems that the real ground for his decision was that the venue was included in the seal. It reads:

"A presumption that the affidavit in question was taken by a proper officer at a proper place is established by the use of the consular seal, by means of which the words 'U. S. Consulate, Cologne, Germany,' were impressed into the body of the paper and thereby made a part of the permanent record. Sound reasoning and common sense would seem to indicate that this is the equivalent in all essential respects of the formal use of similar words at the beginning of an affidavit to indicate the county in which it may have been executed."

In the later case of *Ex parte Delavoye* (124 O. G., 626; C. D. 1906-320), where the omission of the venue was considered fatal by the Examiner. Commissioner Allen said:

"No reason appears why proper evidence should not be furnished that the oath was administered within the territorial jurisdiction of the notary."

But there is nothing in the decision to indicate that he intended to overrule *Prym vs. Heilbrunner* or to direct the Examiners to require a formal statement of venue when the notary's jurisdiction appears in the seal.

However, if a venue is given it must not be inconsistent or at variance with the seal.

CITIZENSHIP.

The citizenship of the inventor was originally of no importance; the statutes provided that "any person" under the prescribed conditions could obtain a patent and required no statement as to citizenship. But under the statute of 1793 it became very material, for that law

only made provisions for granting patents to citizens; and it was not until the amendment of 1800 that the privilege was extended to aliens. Again in the act of 1836 discrimination was made against aliens; and it was required that the applicant make oath "also of what country he is a citizen" (Sec. 6). This discrimination, however, was abolished in 1870 and apparently so remains to the present, since Sec. 4892 Revised Statutes is the same as Art. No. 30 of that Act in this regard. The situation under the later law was ably stated in *Tondeur vs. Chambers* (46 O. G., 110; 37 F., 333) where the defendant in an infringement suit set up that the patent was void "upon the ground that in the application for his patent the plaintiff made oath that he was a citizen of the U. S., which he was not," and cited *Child vs. Adams* (1 Fish, 189) to support it.

"But" said the court "that case arose under and was governed by the patent act of 1836, which allowed the grant of Letters Patent to aliens only upon peculiar conditions, to which citizens were not subject (5 Stats. at Large, 117). By that act the patent-fee payable by a citizen was \$30 only, whereas an alien was required to pay at least \$300, and if a British subject \$500; and by the stringent language of the act the fee was to be paid before the application for a patent could be considered by the Commissioner (Section 9). Then, again, an alien patentee was compelled 'to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued' (Section 15.) It was therefore, under that act of the highest importance that the applicant should truly disclose his citizenship, and Section 6 required that before any inventor should receive a patent he should 'make oath . . . of what country he is a citizen.' The decision cited was expressly put upon the ground that an alien, whether through ignorance or intention, falsely swearing that he was a citizen in order to procure a patent not only failed to perform a condition upon which his right to a patent depended, but committed

a fraud upon the Government. But the law governing the present case—i. e., the patent act of 1870, as embodied in the Revised Statutes—abolished all such discriminations against aliens and placed them upon the same footing as citizens in respect to the grant of Letters Patent for inventions, and the enjoyment of the privileges thereby secured (R. S., Secs. 4886, 4920, 4934). Therefore, under the law as it stood when the plaintiff applied for and obtained his patent, the mistake in his statement as to his citizenship operated, and could operate, neither to his advantage nor to the detriment of the Government or the public. Furthermore, it is well worthy of notice that while Section 4892 Revised Statutes requires the applicant for a patent to 'make oath that he does verily believe himself to be the original and first inventor,' etc., in respect to citizenship, the language is 'and shall state of what country he is a citizen.' This change in phraseology seems to be intentional and to dispense with the necessity of an oath as to citizenship. At any rate, the citizenship of the applicant for a patent is no longer a matter of any real importance, and a mistake touching the same is harmless."

The impression must not be gotten, however, that the statement of citizenship may be omitted; it is a statutory requirement and absolutely necessary (See *Ex parte Benecke*, 126 O. G., 3423; C. D., 1907-66). Nor is it sufficient to say that he has declared his intention of becoming a citizen of the United States (*Ex parte Rhodes*, 105 O. G., 1261) though a statement that he is not a citizen of any country is compliance with the statute (*Ex parte Benecke*, supra).

RESIDENCE.

Rule 46 requires the applicant to state where he resides; but in this it is not supported by the statute; and the want of such a statement would not warrant the Office in holding an application otherwise unobjectionable to be incomplete. In such a case, however, a new oath should be required (*Ex parte Becker*, 97 O. G., 1597; C. D., 1901-198).

ORIGINAL AND FIRST.

It is the intent of the United States patent law that patents shall issue only as a reward for progress made in the useful arts (Constitution, Art. 1, Sec. 8). Under its provisions the "true inventor or discoverer" (as he was defined in the first statute requiring an oath in the application, 1793), is the only person entitled to reward. And by "true inventor or discoverer" here is meant the man who in deed and in truth originated the art, machine, manufacture, etc., and brought it to light for the first time in the knowledge of the world, in contradistinction to bringing it into the realm as in England, or originating at a time subsequent to some other. The later laws adopted the words "original and first" in recognition of the fact that a man might originate the thing, in so far as his own knowledge was concerned and yet not be the first to do the act, and with the intention of excluding such secondary originator from the peculiar and special rights and privileges contemplated by the constitution. Therefore, the applicant's averment that he verily believes himself to be the original and first inventor or discoverer is of first and primary importance, for it his affidavit to these facts that establishes his *prima facie* right under the law to receive a patent for his invention; and unless he can make this portion of the oath it is useless to proceed further (*Ex parte* Hill, 16 O. G., 765; C. D., 1879-236).

JOINT AND SOLE.

The possibility of joint as well as sole invention seems to have been recognized from the earliest times of our patent system. The statute of 1790 provided for the grant of patents to "any person or persons;" and in the list of patentees under date of August 10, 1791, are found the names of John Biddis and Thomas Bedwell presumably joint inventors of "Making extract of barks." Certain it is that the term "joint" was current in 1836; for on page 1 of the rules in force in July of that year appears the following:

"Joint inventors are entitled to a joint patent, but neither can claim one separately."

However, in the form of oath given on page 10 of those rules no reference is made to either "joint" or "sole" and the requirement in that regard did not appear in Rule 46 until July 31, 1906, though the forms used those words as early as 1871.

The statutes are silent on this question, but the rule requires that the applicant "shall state . . . whether he is a sole or joint inventor," and that rule has all the force and effect of law (*Miller vs. Lambert*, 72 O. G., 1903, and Revised Statutes, Sec. 483), and every part of it is material (*Ex parte Leverstein and Naef*, 110 O. G., 1726; C. D., 1904-217). It seems safe, therefore, to assume that this statement is a material and necessary part of every oath; but, from the wording of the Rule which puts it on the same footing as the statements as to residence and citizenship, apparently no actual averment is necessary. A careful search disclosed no decision on these points. However, in *Ex parte Mygatt* (160 O. G., 773; C. D., 1910-205), Commissioner Moore held that, while the omission of the word "sole" resulted in a defective oath, it did not render it invalid and warrant holding an application abandoned for failure to complete within the year.

Such an omission, would probably not invalidate a patent, for, as above noted, the courts will not go back of the grant to examine the papers except in cases of fraud; but a joint patent on a sole invention or a sole patent on a joint invention would be void (*Walker*, 4th Ed., Secs. 50 and 51).

The use of the word "sole" is not such a significant and material matter as would support an indictment for perjury under Section 5392 Revised Statutes (*Patterson vs. U. S.*, 181 F., 970; *U. S. vs. Patterson*, 174 O. G., 287). And an oath by two people as joint inventors does not preclude either one of them from subsequently filing a sole application for the same invention if he should come into possession of information leading to the belief that he was in fact a sole inventor. Indeed, in such a case an interference may be declared for the purpose of determining whether the invention was made by one or by both jointly (*Kohler vs. Kohler and Chambers*, 43 O. G., 247; C. D., 1888-19).

For a short time under the rules of 1897 a sole application could be transformed into a joint application and vice versa, but a new application would be necessary now (*Ex parte* Erne and Bridges, 81 O. G., 2247; C. D., 1897-197; and *Ex parte* Gordon, 108 O. G., 561; C. D., 1903-20).

In a joint application the oath must be made and signed by both parties (*In re* Crane, 106 O. G., 999; C. D., 1903-332); but it is not necessary that they sign the same paper, each may sign and execute duplicate copies (*Ex parte* Wellman & Wellman, 88 O. G., 2065; C. D., 1899-176).

IDENTIFICATION.

When all parts of the application are filed at one time, there is generally no trouble on this score; for the papers are usually permanently attached together and the oath refers to the annexed specification for a disclosure of the invention about which its averments are made. But when the specification and oath are filed at different times, it almost always happens that the form of the latter has not been changed, and it refers, as usual, to an annexed specification, which in fact does not exist. The averments are, therefore, all about an unidentified invention, and without force or effect. Rules 10 and 32 "apply to an oath as well as to any other paper relating to or a part of an application." *Ex parte* Heusch, 88 O. G., 1703; C. D., 1899-172).

DOES NOT KNOW AND DOES NOT BELIEVE.

In the Patent Act of 1800 extending the privileges of the Law of 1793 to aliens, the applicant was required to make oath as to "the best of his or her knowledge or belief;" and likewise under the Statute of 1836 he swore that he did "not know or believe;" but in 1870 the language was changed to "does not know and does not believe" as it is at present. The positive reason for the change could not be readily ascertained, but it was apparently the intent of Congress to put applicants on oath as to both knowledge and belief. This was the opinion of Commissioner Allen in *Ex parte* Nicholson

(96 O. G., 1035; C. D., 1901-86) where instead of using the words of the law the applicant said:

"I verily believe . . . that the said improvement was not known or used by others . . .,"

and contended that the averment of belief was sufficient to comply with the statute. But the Commissioner said:

"It seems clear to my mind that the framers of this Section 4892 intended to require the applicant for a patent to disclaim, first, his personal knowledge, and, second, his belief, which, in contradistinction to his knowledge, may be defined as that reasonable belief which is founded upon information derived from others, thus disclaiming two classes of means by which conviction is wrought. Thus considered as excluding personal knowledge, and information and belief, the words of the statute have that vitality which should be expected from the fact of their use, and they are not construed as meaningless.

"Those provisions of section 4892 are conditions precedent to the grant of a patent, and since such grant follows a course of statutory procedure resulting in the creation of a monopoly in derogation of the common-law rights of the public any failure to comply with these conditions would render the patent granted fatally defective. The only safe course is strict conformity, although some latitude in the use of terms may be permitted to cover the requirements of other portions of Rule 46, whereby the applicant is required to make for himself a *prima facie* case under sections 4886 and 4887, Revised Statutes."

Ex parte Buddington (84 O. G., 1728; C. D. 1898-184) was a similar case in which the applicant made oath to his knowledge, but said nothing about his belief, and the Commissioner said:

"Section 4892 of the Revised Statutes distinctly requires that the applicant shall make

oath in regard to his invention 'that he does not know and does not believe that the same was ever before known or used,' and this Office has no authority to waive any positive requirement of the statute."

THAT THE SAME WAS EVER BEFORE KNOWN OR USED.

These are the words of Section 4892, Revised Statutes, and have been in the corresponding sections or articles since 1836, when an averment of that nature was first required. They are also the words of Rule 46, and were in the form of 1836. But the present form (No. 18) reads:

"That the same was ever known or used before
—— invention or discovery thereof,"

and has so read since April 15, 1882 ("or discovery" was not inserted until February 9, 1897, but the words are synonymous). There is nothing wrong about this, however, for the form is a patch-work of Sections 4886, 4892, 4923 and others, and also Rule 46. Section 4892 and Rule 46 are indefinite as to the time before which the alleged improvements were not known or used. They simply make the applicant swear "that he does not know and does not believe that the same was ever before known or used," without setting the date from which that speaks. And it could not be the date of the oath or that of the application, which is theoretically the same (*Ex parte Branna*, 97 O. G., 2533; C. D., 1901-232), for it would not do to bar a patent because the invention had been used (for a time less than two years) before the application was filed (*Ex parte Rowan*, 22 O. G., 1037; C. D., 1882-12). However, Section 4892 relates merely to the knowledge and belief of the applicant whereas Section 4886 deals with the actual facts of invention, and admits only such improvements as are "not known or used by others in this country before his invention or discovery thereof." That then is the time before which knowledge or use of the invention would be fatal. Still, the oath must not be limited to knowledge or use in this country (*Ex parte*

Nicholson, 96 O. G., 1035; C. D., 1901-86), as the quotation would imply, for it is contemplated by Section 4923 that, at the time of making his application, the inventor shall believe himself to be the original and first inventor, although it prohibits holding a patent void because the invention or any part thereof was known or used in any foreign country before his invention or discovery thereof.

**Or Patented or Described
in any
Printed Publication in any Country
Before ——— Invention or Discovery thereof or
more than
Two Years Prior to this Application.**

The germ of this averment made its entry into the patent law in Section 7 of the Act of 1836, which provided:

“That . . . if, on any such examination, it shall *not* appear to the Commissioner . . . that it had been patented or described in any printed publication in this or any foreign country, . . . it shall be his duty to issue a patent therefor.”

It next appeared as a bar in Section 24 of the Act of 1870, which was embodied in Section 4886 of the Revised Statutes in 1874; but the two-years clause was not added until the Act of 1897.

The rules did not require it until 1899, when it was also inserted in the form.

**Or in Public Use
or on
Sale in the United States for More
Than Two Years Prior to this Application.**

Public use or sale with the consent or allowance of the inventor as such, at the time of the application was made a bar to the grant of a patent by Section 6 of the Act of 1836. Under Section 6 of the Act of 1839 relative to foreign patents, introduction of the invention covered by

the foreign patent into "public or common use in the United States" debarred the grant of a patent here. While by Section 7 of the Act of 1839 public use or sale by others without the consent specified by Section 6 of the Act of 1836 for more than two years prior to the application rendered the patent void. Section 24 of the Act of 1870 barred the grant for "public use or sale for more than two years prior to his application;" and Section 25 of this Act contained a limitation similar to Section 6 of the Act of 1839. Section 4886 took its original form from Section 24 of the Act of 1870, and the limitation of the use or sale to this country was not made until the amendment of 1897.

This bar came into the Rules associated with foreign patents. Thus, in 1867, Rule 16 corresponding to Rule 46 and the form contained nothing in regard to public use or sale, but Rule 80, under the heading "Of Foreign Patents," read:

"When an application is made for a patent for an invention which has been already patented abroad, the inventor will be required to make oath that, according to the best of his knowledge and belief, the same has not been introduced into public and common use in the United States."

This oath was a separate instrument, from that commonly attached to the specification.

The words "and common" were dropped in 1871; and the present words "or on sale" occurred first in the form for the oath relating to foreign patents issued in 1880, though they did not come into the corresponding Rule (39) until 1883. The forms were consolidated in 1882; but Rule 45, which corresponds to present Rule 46, did not mention public use or sale until 1885.

There are few published decisions involving this clause of the oath, but Rule 46 has all the force of a statute and the requirement there is sufficient (See *Miller vs. Lambert*, 72 O. G., 1903; 1897-77).

**"That said Invention
has not been
Patented in Any Country Foreign
to the
United States on an Application Filed
by him or his
Legal Representatives or Assigns More Than
Twelve Months Prior to this Application."**

This clause had its inception in Article 8 of the Act of 1836; it was changed by Section 6 of the Act of 1839, by Section 25 of the Act of 1870, and by Section 8 7 Revised Statutes in 1874, which was amended by the Act of 1897, and received its final form by the Act of 1903.

The various steps of its development are very interesting, but anything like a detailed examination of them would be too long for this paper.

(For decisions see next head.)

**"And That
no
Application for Patent
on said
Improvement has been Filed by
——— or ———
Representatives or Assigns in any Country
Foreign to the United States Except as Follows:"**

This requirement was added to the Rule (46) in 1897 when Section 4887, Revised Statutes, was amended to make a foreign patent granted on an application filed more than seven months before the date of the application in this country a bar to the grant here, instead of a mere limitation of the life of the patent, as it would have been under the preceding law. It gave the Office notice of applications pending in foreign countries more than seven months prior to the execution of the oath and which might become patents before allowance in this country. And it serves a similar purpose under the present law (1903). Also, it shows what dates applicants are entitled to under the second paragraph of Section 4887 Revised Statutes.

Both these statements about foreign patents and applications are productive of trouble. Applicants seem inclined to use their own language and to give as little information as possible.

In *Ex parte* Levenstein and Naef (110 O. G., 1726; C. D., 1904-217) the statement relative to foreign patents granted on applications filed more than twelve months prior to the domestic application was omitted, and on petition taken from the Examiner's requirement for a new oath the Commissioner said:

"Present Rule 46 requires that the applicant state in his oath that the invention has not been patented to himself or others with his knowledge or consent . . . on an application for a patent filed in any foreign country by himself or his legal representatives or assigns more than twelve months prior to his application.

"This rule is based upon section 4887, Revised Statutes, as amended March 3, 1903, which states:

"Section 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"It therefore appears that this requirement of Rule 46 and section 4887 of the Revised Statutes has not been complied with by the petitioners. They contend, however, that their oath substantially complies with the present requirements, for they state . . . that no application for patent on said improvement has been filed . . . in any country foreign to the United States except . . . one filed in Great Britain, the date

of which appears to be less than twelve months prior to the filing in this country.

"A similar contention to this was urged in *Ex parte Mason* (C. D., 1888, 33; 43 O. G., 627), wherein applicant instead of using the phraseology required by the rules then in force changed it in a material particular, and it was said by Commissioner Hall:

"It is evident that this language is far from a compliance with the rules. It may possibly put the applicant to some trouble or delay to file a proper oath but the requirement is one which should be insisted upon. If a material variation, or, rather, violation of the rule, can be permitted in one particular, the practice would soon become very lax in others."

"In the present case, the applicants have ignored one of the positive requirements of Rule 46, but state that their compliance with another requirement of the rule is sufficient to cure any defect in the omission of the other one. This position is not thought sound. Every portion of Rule 46 is material, and it can not be held therefore, that a compliance with some of its requirements is a compliance with all of them. In the present case the papers are sufficient to entitle the applicants to the date upon which they were filed in this office; but the requirement of the Primary Examiner that a new oath be filed to comply strictly with Rule 46 is right and is affirmed."

This decision was modified by a notice published in 110 O. G., 2019, as follows:

"The decision of *Ex parte Lerenstein and Naef* (110 O. G., 1726) is to the effect that the oath forming a part of an application must be so clear as not to require a comparison of the allegations therein as to the filing of foreign applications with the date of filing of the application in this country in order to determine whether or not the application in question has been filed in this country within twelve months from the date of filing of the

foreign application. An oath which states that no foreign applications have been filed prior to the filing of the application in this country complies with the rule in this particular; but when an application has been filed in a foreign country it must be positively stated that the said foreign application has not been filed more than twelve months prior to the date of filing of the domestic application."

And both these were interpreted by *Ex parte Giradot* (115 O. G., 1584; C. D., 1905-124):

"The Examiner's objection relates to the statements concerning the inventor's applications and patents in foreign countries. The inventor has sworn that he does not know and does not believe that the invention or discovery has been patented in any country foreign to the United States on an application filed twelve months before this application and that no application for patent upon his invention has been filed by him or his representatives or assigns in any country foreign to the United States, except one in France identified by date and number, the date given being within twelve months of the date of the application in this country. The Examiner's objection is that the oath does not positively state that the foreign application mentioned was not filed more than twelve months prior to the filing of this application.

"The Examiner's position is not well taken. There is no good reason for requiring the applicant to state, in addition to the statements already made, that his foreign application was not filed more than twelve months before the filing of the application in this country. If the foreign application had been filed outside of the twelve-months' period, the application here would nevertheless be entitled to full consideration, no patent having issued upon the foreign application. In citing his foreign application, in stating that no other foreign application has been filed and that no

patent has been granted upon an application filed in any foreign country more than twelve months before the date of the domestic application the applicant has made every allegation respecting his foreign applications and patents required by the rule. The Examiner based his action upon *Ex parte Levenstein and Naef* (C. D., 1904, 217; 110 O. G., 1726), and notice concerning this decision published in the Official Gazette, volume 110, page 2239. This decision and notice should not, however, be interpreted to require more than the applicant has already done in this case."

The language of Commissioner Allen in *Ex parte Thorsten von Zweibergh* (110 O. G., 859; C. D., 1904-176) is a good guide. He said:

"While . . . filing a new oath may cause slight delay . . . it is essential that the practice should be uniform, and the rule relating to oaths should be strictly followed. To hold otherwise would cause endless confusion in determining whether or not language chosen by the applicant in his oath was sufficient to comply with the requirements of the statute."

DATE.

In *French vs. Rogers* (1 Fisher, 133, 1851) the court said:

"We do not see the justice of the criticisms upon this application that the jurat affixed to it is without date of day or month."

But that was in an infringement suit on a patent and the presumptions referred to earlier in this paper would protect it. The oath deals with conditions at the date of the application and it should be dated so that the Office can determine whether or not there has been an unreasonable delay in filing the papers after the execution of the oath. However the issue division is instructed to pass cases where the month and year are given.

MUST BE SUBSCRIBED TO BY THE AFFIANT.

Rule 46 says that: "This oath must be subscribed to by the affiant;" and that appears to be sufficient authority, in view of the numerous decisions that hold it to have all the force and effect of a statute.

BEFORE WHOM TAKEN.

Section 4892 of the Revised Statutes provides that:

"Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affairs, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States,"

to which Rule 47 adds:

". . . the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made, except that no acknowledgment may be taken by any attorney appearing in the case. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

"When the oath is taken before an officer in *any country including the United States* all the application papers must be attached together and a ribbon or tape passed one or more times through all the sheets of the application, and the ends of said ribbon or tape brought together under the seal before the latter is affixed and impressed, or

each sheet must be impressed with the official seal of the officer before whom the oath was taken, or, if he is not provided with a seal then each sheet must be initialed by him."

(Only people specified competent, *Ex parte* Harkanson, 63 O. G., 1688; C. D. 1893-76). (See also Op. Atty. Gen., 60 O. G., 1481.)

This language is sufficiently specific without construction or explanation to form a guide in most instances; but the exception made in the case of the attorney deserves special mention, for an oath administered by him is absolutely void (*Rieger vs. Beierl*, 150 O. G., 826; C. D. 1910-12). This exception had its initial appearance in the revision of the Rules made July 17, 1907; and was apparently made in view of the opinion of Attorney General Bonaparte (127 O. G., 3642) under date of April 18, 1907, construing the amended section 558 of the D. C. Code relative to notaries. This section in part read:

"That no notary public shall be authorized to take acknowledgments, administer oaths, certify papers, or perform any official acts in connection with matters in which he is employed as counsel, attorney, or agent in which he may be in any way interested before any of the Departments aforesaid,"

and was construed to apply to all notaries who may practice before the Departments. The Court of Appeals of the District of Columbia expressed a similar opinion in the *Hall's Safe Company vs. Herrnig-Hall-Marvin Safe Company* (135 O. G., 1804; C. D., 1908-473). For a full discussion of the subject and directions to be followed see *Rieger vs. Beierl*, *supra*.

The holding in *Ex parte Wolski et al.* (84 O. G., 2022; C. D., 1898-210) that an oath executed before a judge of the Imperial Royal District Court of Austria can not be accepted, and the similar holding in *Ex parte Gruson and Schumann* (26 O. G., 274; C. D., 1884-2) are no longer controlling for they were made before the amend-

ment in Section 4892 Revised Statutes, contained in Section 2 of the Patent Act of 1903 and incorporated in Rule 47 April 15, 1903, which extended the authority to foreign judges and magistrates.

The Patent Act of 1903 also brought the requirement for proof of the authority of the foreign officer who administered the oath, by a certificate of a diplomatic or consular officer of the United States; and a certificate of the authority of one officer who in turn certifies the authority of the officer before whom the oath was taken is not a compliance (*Ex parte* Rose, 180 O. G., 322; C. D., 1912-194); nor is a proper certificate sufficient for more than one case. In *re* Fred G. Dieterich and Co. (110 O. G., 309; C. D., 1904-151).

Ribboning the papers, or impressing the seal or placing the initials upon each sheet of foreign applications which has been necessary since the revision of the Rules published January 2, 1903, is still insisted upon; but the similar requirement in domestic cases imposed by the amended Rules of November 21, 1908, has been informally waived.

To sum up: No application should be allowed unless it contains an oath or affirmation made and subscribed to by the inventor, and before an officer named in the statute; stating his citizenship and residence; declaring a belief that he is the original, first and sole inventor (or joint inventor, as the case may be) of the invention or discovery disclosed in an identified specification; disclaiming knowledge and belief of the knowledge or use thereof before his invention or discovery, or the existence of a patent thereon or a description thereof in a printed publication in any country before his invention or discovery, or more than two years prior to his application; denying that said invention has been patented in any country foreign to the United States on an application filed by him or his representatives or assigns more than twelve months prior to his said application, and also that any application for patent on said improvement has been filed by him or his representatives or assigns in any country foreign to the United States, except as are named and identified by date and country; said oath

bearing the seal of the officer before whom it was made, or, if he had none, being accompanied by competent certification of his authority; said oath also showing venue either in a formal statement or in the seal of the officer before whom it was made, or consistently in both. In cases of dead or insane inventors the oath or affirmation is made by their proper legal representatives with appropriate variations in "form."

December 3, 1914.

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